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PTO/SB/21 (08-00)

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)		Application Number	10/045,902
		Filing Date	January 16, 2002
		First Named Inventor	Shunpei YAMAZAKI
		Group Art Unit	2822
		Examiner Name	R. K. Potter
Total Number of Pages in This Submission		Attorney Docket Number	0756-2405

**ENCLOSURES (check all that apply)**

<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Declaration and Power of Attorney <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosures 1. 2. 3. 4. 5. 6.
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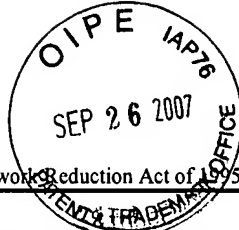
**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm or Individual name	Eric J. Robinson, Reg. No. 38,285 Robinson Intellectual Property Law Office, P.C. PMB 955 21010 Southbank Street Potomac Falls, VA 20165
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Date	September 24, 2007

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**FEE TRANSMITTAL  
FOR FY 2005**

Effective 10/01/2004. Patent fees are subject to annual revision.

☐ Applicant Claims small entity status. See 37 CFR 1.27.**TOTAL AMOUNT OF PAYMENT** (\$) 500.00**Complete if Known**

Application Number	10/045,902
Filing Date	January 16, 2002
First Named Inventor	Shunpei YAMAZAKI
Examiner Name	Roy K. Potter
Group Art Unit	2822
Attorney Docket No.	0756-2405

**METHOD OF PAYMENT**

- 1.
- ☒
- The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

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- 
- Under 37 CFR 1.16 and 1.17 and
- 
- credit overpayments

☐ Applicant claims small entity status.  
See 37 CFR 1.27

- 2.
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☒ Check ☐ Credit Card ☐ Money  
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Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
1001	300	2001	150	Utility filing fee	
1111	500	2111	250	Search fee	
1311	200	2311	100	Examination fee	
Over 100 Sheets/250 for each additional 50					

**SUBTOTAL (1)** (\$)**2. EXTRA CLAIM FEES**

Total Claims	Extra Claims	Fee from below	Fee Paid
	-20** =	\$50	
Independent Claims	-3** =	\$200	
Multiple Dependent			

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
1202	50	2202	25	Claims in excess of 20	
1201	200	2201	100	Independent claims in excess of 3	
1203	360	2203	180	Multiple dependent claim, if not paid	
1204	200	2204	100	** Reissue independent claims over original patent	
1205	50	2205	25	** Reissue claims in excess of 20 and over original patent	

**SUBTOTAL (2)** (\$)

\*\*or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION (continued)****3. ADDITIONAL FEES**

Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	120	2251	60	Extension for reply within first month	
1252	450	2252	225	Extension for reply within second month	
1253	1020	2253	510	Extension for reply within third month	
1254	1,590	2254	795	Extension for reply within fourth month	
1255	2,160	2255	1080	Extension for reply within fifth month	
1401	500	2401	250	Notice of Appeal	
1402	500	2402	250	Filing a brief in support of an appeal	\$500.00
1403	1000	2403	500	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	500	2452	250	Petition to revive - unavoidable	
1453	1,500	2453	750	Petition to revive - unintentional	
1501	1,400	2501	700	Utility issue fee (or reissue)	
1502	800	2502	400	Design issue fee	
1503	1100	2503	550	Plant issue fee	
1462	400	1462	400	Petitions, Group I	
1463	200	1463	200	Petition, Group II	
1464	130	1464	130	Petitions, Group III	
1807	50	1807	50	Processing fee under 37 CR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify) _____					
* Reduced by Basic Filing Fee Paid				<b>SUBTOTAL (3)</b> (\$)	500.00

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**SUBMITTED BY**

Name (Print/Type) Eric J. Robinson

Signature

Registration No.  
(Attorney/Agent)

38,285

**Complete (if applicable)**

Telephone (571) 434-6789

Date

September 24, 2007



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Shunpei YAMAZAKI

Serial No. 10/045,902

Filed: January 16, 2002

For: SEMICONDUCTOR HAVING LOW  
CONCENTRATION OF  
PHOSPHOROUS

) Group Art Unit: 2822

) Examiner: R.K. Potter

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) 9-24-2007.

Adrian M. Stamps

**APPEAL BRIEF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 35 U.S.C. § 134 and 37 C.F.R. § 1.192(a), Appellants submit this Appeal Brief to appeal the examiner's final rejection of claims 1-35 in the Official Action mailed January 4, 2005, and maintained in the Official Action mailed April 10, 2007. A Notice of Appeal was filed July 10, 2007 (received by OIPE July 16, 2007).

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	2. 37 CFR § 1.182	
	3. 35 U.S.C. § 251	
	4. <i>Terminal Disclaimer</i> filed November 27, 1996	
	5. MPEP § 1490, Part VII (Withdrawing a Recorded Terminal Disclaimer), Subpart A (Before Issuance of Patent)	
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	10. <i>Hester Industries, Inc. v. Stein, Inc.</i> , 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998)	
	11. <i>Mentor Corp. v. Coloplast, Inc.</i> , 998 F.2d 992, 27 USPQ2d 1521 (Fed. Cir. 1993)	
	12. <i>Ex parte</i> Durckheimer et al., Appeal No. 94-2004, U.S. Application Ser. No. 07/551,615	
	13. <i>Ex parte</i> Anthony, 230 USPQ 467 (PTO Bd. App. 1982)	



14. Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935)
15. In re Jentoft, 392 F.2d 633, 157 USPQ 363 (CCPA 1968)
16. In re Morgan, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993)

**I. REAL PARTY IN INTEREST**

The named inventor has assigned all ownership rights in the pending application to Semiconductor Energy Laboratory Co., Ltd., 398, Hase, Atsugi-shi, Kanagawa-ken, 243-0036, Japan, which is the real party in interest.

**II. RELATED APPEALS AND INTERFERENCES**

The appellants, their legal representatives, and the assignee are not aware of any other prior or pending appeals, interferences or judicial proceedings which will directly affect or be directly affected by, or have a bearing on the Board's decision in this appeal.

**III. STATUS OF THE CLAIMS**

Claims 1-35 are pending in the present reissue application, of which claims 1, 4, 10, 14, 16, 18, 24, 26, 28, 30, 32 and 34 are independent. Claims 1-35 stand rejected as being based on a defective reissue basis under 35 U.S.C. § 251 and as being based upon a defective reissue oath/declaration under 35 U.S.C. § 251 (page 2, Paper No. 20061214). No claims have been deemed allowable by the examiner. The Appellants appeal the rejection of claims 1-35.

**IV. STATUS OF AMENDMENTS**

All prior amendments are believed to have been entered in the present application.

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

Independent claim 1 is directed to a semiconductor device (FIGS. 1 and 2) comprising: a substrate (e.g. substrate 1); and a non-single crystalline semiconductor layer (e.g. non-single-crystal semiconductor laminate member 3) formed over said substrate, said semiconductor layer comprising amorphous silicon (e.g. column 5, lines 34-35 and 51) and including at least hydrogen (e.g. column 5, lines 43-44 and 56-60; column 6, lines 31-36); and at least one intrinsic or substantially intrinsic region (e.g. I-type non-single-crystal semiconductor layer 5) formed within said semiconductor layer;

at least one N-type or P-type region (e.g. N-type non-single-crystal semiconductor layer 6, P-type non-single-crystal semiconductor layer 4) formed within said semiconductor layer; and at least one NI or PI junction (e.g. NI junction 12, PI junction 11) between said intrinsic or substantially intrinsic region and said N-type or P-type region, wherein carbon is present in said intrinsic or substantially intrinsic region and the concentration of said carbon is less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup> (e.g. column 6, lines 23-24).

Independent claim 4 is substantially similar to claim 1 except that "amorphous" is not included.

Independent claim 10 is directed to a semiconductor device (FIGS. 1 and 2) comprising: a substrate (e.g. substrate 1); and an amorphous semiconductor layer of intrinsic or substantially intrinsic conductivity type (e.g. I-type non-single-crystal semiconductor layer 5; column 5, lines 34-35 and 51) formed over said substrate, said semiconductor layer comprising silicon (e.g. column 5, lines 34, 51 and 56-57; column 6, lines 27 and 31-33) and including at least hydrogen (e.g. column 5, lines 43-44 and 56-60; column 6, lines 31-36); and at least one NI or PI junction (e.g. NI junction 12, PI junction 11) formed with said amorphous semiconductor layer, wherein carbon is present in said semiconductor layer and the concentration of said carbon is less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup> (e.g. column 6, lines 23-24).

Independent claim 14 is directed to a semiconductor device (FIGS. 1 and 2) comprising: a substrate (e.g. substrate 1); and an amorphous semiconductor layer of intrinsic or substantially intrinsic conductivity type (e.g. I-type non-single-crystal semiconductor layer 5; column 5, lines 34-35 and 51) formed over said substrate, said semiconductor layer comprising silicon (e.g. column 5, lines 34, 51 and 56-57; column 6, lines 27 and 31-33) and including at least hydrogen (e.g. column 5, lines 43-44 and 56-60; column 6, lines 31-36); and an N-type microcrystalline (e.g. column 6, line 27) semiconductor layer (e.g. N-type non-single-crystal semiconductor layer 6) comprising silicon (e.g. column 5, lines 34, 51 and 56-57; column 6, lines 27 and 31-33) in contact with said amorphous semiconductor layer to form at least one NI or PI junction (e.g. NI

junction 12, PI junction 11), wherein carbon is present in said semiconductor layer and the concentration of said carbon is less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup> (e.g. column 6, lines 23-24).

Independent claim 16 is directed to a non-single-crystalline semiconductor material (e.g. non-single-crystal semiconductor laminate member 3) comprising silicon (e.g. column 5, lines 34, 51 and 56-57; column 6, lines 27 and 31-33) having at least one junction (e.g. NI junction 12, PI junction 11) formed between a substantially intrinsic or intrinsic semiconductor material (e.g. I-type non-single-crystal semiconductor layer 5) and a one conductivity type semiconductor material (e.g. N-type non-single-crystal semiconductor layer 6, P-type non-single-crystal semiconductor layer 4), said junction being one of NI and PI junctions, said semiconductor material containing at least hydrogen (e.g. column 5, lines 43-44 and 56-60; column 6, lines 31-36) and wherein carbon is present in said substantially intrinsic or intrinsic semiconductor material in an amount less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup> (e.g. column 6, lines 23-24).

Independent claim 18 is directed to an amorphous semiconductor material (e.g. non-single-crystal semiconductor laminate member 3; column 5, lines 34-35 and 51) comprising silicon (e.g. column 5, lines 34, 51 and 56-57; column 6, lines 27 and 31-33) having at least one junction (e.g. NI junction 12, PI junction 11) formed between a substantially intrinsic or intrinsic semiconductor material (e.g. I-type non-single-crystal semiconductor layer 5) and a one conductivity type semiconductor material (e.g. N-type non-single-crystal semiconductor layer 6, P-type non-single-crystal semiconductor layer 4), said junction being one of NI and PI junctions, said semiconductor material containing at least hydrogen (e.g. column 5, lines 43-44 and 56-60; column 6, lines 31-36) and wherein carbon is present in said substantially intrinsic or intrinsic semiconductor material in an amount less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup> (e.g. column 6, lines 23-24).

Independent claim 24 is directed to a semiconductor device (FIGS. 1 and 2) comprising: a substrate (e.g. substrate 1); and a non-single crystalline semiconductor

layer (e.g. non-single-crystal semiconductor laminate member 3) formed over said substrate, said semiconductor layer comprising silicon (e.g. column 5, lines 34, 51 and 56-57; column 6, lines 27 and 31-33) and including at least hydrogen (e.g. column 5, lines 43-44 and 56-60; column 6, lines 31-36); and at least one intrinsic or substantially intrinsic region (e.g. I-type non-single-crystal semiconductor layer 5) formed within said semiconductor layer; at least one N-type or P-type region (e.g. N-type non-single-crystal semiconductor layer 6, P-type non-single-crystal semiconductor layer 4) formed within said semiconductor layer; and at least one NI or PI junction (e.g. NI junction 12, PI junction 11) between said intrinsic or substantially intrinsic region and said N-type or P-type region, wherein carbon is present in said intrinsic or substantially intrinsic region and the concentration of said carbon is less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup> (e.g. column 6, lines 23-24), and at least a portion of said intrinsic or substantially intrinsic region contains boron in a concentration  $1 \times 10^{15}$  to  $2 \times 10^{17}$  (e.g. column 6, lines 11-14).

Independent claim 26 is directed to a semiconductor device (FIGS. 1 and 2) comprising: a substrate (e.g. substrate 1); and a non-single crystalline semiconductor layer (e.g. non-single-crystal semiconductor laminate member 3) of intrinsic or substantially intrinsic conductivity type formed over said substrate, said semiconductor layer comprising silicon (e.g. column 5, lines 34, 51 and 56-57; column 6, lines 27 and 31-33) and including at least hydrogen (e.g. column 5, lines 43-44 and 56-60; column 6, lines 31-36); and at least one NI or PI junction (e.g. NI junction 12, PI junction 11) formed with said non-single crystalline semiconductor layer, wherein carbon is present in said intrinsic or substantially intrinsic region (e.g. I-type non-single-crystal semiconductor layer 5) and the concentration of said carbon is less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^5$  atoms/cm<sup>3</sup>, and at least a portion of said intrinsic or substantially intrinsic region contains boron in a concentration  $1 \times 10^{15}$  to  $2 \times 10^{17}$  (e.g. column 6, lines 11-14).

Independent claim 28 is directed to a semiconductor device (FIGS. 1 and 2) comprising: a substrate (e.g. substrate 1); and a non-single crystalline semiconductor

layer (e.g. non-single-crystal semiconductor laminate member 3) formed over said substrate, said semiconductor layer comprising amorphous silicon (e.g. column 5, lines 34-35 and 51) including at least hydrogen (e.g. column 5, lines 43-44 and 56-60; column 6, lines 31-36); and at least one N-type or P-type region (e.g. N-type non-single-crystal semiconductor layer 6, P-type non-single-crystal semiconductor layer 4) formed within said semiconductor layer; at least one second region (e.g. P-type non-single-crystal semiconductor layer 4, N-type non-single-crystal semiconductor layer 6) formed within said semiconductor layer, said second region having a different conductivity type from said at least one N-type or P-type region; at least one junction (e.g. NI junction 12, PI junction 11) between said N-type or P-type region and said second region, wherein carbon is present in said second region and the concentration of said carbon is less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup> (e.g. column 6, lines 23-24).

Independent claim 30 is directed to a semiconductor device (FIGS. 1 and 2) comprising: a substrate (e.g. substrate 1); and an amorphous semiconductor layer (e.g. I-type non-single-crystal semiconductor layer 5; column 5, lines 34-35 and 51) formed over said substrate, said semiconductor layer comprising silicon (e.g. column 5, lines 34, 51 and 56-57; column 6, lines 27 and 31-33) and including at least hydrogen (e.g. column 5, lines 43-44 and 56-60; column 6, lines 31-36); and at least one junction (e.g. NI junction 12, PI junction 11) formed with said amorphous semiconductor layer, wherein carbon is present in said semiconductor layer and the concentration of said carbon is less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup> (e.g. column 6, lines 23-24).

Independent claim 32 is directed to a semiconductor device (FIGS. 1 and 2) comprising: a substrate (e.g. substrate 1); and an amorphous semiconductor layer (e.g. I-type non-single-crystal semiconductor layer 5; column 5, lines 34-35 and 51) formed over said substrate, said semiconductor layer comprising silicon (e.g. column 5, lines 34, 51 and 56-57; column 6, lines 27 and 31-33) and including at least hydrogen (e.g. column 5, lines 43-44 and 56-60; column 6, lines 31-36); and an N-type semiconductor

layer comprising silicon (e.g. N-type non-single-crystal semiconductor layer 6; column 5, lines 34, 51 and 56-57; column 6, lines 27 and 31-33) in contact with said amorphous semiconductor layer to form at least one junction (e.g. NI junction 12, PI junction 11), wherein carbon is present in said semiconductor layer and the concentration of said carbon is less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup> (e.g. column 6, lines 23-24).

Independent claim 34 is directed to an amorphous semiconductor material (e.g. I-type non-single-crystal semiconductor layer 5; column 5, lines 34-35 and 51) comprising silicon (e.g. column 5, lines 34, 51 and 56-57; column 6, lines 27 and 31-33) having at least one junction (e.g. NI junction 12, PI junction 11) formed between a first semiconductor material and a second semiconductor material having a different conductivity type from said first semiconductor material (e.g. P-type non-single-crystal semiconductor layer 4, N-type non-single-crystal semiconductor layer 6), said first semiconductor material containing at least hydrogen (e.g. column 5, lines 43-44 and 56-60; column 6, lines 31-36) and wherein carbon is present in said first semiconductor material in an amount less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup> (e.g. column 6, lines 23-24).

## **VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

A. Whether the error of the Examiner and the U.S. Patent Office in failing to consider and act upon a *Petition Under 37 CFR § 1.182 to Withdraw a Terminal Disclaimer* filed 21 months before issuance of a patent is an error under 35 U.S.C. § 251 that is correctable by reissue, and whether the errors of the Applicant (1) in failing to ensure proper disposition of the *Petition Under 37 CFR § 1.182 to Withdraw a Terminal Disclaimer*, (2) in not withdrawing the application from issuance under 37 CFR § 1.313 before the payment of the issue fee, (3) in not withdrawing the application from issuance under 37 CFR § 1.313 after the payment of the issue fee, and (4) in not deferring issuance of the patent under 37 CFR § 1.314 until the outstanding *Petition* was considered are errors under 35 U.S.C. § 251 that are correctable by reissue.

B. Whether claims 1-35 should be rejected as being based on a defective reissue basis under 35 U.S.C. § 251.

C. Whether claims 1-35 should be rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. § 251.

The rejected claims shall stand or fall together.

## VII. ARGUMENTS

The facts that are relevant to the present appeal are set forth below. Unless noted otherwise, these facts are not believed to be disputed.

Application Serial No. 08/426,235, the subject of the present reissue application, was filed April 21, 1995, and issued as U.S. Patent No. 6,180,991 to Yamazaki, on January 30, 2001. On November 27, 1996 (mail room date November 29, 1996), the Applicant filed a *Terminal Disclaimer* that disclaims the portion of the term of Yamazaki '991 that extends beyond the term of U.S. Patent No. 4,581,476 to Yamazaki. At the time of filing the *Terminal Disclaimer*, the claims in the present application did not recite a lower limit of a carbon concentration, i.e. "not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup>." Also, the claims in the '476 patent do not recite a carbon concentration not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup>.

The expiration date of the '476 patent is December 22, 2003. Although the Examiner has asserted that the expiration date of the '476 patent is April 8, 2003 (page 2, Paper No. 20061214), the term of the '476 patent is actually the greater of its 17-year term or its 20-year term due to amendment of § 154 under the Uruguay Round Agreements Act (URAA).

The expiration date of the present '991 patent is January 30, 2018.

After the *Terminal Disclaimer* was filed, each of the independent claims was amended to recite "not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup>." The present Appellants contend that at least this action rendered the *Terminal Disclaimer* unnecessary and inappropriate (see, e.g., the substantive amendments filed August 14, 1997, November 14, 1997, May 11, 1998, and November 4, 1998). Recognizing this, the Applicant filed



a *Petition Under 37 CFR § 1.182 to Withdraw a Terminal Disclaimer* on April 9, 1999.<sup>1</sup> The *Petition to Withdraw* was distinctly noted and specifically brought to the Examiner's attention in an *Amendment* filed on the same date.<sup>2</sup>

The *Petition* is consistent with the procedures set forth, for example, at MPEP § 1490, Part VII (Withdrawing a Recorded Terminal Disclaimer), Subpart A (Before Issuance of Patent).<sup>3</sup> This section of the MPEP specifically suggests filing a petition under 37 CFR § 1.182.

As early as April 1999, the Patent Office could have resolved this matter swiftly by acting on the *Petition*, by withdrawing the *Terminal Disclaimer*, and by notifying the Applicant of its decision.

Due to errors on the part of both the Patent Office and the Applicant, from April 9, 1999, the date of filing the *Petition*, to January 30, 2001, the date of issuance of the patent, which is a period of 21 months, the *Petition* was not considered or acted upon by the Office. The Appellants respectfully submit that these errors, enumerated in the reissue declaration,<sup>4</sup> are errors under 35 U.S.C. § 251.

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<sup>1</sup> The *Petition* explains that "the claims in the above-identified application have since been amended and it is now believed that the previously applied double patenting rejection no longer is applicable" and, specifically, that "the pending claims are different from the patented claims at least with respect to the recited lower limit of the carbon concentration."

<sup>2</sup> Specifically, at page 6 of the *Amendment*, the Applicant stated that "filed herewith is a *Petition to Withdraw* ... in view of the claim amendments effected since the obviousness-type double patenting rejection was first applied."

<sup>3</sup> "[T]here is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. Since the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition ... Under appropriate circumstances, consistent with the orderly administration of the examination process, the nullification of a recorded terminal disclaimer may be addressed by filing a petition under 37 CFR 1.182 requesting withdrawal of the recorded terminal disclaimer."

<sup>4</sup> The errors upon which this reissue is based are as follows: 1. The error of the applicants in failing to ensure proper disposition of the *Petition to Withdraw* during the prosecution of the '235 application; 2. The error of the applicants in not withdrawing the '235 application from issuance under 37 CFR § 1.313 before the payment of the issue fee; 3. The error of the applicants in not withdrawing the '235 application from issuance under 37 CFR § 1.313 after the payment of the issue fee; 4. The error of the applicants in not deferring issuance of the patent under 37 CFR § 1.314 until the outstanding *Petition to Withdraw* was considered; and 5. The error of the Examiner/USPTO in failing to consider and act upon the *Petition to Withdraw* filed 21 months prior to issuance of the subject '991 patent.

The above errors have resulted in rendering the subject '991 patent inoperative during its terminal part of the statutory term that extends beyond the expiration date of the patent identified in the *Terminal Disclaimer* of record. In addition, the above errors have also resulted in rendering the subject '991 patent inoperative in that it is only enforceable for and during a period that it and the various patents identified in the *Terminal Disclaimer* of record are commonly owned. Furthermore, in failing to withdraw the *Terminal Disclaimer*, the applicant also believes the '991 patent is partly inoperative by reason that the patentee claimed less than the patentee had the right to claim in regards to the term of the '991 patent.

The Applicant discovered that the *Petition* had not been properly handled after the '235 application issued as U.S. Patent No. 6,180,991 to Yamazaki on January 30, 2001. Beginning in March 2001, the Applicant through its representatives verbally requested consideration of the *Petition*.

As early as March 2001, the Patent Office could have resolved this matter swiftly by acknowledging its failure to act on the *Petition*, by processing the *Petition*, which was filed in full accordance with MPEP § 1490.VII.A and by issuing, at its own direction, a *Certificate of Correction* under 35 U.S.C. § 254 to delete the reference to the *Terminal Disclaimer* on the face of the patent.

Instead, on May 10, 2001, the Office of Petitions issued a *Decision on Petition* dismissing the *Petition*. The *Decision* cites MPEP § 1490, Part VII (Withdrawing a Recorded Terminal Disclaimer), Subpart B (After Issuance of Patent), which relates to procedures for petitions filed after issuance of a patent and does not apply to the present *Petition*, which was clearly filed before issuance of a patent. The Applicant filed a *Request for Reconsideration of Petition Under 37 CFR § 1.182 to Withdraw a Terminal Disclaimer* on August 24, 2001, which was denied in the *Decision Denying Petition* mailed November 8, 2001.

On January 16, 2002, the Applicant filed the present reissue application Serial No. 10/045,902. The Office issued a non-final Official Action on April 6, 2004. The Applicant responded on September 7, 2004, with a *Response*. On January 4, 2005, the Office

issued a final Official Action. The Applicant conducted an interview with Examiner Potter that resulted in an *Interview Summary* mailed April 5, 2005, agreeing that "Reissue can be used to correct an error involving a Terminal Disclaimer." Despite the Examiner's agreement on the record, the Office delayed subsequent action for over two years. During this period, the Applicant diligently contacted Office personnel on at least two dozen occasions to request further action by the Office. After a two year delay, instead of acting in accordance with the *Interview Summary*, the Office instead issued a new non-final Official Action on April 10, 2007. The Applicant filed a Notice of Appeal on July 10, 2007, resulting in the present *Appeal Brief*.

A. Whether the error of the Examiner and the U.S. Patent Office in failing to consider and act upon a *Petition Under 37 CFR § 1.182 to Withdraw a Terminal Disclaimer* filed 21 months before issuance of a patent is an error under 35 U.S.C. § 251 that is correctable by reissue, and whether the errors of the Applicant (1) in failing to ensure proper disposition of the *Petition Under 37 CFR § 1.182 to Withdraw a Terminal Disclaimer*, (2) in not withdrawing the application from issuance under 37 CFR § 1.313 before the payment of the issue fee, (3) in not withdrawing the application from issuance under 37 CFR § 1.313 after the payment of the issue fee, and (4) in not deferring issuance of the patent under 37 CFR § 1.314 until the outstanding *Petition* was considered are errors under 35 U.S.C. § 251 that are correctable by reissue.

The Office continues to refuse the question which was originally put to it, that is, whether the *Terminal Disclaimer* is necessary or unnecessary, or the question presented in the present reissue, that is, whether the errors that occurred from April 8, 1999, to January 30, 2001 in failing to process the *Petition* are "errors" as defined in the reissue statute. In failing to process the *Petition*, in changing course during prosecution of the present reissue application, in delaying by at least two years the prosecution of the present reissue application, and in subsequent responses allegedly justifying the failure to respond to the *Petition*, there appears to be an utter disregard for procedures promulgated by the Patent Office, namely the processing of a properly filed petition under 37 CFR § 1.182. It appears that the Official Action and prior communications from the Office are more and more clearly becoming arbitrary and capricious, particularly in light of the clear guidance of the MPEP and previous decisions. From the

facts of record and noted in the present communication, it is clear that the public was put on notice of Applicant's intent to withdraw the *Terminal Disclaimer*, and that the terminal portion of the '991 patent was never freely dedicated to the public. The present reissue application seeks correction of these errors.

The Appellants respectfully submit that at least the error of the Examiner and the U.S. Patent Office in failing to consider and act upon a *Petition Under 37 CFR § 1.182 to Withdraw a Terminal Disclaimer* filed 21 months before issuance of a patent is an error under 35 U.S.C. § 251.

35 U.S.C. § 251, Reissue of Defective Patents,<sup>5</sup> sets forth the following:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The Federal Circuit and its predecessor, the Court of Customs and Patent Appeals (CCPA), have generally held that the reissue statute "is remedial in nature, based upon fundamental principles of equity and fairness, and should be construed liberally."<sup>6</sup> However, the reissue statute "was not enacted as a panacea for all patent prosecution problems, nor as a grant to the patentee of a second opportunity to prosecute *de novo* his original application" (790 F.2d at 1582). In the present application, the Patentee does not

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<sup>5</sup> Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).

<sup>6</sup> *In re Weiler*, 790 F.2d 1576, 1579, 229 USPQ 673, 675 (Fed. Cir. 1986); see also *In re Doyle*, 293 F.3d 1355, 1358, 63 USPQ2d 1161 (Fed. Cir. 2002); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 1479-80, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998); and *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993).

seek a second opportunity to prosecute *de novo* his application. Rather, the Patentee seeks a decision on a *Petition* that should have occurred during prosecution, but, due to errors on the part of both the Applicant and the Patent Office itself, such *Petition* was not timely decided. In any event, the determination of whether "error" has occurred under 35 U.S.C. § 251 may depend upon the facts of each case.

The errors which are relied upon to support the present reissue application are unquestionably errors upon which a reissue can be based. Among the errors in question in the present reissue application is the error of the Examiner/USPTO in failing to consider and act upon the *Petition to Withdraw* filed 21 months prior to issuance of the subject '991 patent. As noted in detail below, the Official Action attempts to characterize the present reissue as merely an attempt to withdraw the *Terminal Disclaimer* after issuance of a patent. The Appellants have not made such an error. By the present reissue, the Appellants are not merely asking the Patent Office to correct the Appellants error in waiting until after issuance of the patent to withdraw the *Terminal Disclaimer*. Rather, the Appellants seek correction of an ongoing error, particularly a failure to consider the *Petition to Withdraw* on April 8, 1999, which occurred in between the filing of the *Petition to Withdraw*, persisted until issuance of the case on January 30, 2001, a period of about 21 months, and continues to this day. On April 8, 1999, 21 months before issuance of the '991 patent, the Applicant properly filed a *Petition Under 37 CFR § 1.182 To Withdraw a Terminal Disclaimer*. The Patent Office never acted on this *Petition to Withdraw*, and the present reissue application seeks correction of this error, namely the failure to consider the *Petition to Withdraw*.

In a *Preliminary Letter* filed with the present reissue application, the Applicant notes the similarities between the present reissue application and the facts in the Board's decision in Ex parte Durckheimer et al., Appeal No. 94-2004, U.S. Application Ser. No. 07/551,615. The Official Action asserts that the present reissue application is distinguishable from the Durckheimer decision. Specifically, the Official Action asserts that a reading of the Durckheimer decision "reveals on page 21 ... that there was 'an unique set of facts and circumstances wherein the claims which were secured by the

filing of the terminal disclaimer were canceled before the patent was granted.” (page 3, Paper No. 2). The Applicant respectfully disagrees and traverses the above assertions in the Official Action. As noted in detail below, it appears that the Official Action has taken page 21 of the Durckheimer decision out of context.

In fact, the present reissue application is very similar to the Durckheimer decision. At the time of filing the *Terminal Disclaimer* in the present case, the claims were different from the claims as ultimately allowed. In the Official Action, it is implied that the facts of the present application differ from the “unique set of facts and circumstances” (page 3, Paper No. 2, citing page 21 of Durckheimer). The Applicant respectfully disagrees.

In Durckheimer, the claims which were subject to a terminal disclaimer were canceled rendering the terminal disclaimer moot. Similarly, in the present application, the claims of the '235 application were substantively amended on August 14, 1997, November 14, 1997, May 11, 1998, and November 4, 1998, thereby rendering the *Terminal Disclaimer* unnecessary and inappropriate. As in Durckheimer, the *Terminal Disclaimer* was proper at the time it was filed, and the *Terminal Disclaimer* later became unnecessary because of amendments to the claims. Due to the above-referenced amendments, the claims which were secured by the *Terminal Disclaimer* were no longer pending in the case, and none of the claims of the issued patent would have been subject to an obviousness-type double patenting rejection. Like Durckheimer, the *Terminal Disclaimer* in the present application does not secure claims that were issued in the '991 patent. Therefore, the amendments obviated the purpose for which the terminal disclaimer had been originally filed. Therefore, the Applicant's request to withdraw the *Terminal Disclaimer* should be granted, and the aforementioned errors should be corrected by the present reissue application.

Furthermore, the facts of the present case are even more favorable than in Durckheimer because the Applicant, 21 months before issuance, filed a subsequent *Petition to Withdraw* and brought such *Petition* to the attention of the Examiner in a subsequent *Amendment*. Also in Durckheimer, the Applicants successfully withdrew a

terminal disclaimer even after issuance of the patent and even though no attempt was made to request such withdrawal prior to issuance.

In *Durckheimer*, the Board found that a reissue application proceeding was a proper mechanism to withdraw a terminal disclaimer from an issued patent. Specifically, the Board in the *Durckheimer* case states that when the record establishes that a terminal disclaimer has become unnecessary, an error within the meaning of 35 U.S.C. § 251 may have occurred by the patent Applicants' or their appointed representative's failure to petition or to take some other action to nullify or expunge the terminal disclaimer from the application file prior to issuance of a patent (*Ex parte Durckheimer et al.* at 16; emphasis added). It is significantly more clear that an error within the meaning of § 251 has occurred when an Applicant has in fact taken the further step of noting an unnecessary *Terminal Disclaimer* in a petition under § 1.182, that subsequent errors by the Applicants or the Patent Office would also constitute errors within the meaning of § 251 and are therefore suitable for a reissue application, and that the public interest has been protected.

There are three grounds for denying reissue set forth in MPEP § 1490 and reiterated in the *Durckheimer* decision, and the facts of the present reissue application do not support such grounds for denying reissue. The Applicant submits that a terminal disclaimer does not alter the term of the original patent and that a terminal disclaimer is only a disclaimer of a terminal part of the term of the patent granted or to be granted; therefore, a reissue in the present case does not extend the term of the original patent sought to be reissued under § 251 (*Ex parte Durckheimer et al.*, at 18-21). Also, the Applicant submits that the present reissue application was filed without any changes to the original patent claims; therefore, recapture is not an issue (*Id.*). Further, the Applicant submits that the present reissue application does not seek to challenge the propriety of a double patenting rejection that prompted the *Terminal Disclaimer* sought to be withdrawn; therefore, the above-referenced errors are proper and within the meaning of § 251 (*Id.* at 21-23). Still further, the Applicant submits that some of the errors noted in the present reissue application are inadvertent errors for failure to take

advantage of an opportunity of or to follow Office procedure before a patent issues; therefore, such errors are not *per se* a ground for denying reissue (*Id.* at 23-25). Even further, the Applicant submits that the error by the Office in failing to consider the properly filed *Petition to Withdraw* is clearly an error within the meaning of § 251. As such, the present reissue should not be barred.

Also, it appears that the procedures set forth in the MPEP favor the Appellants' position that errors occurred within the meaning of § 251. MPEP § 1490.VII.A sets forth the following: "[T]here is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. Since the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition ... Under appropriate circumstances, consistent with the orderly administration of the examination process, the nullification of a recorded terminal disclaimer may be addressed by filing a petition under 37 CFR 1.182 requesting withdrawal of the recorded terminal disclaimer." The Appellants respectfully submit that the *Petition* in the present case fully complies with MPEP § 1490.VII.A. But for the errors set forth in the present reissue application, there was no reason for the Office to fail to process and act upon the *Petition*.

It is noted that MPEP § 1490.VII.A cautions that "[p]etitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of the terminal disclaimer have not been favorably considered." In the present application, the *Petition* does not seek to reopen the question of the propriety of the double patenting rejection that prompted the filing of the *Terminal Disclaimer*. Rather, the *Petition* explains that "the claims in the above-identified application have since been amended and it is now believed that the previously applied double patenting rejection no longer is applicable" and, specifically, that "the pending claims are different from the patented claims at least with respect to the recited lower limit of the carbon



concentration.” In other words, the *Petition* makes clear that the obviousness type double patenting rejection simply does not apply to the claims.

In various Decisions and Official Actions provided by the Office in the '235 application and the present '902 reissue application, the Office has refused to decide whether the *Petition* was proper. Rather, the Office has referred to MPEP § 1490.VII.B or decisions cited in MPEP § 1490.VII.B. Specifically, the Office of Petitions, in its *Decision on Petition*, mailed May 10, 2001, cites MPEP § 1490.VII.B at page 1, n1. Also, the Office of Petitions, in its *Decision Denying Petition*, mailed November 8, 2001, cites MPEP § 1490.VII.B at page 4; Ex parte Anthony, 230 USPQ 467 (PTO Bd. App. 1982) at page 6; and Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935) at page 7. MPEP § 1490.VII.B clearly does not apply to MPEP § 1490.VII.A or the facts of the present application. Ex parte Anthony and Altoona are discussed in greater detail below.

The Appellants wish to clarify a point regarding the quotation of the “unhappy circumstance” in MPEP § 1490.VII.A, in the *Decision on Petition*, mailed May 10, 2001 (page 1, n3), and in the *Decision Denying Petition*, mailed November 8, 2001 (page 5). Specifically, these decisions state that the “Petitioner is, nevertheless, confronted with what has been characterized as ‘an unhappy circumstance’, rather than a circumstance necessitating relief” (page 1, *Decision on Petition*, mailed May 10, 2001). That is, the Office has attempted to categorize the circumstances of the present application as an unhappy circumstance that does not necessitate relief. However, it appears that the Office of Petitions has mischaracterized the holding in a CCPA decision and misapplied the holding set forth in the CCPA decision. Specifically, this portion of the MPEP states the following:

While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an “unhappy circumstance” in In re Jentoft, 392 F.2d 633, 157 USPQ 363 (CCPA 1968), there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. Since the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal

disclaimer, relief from this unhappy circumstance may be available by way of petition or by refiling the application (other than by refiling it as a CPA).

Also, In re Jentoft states the following: "It is an unhappy circumstance to file a terminal disclaimer in a case where, on appeal, it turns out to have been unnecessary" (at n6). That is, In re Jentoft does not actually relate to a situation where an Applicant has filed a petition under § 1.182 to withdraw a *Terminal Disclaimer* prior to issuance of a patent. Rather, in In re Jentoft, the CCPA simply ruled that a terminal disclaimer is effective to obviate a double patenting rejection. The holding in In re Jentoft does not state that a petition under § 1.182 to withdraw a *Terminal Disclaimer* prior to issuance of a patent is an "unhappy circumstance" or is a situation that does not necessitate relief. Rather, MPEP § 1490.VII.A, after describing an "unhappy circumstance," goes on to suggest precisely the action that was taken by the Applicant, i.e. filing a petition under § 1.182 to withdraw a *Terminal Disclaimer* prior to issuance of a patent.<sup>7</sup> As noted above with respect to Ex parte Durckheimer, the MPEP was specifically amended to include a suggestion that it is desirable for an Applicant to file a petition under § 1.182 to withdraw a *Terminal Disclaimer* that is no longer necessary due to subsequent prosecution.

Although the courts have heard cases involving withdrawal of a *Terminal Disclaimer*, to the best of the Appellants' knowledge, unlike the present application, most of these cases, including those cited by the Office, involve situations where the Applicant delayed a request to remove such *Terminal Disclaimer* until after issuance of the patent. For example, in Ex parte Anthony, 230 USPQ 467 (PTO Bd. App. 1982), the Board considered a question of whether it is possible through reissue to correct an allegedly erroneous filing of a *Terminal Disclaimer*. However, in Ex parte Anthony, the Applicant never substantively traversed an obviousness type double patenting rejection during prosecution. In contrast, in the present application, in a *Petition Under 37 CFR § 1.182 to Withdraw a Terminal Disclaimer* filed on April 9, 1999, the Applicant argued that "the

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<sup>7</sup> MPEP § 1490.VII.A: "Under appropriate circumstances, consistent with the orderly administration of the examination process, the nullification of a recorded terminal disclaimer may be addressed by filing a petition under 37 CFR 1.182 requesting withdrawal of the recorded terminal disclaimer."

claims in the above-identified application have since been amended and it is now believed that the previously applied double patenting rejection no longer is applicable” and that “the pending claims are different from the patented claims at least with respect to the recited lower limit of the carbon concentration.” Also, in an *Amendment* filed on the same date, the Applicant specifically brought the *Petition* to the Examiner’s attention and stated that “filed herewith is a Petition to Withdraw ... in view of the claim amendments effected since the obviousness-type double patenting rejection was first applied.” Therefore, the present application is favorably distinguished from the holding in Ex parte Anthony.

Further distinctions may be gleaned from MPEP § 1490.VII.B, which states, in part, the following: “As a general principle, public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner - e.g., intervening rights in the case of a reissue patent. See, e.g., Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935).” There are several important distinctions between MPEP § 1490.VII.B, the facts in Altoona, and the present application. The “disclaimer” in Altoona was not a *Terminal Disclaimer* and the respondent in Altoona did not file such disclaimer before issuance of a patent. Rather, in Altoona, a disclaimer was “filed by respondent shortly before trial ... to add the flywheel device ...” (U.S. 477 at 480). Second, in the present application, the Applicant never freely dedicated to the public the terminal portion of the term of the ‘991 patent. The record clearly shows that the Applicant, during prosecution and 21 months prior to issuance, sought to withdraw the *Terminal Disclaimer* and never intended to freely dedicate to the public the terminal portion of the ‘991 patent.

In its communications to date, the Office appears to ignore the clear holding in Altoona, namely that public policy does not favor the restoration to the patent owner of “something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner.” The Applicant respectfully submits that upon filing of the *Petition to Withdraw* on April 8, 1999, the public was on notice that the

Applicant did not freely dedicate the terminal portion of the ultimate '991 patent to the public. Furthermore, the Altoona case has nothing to do with terminal disclaimers, and certainly does not address a situation where an Applicant timely and properly petitioned the Office to withdraw a terminal disclaimer prior to issuance of a patent, and where the Office fails to consider the petition. Therefore, the terminal portion of the '991 patent was never freely dedicated to the public. Further, the Applicant respectfully submits that public policy does not favor taking from the patent owner something that has not been freely dedicated to the public. Unless the present reissue examines the error in question, the patent owner will be deprived of something that has not been freely dedicated to the public.

As such, the Appellants respectfully submit that the error of the Examiner and the U.S. Patent Office in failing to consider and act upon a *Petition Under 37 CFR § 1.182 to Withdraw a Terminal Disclaimer* filed 21 months before issuance of a patent is an error under 35 U.S.C. § 251 that is correctable by reissue, and that the errors of the Applicant (1) in failing to ensure proper disposition of the *Petition Under 37 CFR § 1.182 to Withdraw a Terminal Disclaimer*, (2) in not withdrawing the application from issuance under 37 CFR § 1.313 before the payment of the issue fee, (3) in not withdrawing the application from issuance under 37 CFR § 1.313 after the payment of the issue fee, and (4) in not deferring issuance of the patent under 37 CFR § 1.314 until the outstanding *Petition* was considered are errors under 35 U.S.C. § 251 that are correctable by reissue.

B. Whether claims 1-35 should be rejected as being based on a defective reissue basis under 35 U.S.C. § 251.

The Official Action mailed April 10, 2007, asserts that "there is no unexpired part of the term of the original patent" (page 2, Paper No. 20061214). The Official Action ignores the errors in the present application (discussed in detail above) and asserts that the *Terminal Disclaimer* has ended the term of the '991 patent. The Appellants respectfully disagree and traverse the assertions in the Official Action. The facts in the present reissue are distinguished from the facts in In re Morgan, 990 F.2d 1230, 26

USPQ2d 1392 (Fed. Cir. 1993).<sup>8</sup> As noted above, the expiration date of the present '991 patent is January 30, 2018. Therefore, there is an unexpired part of the term of the original '991 patent.

C. Whether claims 1-35 should be rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. § 251.

The Official Action mailed April 10, 2007, continues to assert that the "reissue oath/declaration filed with this application is defective because none of the errors, which are relied upon to support the reissue application, are errors upon which a reissue can be based" (page 3, *Id.*, citing 37 CFR § 1.175(a)(1) and MPEP § 1414). The Appellants respectfully disagree and traverse the assertion in the Official Action.

37 CFR § 1.175(a)(1) states that the reissue oath must state that "The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue." The Appellants respectfully submit that the reissue oath/declaration filed with the present reissue application is not defective; that the Appellants believe the original patent to be wholly or partly inoperative or invalid by reason of the patentee claiming more or less than the patentee had the right to claim in the patent; that the Applicant, during prosecution, clearly stated at least one error being relied upon as the basis for reissue (reproduced above at n4); and that the errors which are relied upon to support the reissue application are errors upon which a reissue can be based.

Specifically, in the *Reissue Application Declaration by the Inventor*, the Applicant stated the following: "I verily believe the original patent to be wholly or partly inoperative or invalid ... by reason of the patentee claiming more or less than he had the right to claim in the patent ... [and] by reason of other errors." The Applicant presented facts

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<sup>8</sup> U.S. Patent No. 3,900,645 expired seventeen years after issuance on August 19, 1992, and the '645 patent expired while the appeal was pending. Therefore, the reissue application was considered defective.

related to the present reissue application and five errors upon which the present reissue is based. Having made such statements in the *Declaration*, the Appellants respectfully submit that the *Declaration* fully complies with 37 CFR § 1.175 and is not defective.

Therefore, the Appellants respectfully submit that the errors set forth in the present reissue declaration are errors under 35 U.S.C. § 251 that are correctable by reissue, that the basis for the reissue is proper, and that the reissue oath/declaration is proper.

For the reasons set forth in the '235 and '902 applications and in the present appeal, the *Petition Under 37 CFR § 1.182 To Withdraw a Terminal Disclaimer* should be granted, the *Terminal Disclaimer* should be withdrawn, and the face of the patent should be corrected by reissuing the '991 patent in order to delete the following on the face of the patent: "This patent is subject to a terminal disclaimer." If other suitable remedies are available to correct the errors in the present patent, the Appellants respectfully request that such actions be taken. If further discussions would expedite prosecution of this application, please contact the undersigned.

Respectfully submitted,



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APPENDIX A  
PENDING CLAIMS

**NOTE: Pursuant to MPEP § 1454, claims are presented in reissue format.**

1. A semiconductor device comprising:

a substrate; and

a non-single crystalline semiconductor layer formed over said substrate, said semiconductor layer comprising amorphous silicon and including at least hydrogen; and

at least one intrinsic or substantially intrinsic region formed within said semiconductor layer;

at least one N-type or P-type region formed within said semiconductor layer; and

at least one NI or PI junction between said intrinsic or substantially intrinsic region and said N-type or P-type region,

wherein carbon is present in said intrinsic or substantially intrinsic region and the concentration of said carbon is less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup>.

2. The semiconductor device of claim 1 wherein said concentration of said carbon is not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup>.

3. A semiconductor device according to claim 1 wherein said intrinsic or substantially intrinsic region is formed by a chemical vapor deposition.



4. A semiconductor device comprising:

a substrate; and

a non-single crystalline semiconductor layer formed over said substrate, said semiconductor layer comprising silicon and including at least hydrogen; and

at least one intrinsic or substantially intrinsic region formed within said semiconductor layer;

at least one N-type or P-type region formed within said semiconductor; and

at least one NI or PI junction between said intrinsic or substantially intrinsic region and said N-type or P-type region,

wherein carbon is present in said intrinsic or substantially intrinsic region and the concentration of said carbon is less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup>.

5. The semiconductor device of claims 1 or 4, wherein a concentration of boron in said intrinsic or substantially intrinsic region is not higher than  $2 \times 10^{17}$  atoms/cm<sup>3</sup>.

6. The semiconductor device of claims 1 or 4, wherein a concentration of phosphorus in said N-type region is higher than  $1 \times 10^{19}$  atoms/cm<sup>3</sup>.

7. The semiconductor device of claims 1 or 4 wherein said N-type region comprises microcrystalline silicon.

8. The semiconductor device of claims 1 or 4, wherein said intrinsic or substantially intrinsic region has a thickness of 0.5  $\mu\text{m}$ .

9. A semiconductor device according to claim 4 wherein said intrinsic or substantially intrinsic region is formed by a chemical vapor deposition.

10. A semiconductor device comprising:

a substrate; and

an amorphous semiconductor layer of intrinsic or substantially intrinsic conductivity type formed over said substrate, said semiconductor layer comprising silicon and including at least hydrogen; and

at least one NI or PI junction formed with said amorphous semiconductor layer,

wherein carbon is present in said semiconductor layer and the concentration of said carbon is less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup>.

11. The semiconductor device of claim 10, wherein a concentration of boron in said semiconductor layer is not higher than  $2 \times 10^{17}$  atoms/cm<sup>3</sup>.

12. The semiconductor device of claim 10, further comprising an N-type semiconductor layer in contact with said amorphous semiconductor layer to form said NI junction therebetween, wherein a concentration of phosphorus in the N-type layer is

higher than  $1 \times 10^{19}$  atoms/cm<sup>3</sup>.

13. The semiconductor device of claim 10, where said semiconductor layer has a thickness of 0.5  $\mu$ m.

14. A semiconductor device comprising:

a substrate; and

an amorphous semiconductor layer of intrinsic or substantially intrinsic conductivity type formed over said substrate, said semiconductor layer comprising silicon and including at least hydrogen; and

an N-type microcrystalline semiconductor layer comprising silicon in contact with said amorphous semiconductor layer to form at least one NI or PI junction,

wherein carbon is present in said semiconductor layer and the concentration of said carbon is less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup>.

15. A semiconductor device according to claim 10 wherein said amorphous semiconductor layer is formed by a chemical vapor deposition.

16. A non-single-crystalline semiconductor material comprising silicon having at least one junction formed between a substantially intrinsic or intrinsic semiconductor material and a one conductivity type semiconductor material, said junction being one of NI and PI junctions, said semiconductor material containing at least hydrogen and

wherein carbon is present in said substantially intrinsic or intrinsic semiconductor material in an amount less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup>.

17. A non-single crystalline semiconductor material according to claim 16 wherein said substantially intrinsic or intrinsic semiconductor material is formed by a chemical vapor deposition.

18. An amorphous semiconductor material comprising silicon having at least one junction formed between a substantially intrinsic or intrinsic semiconductor material and a one conductivity type semiconductor material, said junction being one of NI and PI junctions, said semiconductor material containing at least hydrogen and wherein carbon is present in said substantially intrinsic or intrinsic semiconductor material in an amount less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup>.

19. The semiconductor material of claims 16 or 18, wherein the concentration of boron contained in said substantially intrinsic or intrinsic semiconductor material is not higher than  $2 \times 10^{17}$  atoms/cm<sup>3</sup>.

20. The semiconductor material of claims 16 or 18, further comprising an N-type semiconductor layer in contact with said amorphous semiconductor layer to form said NI junction therebetween, wherein a concentration of phosphorus in the N-type layer is

higher than  $1 \times 10^{19}$  atoms/cm<sup>3</sup>.

21. The semiconductor material of claims 16 or 18, further comprising an N-type semiconductor layer in contact with said amorphous semiconductor layer to form said NI junction therebetween, wherein the N-type layer comprises microcrystalline silicon.

22. The semiconductor material of claims 16 or 18, wherein said substantially intrinsic or intrinsic semiconductor material has a thickness of 0.5  $\mu\text{m}$ .

23. An amorphous semiconductor material according to claim 18 wherein said substantially intrinsic or intrinsic semiconductor material is formed by a chemical vapor deposition.

24. A semiconductor device comprising:

a substrate; and

a non-single crystalline semiconductor layer formed over said substrate, said semiconductor layer comprising silicon and including at least hydrogen; and

at least one intrinsic or substantially intrinsic region formed within said semiconductor layer;

at least one N-type or P-type region formed within said semiconductor layer; and

at least one NI or PI junction between said intrinsic or substantially intrinsic region and said N-type or P-type region,

wherein carbon is present in said intrinsic or substantially intrinsic region and the concentration of said carbon is less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup>, and at least a portion of said intrinsic or substantially intrinsic region contains boron in a concentration  $1 \times 10^{15}$  to  $2 \times 10^{17}$ .

25. A semiconductor device according to claim 24 wherein said intrinsic or substantially intrinsic region is formed by a chemical vapor deposition.

26. A semiconductor device comprising:

a substrate; and

a non-single crystalline semiconductor layer of intrinsic or substantially intrinsic conductivity type formed over said substrate, said semiconductor layer comprising silicon and including at least hydrogen; and

at least one NI or PI junction formed with said non-single crystalline semiconductor layer,

wherein carbon is present in said intrinsic or substantially intrinsic region and the concentration of said carbon is less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup>, and at least a portion of said intrinsic or substantially intrinsic region contains boron in a concentration  $1 \times 10^{15}$  to  $2 \times 10^{17}$ .

27. A semiconductor device according to claim 26 wherein said non-single crystalline semiconductor layer is formed by a chemical vapor deposition.

28. A semiconductor device comprising:

a substrate; and

a non-single crystalline semiconductor layer formed over said substrate, said semiconductor layer comprising amorphous silicon including at least hydrogen; and

at least one N-type or P-type region formed within said semiconductor layer;

at least one second region formed within said semiconductor layer, said second region having a different conductivity type from said at least one N-type or P-type region;

at least one junction between said N-type or P-type region and said second region,

wherein carbon is present in said second region and the concentration of said carbon is less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup>.

29. A semiconductor device according to claim 28 wherein said second region is formed by a chemical vapor deposition.

30. A semiconductor device comprising:

a substrate; and

an amorphous semiconductor layer formed over said substrate, said semiconductor layer comprising silicon and including at least hydrogen; and

at least one junction formed with said amorphous semiconductor layer,

wherein carbon is present in said semiconductor layer and the concentration of said carbon is less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup>.

31. A semiconductor device according to claim 30 wherein said amorphous semiconductor layer is formed by a chemical vapor deposition.

32. A semiconductor device comprising:

a substrate; and

an amorphous semiconductor layer formed over said substrate, said semiconductor layer comprising silicon and including at least hydrogen; and

an N-type semiconductor layer comprising silicon in contact with said amorphous semiconductor layer to form at least one junction,

wherein carbon is present in said semiconductor layer and the concentration of said carbon is less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup>.

33. A semiconductor device according to claim 32 wherein said amorphous semiconductor layer is formed by a chemical vapor deposition.

34. An amorphous semiconductor material comprising silicon having at least one junction formed between a first semiconductor material and a second semiconductor material having a different conductivity type from said first semiconductor material, said first semiconductor material containing at least hydrogen



and wherein carbon is present in said first semiconductor material in an amount less than  $4 \times 10^{18}$  atoms/cm<sup>3</sup> and not lower than  $4 \times 10^{15}$  atoms/cm<sup>3</sup>.

35. An amorphous semiconductor material according to claim 34 wherein said first semiconductor material is formed by a chemical vapor deposition.

APPENDIX B  
REFERENCES

Copies attached.

APPENDIX C  
EVIDENCE APPENDIX

Not applicable.

APPENDIX D  
RELATED PROCEEDINGS APPENDIX

Not applicable.

APPENDIX E  
COURTESY COPIES

Copies attached.

## B. REFERENCES OF RECORD

1. U.S. Patent No. 6,180,991 to Yamazaki

## E. COURTESY COPIES

1. *Petition Under 37 CFR § 1.182 to Withdraw a Terminal Disclaimer* on April 9, 1999

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT Application of ) Art Unit: 2815  
Shunpei YAMAZAKI )  
Serial No. 08/426,235 ) Examiner: S. Meier  
Filed: April 21, 1995 )  
For: PHOTOELECTRIC CONVERSION )  
DEVICE AND METHOD OF )  
MAKING THE SAME )

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on 4/8/99.

*Kristin M. Johnson*

PETITION UNDER 37 CFR §1.182 TO WITHDRAW

A TERMINAL DISCLAIMER

Honorable Assistant Commissioner for Patents

Washington, D.C. 20231


Sir:

It is respectfully requested that the Terminal Disclaimer filed November 29, 1996 be withdrawn. The instant Terminal Disclaimer was filed to overcome an obviousness-type double patenting rejection applied in a previous Office Action in the above-identified application. However, the claims in the above-identified application have since been amended and it is now believed that the previously-applied double patenting rejection no longer is applicable. Specifically, the pending claims are different from the patented claims at least with respect to the recited lower limit of the carbon concentration.

Submitted herewith is the \$130 petition fee in accordance with 37 CFR 1.17(h).

Should there be any question regarding this matter the appropriate representative of the U.S. Patent and Trademark Office is invited to contact the undersigned.

Respectfully submitted,

  
Eric J. Robinson  
Reg. No. 38,285

Sixbey, Friedman, Leedom & Ferguson, P.C.  
8180 Greensboro Drive, Suite 800  
McLean, Virginia 22102  
(703) 790-9110

## 2. 37 CFR § 1.182

memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; paras. (d) and (g), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (c) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; paras. (a), (a)(2)-(3), (c)-(e) & (g) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a)(3) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

### § 1.182 Questions not specifically provided for.

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the

authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

[47 FR 41278, Sept. 17, 1982, effective date Oct. 1, 1982; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

### § 1.183 Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

[47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

### § 1.184 [Reserved]

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

## APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

### § 1.191 Appeal to Board of Patent Appeals and Interferences.

Appeals to the Board of Patent Appeals and Interferences under 35 U.S.C. 134(a) and (b) are conducted according to part 41 of this title.

[46 FR 29183, May 29, 1981; para. (a), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (d), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; paras. (b) and (d) amended, para. (e) added, 54 FR 29553, July 13, 1989, effective Aug. 20, 1989; para. (d) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; paras. (a) and (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001;



3. 35 U.S.C. § 251

that Act specifically cites this Act and provides that it shall take precedence over this Act.

(b) Nothing in this chapter is intended to alter the effect of the laws cited in paragraph (a) of this section or any other laws with respect to the disposition of rights in inventions made in the performance of funding agreements with persons other than nonprofit organizations or small business firms.

(c) Nothing in this chapter is intended to limit the authority of agencies to agree to the disposition of rights in inventions made in the performance of work under funding agreements with persons other than nonprofit organizations or small business firms in accordance with the Statement of Government Patent Policy issued on February 18, 1983, agency regulations, or other applicable regulations or to otherwise limit the authority of agencies to allow such persons to retain ownership of inventions, except that all funding agreements, including those with other than small business firms and nonprofit organizations, shall include the requirements established in section 202(c)(4) and section 203 of this title. Any disposition of rights in inventions made in accordance with the Statement or implementing regulations, including any disposition occurring before enactment of this section, are hereby authorized.

(d) Nothing in this chapter shall be construed to require the disclosure of intelligence sources or methods or to otherwise affect the authority granted to the Director of Central Intelligence by statute or Executive order for the protection of intelligence sources or methods.

(e) The provisions of the Stevenson-Wydler Technology Innovation Act of 1980 shall take precedence over the provisions of this chapter to the extent that they permit or require a disposition of rights in subject inventions which is inconsistent with this chapter.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3026.)

(Subsection (c) amended Nov. 8, 1984, Public Law 98-620, sec. 501(13), 98 Stat. 3367.)

(Subsection (e) added Oct. 20, 1986, Public Law 99-502, sec. 9(c), 100 Stat. 1796.)

(Subsection (a)(4) amended July 5, 1994, Public Law 103-272, sec. 5(j), 108 Stat. 1375.)

(Subsection (e) amended Mar. 7, 1996, Public Law 104-113, sec. 7, 110 Stat. 779.)

(Subsection (a) amended Nov. 13, 1998, Public Law 105-393, sec. 220(c)(2), 112 Stat. 3625.)

(Subsections (a)(11), (a)(20), and (c) amended Nov. 2, 2002, Public Law 107-273, sec. 13206, 116 Stat. 1905.)

### **35 U.S.C. 211 Relationship to antitrust laws.**

Nothing in this chapter shall be deemed to convey to any person immunity from civil or criminal liability, or to create any defenses to actions, under any antitrust law.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3027.)

### **35 U.S.C. 212 Disposition of rights in educational awards.**

No scholarship, fellowship, training grant, or other funding agreement made by a Federal agency primarily to an awardee for educational purposes will contain any provision giving the Federal agency any rights to inventions made by the awardee.

(Added Nov. 8, 1984, Public Law 98-620, sec. 501(14), 98 Stat. 3368.)

## **PART III — PATENTS AND PROTECTION OF PATENT RIGHTS**

### **CHAPTER 25 — AMENDMENT AND CORRECTION OF PATENTS**

Sec.

251 Reissue of defective patents.

252 Effect of reissue.

253 Disclaimer.

254 Certificate of correction of Patent and Trademark Office mistake.

255 Certificate of correction of applicant's mistake.

256 Correction of named inventor.

### **35 U.S.C. 251 Reissue of defective patents.**

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original

patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

### **35 U.S.C. 252 Effect of reissue.**

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are substantially identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are substantially identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

A reissued patent shall not abridge or affect the right of any person or that person's successors in business who, prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the use of, to offer to sell, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported unless the making, using, offering for sale, or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before

which such matter is in question may provide for the continued manufacture, use, offer for sale, or sale of the thing made, purchased, offered for sale, used, or imported as specified, or for the manufacture, use, offer for sale, or sale in the United States of which substantial preparation was made before the grant of the reissue, and the court may also provide for the continued practice of any process patented by the reissue that is practiced, or for the practice of which substantial preparation was made, before the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

(Amended Dec. 8, 1994, Public Law 103-465, sec. 533(b)(2), 108 Stat. 4989; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-566 (S. 1948 sec. 4507(8)).)

### **35 U.S.C. 253 Disclaimer.**

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent and Trademark Office, and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

### **35 U.S.C. 254 Certificate of correction of Patent and Trademark Office mistake.**

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Director may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be con-

4. *Terminal Disclaimer* filed November 27, 1996

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT application of )  
Shunpei YAMAZAKI )  
Serial No. 08/426,235 ) Art Unit: 2503  
Filed: April 21, 1995 ) Examiner: S. Miller  
For: PHOTOELECTRIC CONVERSION )  
DEVICE AND METHOD OF )  
MAKING THE SAME )

TERMINAL DISCLAIMER

Honorable Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

I, Dr. Shunpei Yamazaki, having a place of business at Semiconductor Energy Laboratory Co., Ltd., 398 Hase Atsugi-shi, Kanagawa-ken, 243 Japan, state that I am authorized to sign on behalf of the assignee of this invention and that the Assignment referred to below has been reviewed and certify that, to the best of its knowledge and belief, the entire right, title and interest in the above-identified application is in the name of Semiconductor Energy Laboratory Co., Ltd. by virtue of an Assignment recorded in the U.S. Patent and Trademark Office at Reel 4211, Frame 997.

Semiconductor Energy Laboratory Co., Ltd. hereby disclaims, except as

provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 4,581,476. Semiconductor Energy Laboratory Co., Ltd. hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and prior Patent Nos. 4,581,476; 4,591,892; 5,349,204; and 5,315,132 are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.


In making the above disclaimer, Semiconductor Energy Laboratory Co., Ltd. does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior Patent No. 4,581,476, as presently shortened by any terminal disclaimer, in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 35 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States

Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

March 23, 1996

Date

  
Name: Shunpei Yamazaki  
Title: President  
Company Name: Semiconductor Energy  
Laboratory Co., Ltd.

5. MPEP § 1490, Part VII (Withdrawing a Recorded Terminal Disclaimer), Subpart A (Before Issuance of Patent)
6. MPEP § 1490, Part VII (Withdrawing a Recorded Terminal Disclaimer), Subpart B (After Issuance of Patent) .



ument(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel\_\_\_\_, Frame\_\_\_\_" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From:\_\_\_\_ To:\_\_\_\_" blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b), e.g., when signing a terminal disclaimer or a power of attorney.

#### Examiner Note:

1. This form paragraph can be used to provide applicant samples of a terminal disclaimer which contains the necessary clauses to overcome an obviousness-type double patenting rejection over a prior patent and a Statement to be signed by an assignee to ensure compliance with 37 CFR 3.73(b).

2. Note that the requirements for compliance with 37 CFR 3.73(b) have been made more liberal, such that certain specifics of the sample statement are no longer required. At present, in order to comply with 37 CFR 3.73(b), the assignee's ownership interest must be established by (a) filing in the application or patent evidence of a chain of title from the original owner to the assignee and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11, or (b) specifying in the record of the application or patent where such evidence is recorded in the Office (e.g., reel and frame number, etc.). The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee.

(See your Technology Center Paralegal or Special Program Examiner for copies of the sample terminal disclaimer and Statement Under 37 CFR 3.73(b) to enclose with the Office action. Alternatively, it is permissible to copy the sample terminal disclaimer found after MPEP § 1490 and the Sample Statement Under 37 CFR 3.73(b) found after MPEP § 324.)

#### ¶ 14.39 Sample Assignee Statement Under 37 CFR 3.73(b) Enclosed

Enclosed with this Office action is a sample Statement under 37 CFR 3.73(b) which an assignee may use in order to ensure compliance with the Rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel\_\_\_\_, Frame\_\_\_\_" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From:\_\_\_\_ To:\_\_\_\_" blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b).

#### Examiner Note:

1. This form paragraph can be used to provide applicant a sample of a Statement to be signed by an assignee to ensure compliance with 37 CFR 3.73(b).

2. Note that the requirements for compliance with 37 CFR 3.73(b) have been made more liberal, such that certain specifics of the sample statement are no longer required. At present, in order to comply with 37 CFR 3.73(b), the assignee's ownership interest must be established by (a) filing in the application or patent evidence of a chain of title from the original owner to the assignee and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11, or (b) specifying in the record of the application or patent where such evidence is recorded in the Office (e.g., reel and frame number, etc.). The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee.

(See your Technology Center Paralegal or Special Program Examiner for a copy of the sample Statement Under 37 CFR 3.73(b) to enclose with the Office action. Alternatively, it is permissible to copy the sample Statement Under 37 CFR 3.73(b) found after MPEP § 324.)

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## VII. WITHDRAWING A RECORDED TERMINAL DISCLAIMER

If timely requested, a recorded terminal disclaimer may be withdrawn before the application in which it is filed issues as a patent, or in a reexamination proceeding, before the reexamination certificate issues. After a patent or reexamination certificate issues, it is unlikely that a recorded terminal disclaimer will be nullified.

### A. Before Issuance Of Patent

While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "unhappy circumstance" in *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968), there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. Since the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition or by refiling the application (other than by refiling it as a CPA).

Under appropriate circumstances, consistent with the orderly administration of the examination process,

the nullification of a recorded terminal disclaimer may be addressed by filing a petition under 37 CFR 1.182 requesting withdrawal of the recorded terminal disclaimer. Petitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of the terminal disclaimer have not been favorably considered. The filing of a continuing application other than a CPA, while abandoning the application in which the terminal disclaimer has been filed, will typically nullify the effect of a terminal disclaimer. The filing of a Request for Continued Examination (RCE) of an application under 37 CFR 1.114 will not nullify the effect of a terminal disclaimer, since a new application has not been filed, but rather prosecution has been continued in the existing application.

### B. After Issuance Of Patent

The mechanisms to correct a patent — Certificate of Correction (35 U.S.C. 255), reissue (35 U.S.C. 251), and reexamination (35 U.S.C. 305) — are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer. As a general principle, public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner — e.g., intervening rights in the case of a reissue patent. See, e.g., *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U.S. 477, 24 USPQ 308 (1935).

Certificates of Correction (35 U.S.C. 255) are available for the correction of an applicant's mistake. The scope of this remedial provision is limited in two ways — by the nature of the mistake for which correction is sought and the nature of the proposed correction. *In re Arnott*, 19 USPQ2d 1049 (Comm'r Pat. 1991). The nature of the mistake for which correction is sought is limited to those mistakes that are:

- (A) of a clerical nature,
- (B) of a typographical nature, or
- (C) of a minor character.

The nature of the proposed correction is limited to those situations where the correction does not involve changes which would:

- (A) constitute new matter, or
- (B) require reexamination.

A mistake in filing a terminal disclaimer does not fall within any of the categories of mistake for which a certificate of correction of applicant's mistake is permissible, and any attempt to remove or nullify the effect of the terminal disclaimer would typically require reexamination of the circumstances under which it was filed.

Although the remedial nature of reissue (35 U.S.C. 251) is well recognized, reissue is not available to correct all errors. It has been the Office position that reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent. First, the reissue statute only authorizes the Director of the USPTO to reissue a patent "for the unexpired part of the term of the original patent." Since the granting of a reissue patent without the effect of a recorded terminal disclaimer would result in extending the term of the original patent, reissue under these circumstances would be contrary to the statute. Second, the principle against recapturing something that has been intentionally dedicated to the public dates back to *Leggett v. Avery*, 101 U.S. 256 (1879). The attempt to restore that portion of the patent term that was dedicated to the public to secure the grant of the original patent would be contrary to this recapture principle. Finally, applicants have the opportunity to challenge the need for a terminal disclaimer during the prosecution of the application that issues as a patent. "Reissue is not a substitute for Patent Office appeal procedures." *Ball Corp. v. United States*, 729 F.2d 1429, 1435, 221 USPQ 289, 293 (Fed. Cir. 1984). Where applicants did not challenge the propriety of the examiner's obvious-type double patenting rejection, but filed a terminal disclaimer to avoid the rejection, the filing of the terminal disclaimer did not constitute error within the meaning of 35 U.S.C. 251. *Ex parte Anthony*, 230 USPQ 467 (Bd. App. 1982), *aff'd*, No. 84-1357 (Fed. Cir. June 14, 1985).

Finally, the nullification of a recorded terminal disclaimer would not be appropriate in a reexamination proceeding. There is a prohibition (35 U.S.C. 305) against enlarging the scope of a claim during a reexamination proceeding. As noted by the Board in *Anthony, supra*, if a terminal disclaimer was nullified, "claims would be able to be sued upon for a longer

period than would the claims of the original patent.  
Therefore, the vertical scope, as opposed to the hori-

zontal scope (where the subject matter is enlarged),  
would be enlarged.”

## 7. Reissue Declaration

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## REISSUE APPLICATION DECLARATION BY THE INVENTOR

Docket Number (Optional)

740756-2405

As a below named inventor, I hereby declare that:

My residence, mailing address and citizenship are stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is described and claimed in patent number 6,180,991, granted January 30, 2001, and for which a reissue patent is sought on the invention entitled SEMICONDUCTOR HAVING LOW CONCENTRATION OF PHOSPHOROUS

the specification of which

☒ is attached hereto.☐ was filed on \_\_\_\_\_ as reissue application number \_\_\_\_\_ / \_\_\_\_\_  
and was amended on \_\_\_\_\_

(If applicable)

I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below.  
(Check all boxes that apply.)☐ by reason of a defective specification or drawing.☒ by reason of the patentee claiming more or less than he had the right to claim in the patent.☒ by reason of other errors.

At least one error upon which reissue is based is described below. If the reissue is a broadening reissue, such must be stated with an explanation as to the nature of the broadening.

The subject U.S. Patent No. 6,180,991 issued on January 30, 2001 from application Ser. No. 08/426,235 filed on April 21, 1995.

In the '235 application, a *Terminal Disclaimer* was filed at the beginning of prosecution which disclaimed the terminal part of the statutory term of any patent granted that would extend beyond an issued patent commonly assigned to the assignees of the '235 application. During the course of prosecution, the claims of the '235 application were substantively amended, thereby rendering the *Terminal Disclaimer* unnecessary and inappropriate. Correspondingly, a *Petition Under 37 CFR 1.182 To Withdraw A Terminal Disclaimer* (hereinafter "*Petition to Withdraw*") was filed on April 8, 1999. However, prior to the USPTO's consideration and action on the *Petition to Withdraw*, the '235 application was allowed and the issue fee paid so that the application issued as the subject U.S. Patent No. 6,180,991 with the *Terminal Disclaimer* of record still in effect.

Therefore, the errors upon which this reissue is based are:

1. The error of the applicants in failing to ensure proper disposition of the *Petition to Withdraw* during the prosecution of the '235 application;
2. The error of the applicants in not withdrawing the '235 application from issuance under 37 CFR 1.313 before the payment of the issue fee;

[Page 1 of 3]

Burden Hour Statement: This form is estimated to take 0.5 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETE FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

NVA207357.2

(REISSUE APPLICATION DECLARATION BY THE INVENTOR, page 2)

Docket Number (Optional)  
740756-2405

3. The error of the applicants in not withdrawing the '235 application from issuance under 37 CFR 1.313 after the payment of the issue fee;
4. The error of the applicants in not deferring issuance of the patent under 37 CFR 1.314 until the outstanding *Petition to Withdraw* was considered; and
5. The error of the Examiner/USPTO in failing to consider and act upon the *Petition to Withdraw* filed 21 months prior to issuance of the subject '991 patent.

The above errors have resulted in rendering the subject '991 patent inoperative during its terminal part of the statutory term that extends beyond the expiration date of the patent identified in the *Terminal Disclaimer* of record. In addition, the above errors have also resulted in rendering the subject '991 patent inoperative in that it is only enforceable for and during a period that it and the various patents identified in the *Terminal Disclaimer* of record are commonly owned. Furthermore, in failing to withdraw the *Terminal Disclaimer*, the applicant also believes the '991 patent is partly inoperative by reason that the patentee claimed less than the patentee had the right to claim in regards to the term of the '991 patent.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## (REISSUE APPLICATION DECLARATION BY THE INVENTOR, page 3)

Docket Number (Optional)

740756-2405

All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant. As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the United States Patent and Trademark Office connected therewith.

Name(s)	Registration Number	Name(s)	Registration Number
Daniel W. Sixbey	20,932	Eric J. Robinson	38,285
Stuart J. Friedman	24,312	Marc S. Kaufman	35,212
Charles M. Leedom, Jr.	26,477	Daniel S. Song	43,143
David S. Safran	27,997	James E. Howard	39,175
Thomas W. Cole	28,290	Corinne R. Gorski	34,339
Donald R. Studebaker	32,815	Jason H. Vick	45,285
Jeffrey L. Costellia	35,483	Luan C. Do	38,434
Tim L. Brackett, Jr.	36,092		

Correspondence Address: Direct all communications about the application to:

☒ Customer Number

22204

Type Customer Number here

Place Customer Number Bar  
Code Label here☐ Firm or  
Individual Name

Address

Address

City

State

Zip

Country

Telephone

Fax

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.

Full name of sole or first inventor (given name, family name)

Shunpei YAMAZAKI

Inventor's signature

Date 01/15/2002

Residence Tokyo, Japan

Citizenship Japan

Mailing Address 4-10-20, Seijo, Setagaya-ku, Tokyo 157, Japan

Full name of second joint inventor (given name, family name)

Inventor's signature

Date

Residence

Citizenship

Mailing Address

Full name of third joint inventor (given name, family name)

Inventor's signature

Date

Residence

Citizenship

Mailing Address

☐ Additional joint inventors are named on separately numbered sheets attached hereto.

(Page 3 of 3)

8. In re Weiler, 790 F.2d 1576, 229 USPQ 673 (Fed. Cir. 1986)



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*790 F.2d 1576, \*; 1986 U.S. App. LEXIS 20071, \*\*;  
229 U.S.P.Q. (BNA) 673*

IN RE ELMAR W. WEILER and RICHARD L. MANSELL

Appeal No. 85-2085

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

790 F.2d 1576; 1986 U.S. App. LEXIS 20071; 229 U.S.P.Q. (BNA) 673

May 8, 1986

**PRIOR HISTORY: [\*\*1]**

Appealed from: U.S. Patent and Trademark Office Board of Appeals.

**CASE SUMMARY**

**PROCEDURAL POSTURE:** Appellants sought review of a decision of the United States Patent and Trademark Office Board of Appeals, affirming the patent examiner's rejection of two claims in a reissue application filed under 35 U.S.C.S. § 251.

**OVERVIEW:** Appellants' application for reissue of a patent under 35 U.S.C.S. § 251 was denied by the patent examiner. The board of appeals affirmed the denial and appellants sought review. The court on appeal held that the decision was not clearly erroneous where appellants sought to claim a subject matter that was entirely distinct from anything previously claimed or intended to be claimed, and were not seeking to obtain a broader or narrower claim to subject matter that was claimed in the patent proffered for surrender. According to the court, the error appellants claimed was not an error that reissue could remedy because the statute did not grant a second opportunity to present the original application de novo, and appellants' failure to claim the particular subject matter was not due to an "error" under § 251. The decision sustaining the rejection of appellants' patent claims in the reissue application was affirmed.

**OUTCOME:** The court affirmed the decision that sustained the rejection

of patent claims in a reissue application where appellants sought to claim a subject matter entirely distinct from anything previously claimed or intended to be claimed, and were not seeking to obtain a broader or narrower claim to the subject matter claimed in a patent proffered for surrender.

**CORE TERMS:** subject matter, reissue, invention, patent, original patent, divisional, disclosure, original application, examiner, non-elected, inventor, limonin, antibodies, compound, ignorance, right to claim, elected, specification, patentee, notation, labeled, quantitative analysis, written description, cancellation, inadvertent, meaningless, inoperative, predecessor, enablement, deliberate

LexisNexis(R) Headnotes ♦ [Hide Headnotes](#)

Patent Law > U.S. Patent & Trademark Office Proceedings > Filing Requirements > Drawings

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN1** See 35 U.S.C.S. § 251.



Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN2** In enacting 35 U.S.C.S. § 251, Congress provided a statutory basis for correction of "error." The statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally. Nonetheless, not every event or circumstance that might be labeled "error" is correctable by reissue.



Patent Law > Jurisdiction & Review > Standards of Review > General Overview

**HN3** This court reviews decisions, not the mere language of an opinion.



When that language indicates an erroneous basis for the decision, the decision will be reversed.

Patent Law > Claims & Specifications > Description Requirement > General Overview

Patent Law > U.S. Patent & Trademark Office Proceedings > Continuation Applications > General Overview

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Broadening Reissues & Recapture

**HN4** The whole purpose of the reissue statute, 35 U.S.C.S. § 251, so far as claims are concerned, is to permit limitations to be added to claims that are too broad or to be taken from claims that are too narrow.



Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN5** The question of support in the disclosure is a 35 U.S.C.S. § 112 inquiry. If there be no such support, the inquiry ends there, and reissue cannot be obtained. Thus, all consideration of 35 U.S.C.S. § 251 must await that threshold section 112 determination.



Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN6** One cannot assert error in failing to claim that which was not disclosed at all, or that which was not so disclosed as to indicate that the inventor was possessed of the invention as it is being claimed in the reissue application.



Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN7** A showing that an applicant had an intent to claim matter he did not claim can go a long way to support a finding that error occurred; and, conversely, a showing that an applicant never had any such intent makes a finding of error extremely difficult if not impossible.



Patent Law > U.S. Patent & Trademark Office Proceedings > Examinations > Amendments & Prohibition Against New Matter

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN8** References to "intent to claim," though occasionally including 35

↓ U.S.C.S. § 112 considerations, resolve ultimately into the question of error. Determining what protection an inventor intended to secure by an original patent for the purposes of 35 U.S.C.S. § 251 is an essentially factual inquiry confined to the objective intent manifested by the original patent.

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN9** Absence of compliance with 35 U.S.C.S. § 112 will foreclose a finding of  
↓ "intent" and preclude grant of the reissue, but, as indicated above, that absence dooms the application in any event. The converse is not true. Compliance with section 112 does not alone establish "intent to claim" and does not alone establish error in a failure to claim.

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Requirements

**HN10** The "intent to claim" approach is merely one factor that sheds  
↓ light upon whether the claims of the reissue application are directed to the same invention as the original patent and whether the reissue would correct an inadvertent error in the original patent.

Patent Law > U.S. Patent & Trademark Office Proceedings > Examinations > Amendments & Prohibition Against New Matter

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN11** It is not enough for reissue that an invention might have been  
↓ claimed in the original patent because it was suggested or indicated in the specification. It must appear from the face of the instrument that what is covered by the reissue was intended to have been covered and secured by the original.

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN12** Though the term "error" is to be interpreted liberally, Congress  
↓ did not intend to alter the test of "inadvertence, accident, or mistake" established in relation to the pre-1952 statutes.

Patent Law > U.S. Patent & Trademark Office Proceedings > Continuation Applications > Divisionals & Restrictions

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN13** By acquiescing in the examiner's restriction requirement, and  
↓ failing to file divisional applications on the subject matter of non-elected claims, a party forecloses (because that is not error) his right to claim that subject matter.

**COUNSEL:** William D. Stokes, of Alexandria, Virginia, argued for appellants.

Richard E. Schafer, Associate Solicitor, U.S. Patent and Trademark Office, or Arlington, Virginia, argued for Appellee. With him on the brief were Joseph F. Nakamura, Solicitor and Fred E. McKelvey, Deputy Solicitor.

**JUDGES:** Markey, Chief Judge, Davis and Bissell, Circuit Judges.

**OPINION BY:** MARKEY

**OPINION:** [\*1578] MARKEY, Chief Judge.

Weiler and Mansell (Weiler) appeal from a decision of the United States Patent and Trademark Office Board of Appeals (board), App. No. 600-54 (Dec. 31, 1984), affirming the examiner's rejection of claims 13 and 19 in a reissue application filed under 35 U.S.C. § 251 (1982). We affirm.

### *Background*

Weiler filed an application on May 8, 1980, containing 11 claims. During prosecution, the examiner held that the application contained "three independent and distinct inventions" and required restriction between Claims 1-7 (assay method), Claims 8 and 11 (an "organic compound" in class 260/343.42), and Claims 9 and 10 (a "protein compound" in class 260/121). Weiler elected to prosecute **[\*\*2]** Claims 1-7. Those claims were allowed without amendment, and the application issued on December 15, 1981 as U.S. Patent No. 4,305,923 ('923 patent) for a "Method for Quantitative Analysis for Limonin".

#### *1. U.S. Patent No. 4,305,923*

The seven claims of the patent are independent claim 1 and dependent claims 2-7. Claim 1 reads:

1. A method for quantitative analysis of limonin which comprises reacting a known amount of limonin-specific antibodies, with a mixture of a known volume of sample containing an unknown amount of limonin and a known amount of a limonin-derivative labeled with an enzyme or with a radioactive isotope, determining the amount of labeled limonin-derivative which has reacted with said antibodies and calculating therefrom the unknown amount of limonin in said sample.

#### *2. The Reissue Application*

Weiler did not contest the examiner's requirement for restriction and did not file a divisional application, to assert the non-elected claims or any other claims.

On August 18, 1982, Weiler filed application Serial No. 408,497 to reissue the '923 patent. In his Declaration, Weiler said the '923 patent was partly inoperative or invalid **[\*\*3]** by reason of his having claimed less than he had a right to claim, and that that deficiency "exists because of errors which were made without deceptive intent on my part."

Weiler alleged "an extraordinary sequence of events which preceded and followed the inadvertent abandonment of original claims 8-11" which made him aware that the invention of the '923 patent was not adequately claimed. His Declaration set forth: (1) a June 23, 1981 letter from patent attorney Earl Tyner to Manzell (co-inventor of the '923 invention) confirming Manzell's authorization to file a divisional application on claims 8-11; (2) Tyner's July 2, 1981 letter to Bryan Burgess (Office of General Counsel, University of Florida), about filing a divisional application; and (3) a January 19, 1982 letter to Mansell from Arthur Yeager, a partner in Tyner's firm, stating that a divisional application had not been filed.

The Declaration further stated that "on being made aware of the failure to timely file the divisional application," *Mansell* consulted with patent attorney William D. Stokes (counsel of record here), who drafted a set of claims which, he said in the Declaration, "should have been made in the **[\*\*4]** original application."

#### *3. The Reissue Claims*

The reissue application contained 20 claims. Claim 13 reads:

13. A method for developing citrus fruit strains low in limonin content, which method comprises identifying by the use of limonin-specific antibodies as a analytical reagent the limonin-low mutants in a breeding or cell culture program, and propagating said mutants.

Claim 19 reads:

19. A gamma globulin fraction comprising antibodies reactive with limonin, said antibodies being formed consequent [\*1579] to injecting into an animal a limonin-protein conjugate.

Claims 1-12 and 20 were allowed by the examiner. Claim 2 was cancelled by Weiler. Claims 13-19 were rejected, and that rejection was appealed to the board.

#### 4. The Board's Action

The board agreed with the examiner's view that "failure to timely file a divisional application including non-elected claims is a deliberate act and not error in the prosecution of the original patent" (citing *In re Orita*, 550 F.2d 1277, 193 U.S.P.Q. (BNA) 145 (CCPA 1977)). It sustained the rejection of claims 14-18 on that ground, i.e., because they are "directed to the [\*\*5] same subject matter as the non-elected conjugate claims 9 and 10" of the original application. Claims 14-18 are not before us on appeal.

The board sustained the rejection of claims 13 and 19 on this specific ground:

Appeal claims 13 and 19 are directed to subject matter not claimed at all in the original application. As to them, the Examiner's reliance on the case of *In re Rowand et al.* is entirely correct and that decision is controlling. Here, as in that case, "there is nothing in the original patent evidencing that appellants intended to claim (this now claimed subject matter)" (526 F.2d 558, 560, 187 U.S.P.Q. (BNA) 487 at 489).

#### Issue

Whether the board erred in sustaining the rejection of claims 13 and 19.

#### OPINION

##### Introduction

The starting place is the statute itself, 35 U.S.C. § 251:

**HN1** ↑ Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had [\*\*6] a right to claim in the patent, the Commissioner shall, on surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

**HN2** In enacting the statute, Congress provided a statutory basis for correction of "error". The statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally. In re Bennett, 766 F.2d 524, 528, 226 U.S.P.Q. (BNA) 413, 416 (Fed. Cir. 1985) (in banc); Ball Corp. v. United States, 729 F.2d 1429, 1439 n.28, 221 U.S.P.Q. (BNA) 289, 296 n.28 (Fed. Cir. 1984); In re Hay, 534 F.2d 917, 919, 189 U.S.P.Q. (BNA) 790, 791 (CCPA 1976). Nonetheless, not every event or circumstance that might be labeled "error" is correctable by reissue.

#### A. The Parties' Contentions

Weiler says the subject matter of neither [\*\*7] claim 13 nor claim 19 constitutes "an independent and distinct invention" from that secured by the original patent, because both subject matters constituted part of the invention which was intended or sought to be secured by the original patent.

Pointing to the letters about a divisional application, on other claims, Weiler says his failure to claim the subject matter of claims 13 and 19 was not deliberate or purposeful, but was caused by the prosecuting attorney's error. He says that "but for the inventors' ignorance of patent drafting technique, their lack of knowledge of claiming technique, and their attorney's obvious lack of understanding of the invention, the subject matter of the part of the invention covered by claims 13 and 19 would have been included in the original patent."

The Solicitor's brief concedes that some minimal support for claims 13 and 19 appears in the patent's specification, but argues that "mere disclosure of this subject matter does not demonstrate an intent to [\*1580] claim this subject matter." The Solicitor's brief also argues that "if a mistake was made [in not filing a divisional application], it is not the type of mistake which can be corrected [\*\*8] by reissue," citing In re Orita, 550 F.2d 1277, 1281, 193 U.S.P.Q. (BNA) 145, 149 (CCPA 1977). n1

----- Footnotes -----

n1 Because the rejection of claims 14-18 is not appealed, the parties' discussion of the reasons why Weiler failed to file divisional applications on the subject matter of those claims, Weiler's evidence consisting of letters about divisional applications on non-elected claims 8-11, and the Solicitor's reliance on Orita, are irrelevant.

----- End Footnotes -----

#### B. The Board's Opinion

In its opinion, the board said, as above indicated, that the subject matter of claims 13 and 19 "was not claimed at all in the original application" (emphasis added), and that nothing in the patent evidenced an "intent to claim" that subject matter, citing In re Rowand, 526 F.2d 558, 560, 187 U.S.P.Q. (BNA) 487, 489 (CCPA 1975), as controlling authority.

**HN3** This court reviews decisions, not the mere language of an [\*\*9] opinion. When that language indicates an erroneous basis for the decision, the decision will be reversed, but that is not the case here. The board's language, while infelicitous, simply meant that Weiler's failure to have ever claimed, broadly or narrowly or otherwise, the subject matter of claims 13 and 19, and his failure to show an "intent to claim" that subject matter, indicated absence of the statutorily required "error."

The board's language reflected its well founded recognition that Weiler was seeking to claim subject matter entirely distinct from anything anywhere earlier claimed or attempted or intended to be claimed, and was not seeking to obtain a broadened or narrowed claim to subject matter claimed in the patent proffered for surrender. In dealing with that more common circumstance, one of our predecessor courts

said **HN4** "the whole purpose of the [reissue] statute, so far as claims are concerned, is to permit limitations to be added to claims that are too broad or to be taken from claims that are too narrow." In re

Handel, 50 C.C.P.A. 918, 312 F.2d 943, 948, 136 U.S.P.Q. (BNA) 460, 464 (CCPA 1963). [\*\*10]

### C. Disclosure

Weiler argues, on the basis of loose language which, taken out of context, would appear to say that one looks only to see whether the subject matter of a reissue claim appears in the disclosure, and, if it does, a reissue applicant must be granted allowance of that claim. See D. Chisum, Patents, § 15.03[3] at 15-53

(1985); I. Kayton, Kayton on Patents, § 22-64 (1985). But <sup>HN5</sup> the question of support in the disclosure is a § 112 inquiry. If there be no such support, the inquiry ends there, and reissue cannot be obtained. Thus, all consideration of § 251 must await that threshold § 112 determination. In the present case, as above indicated, there is some minimal support for the subject matter of claims 13 and 19.

When, unlike the present case, a reissue applicant seeks to obtain a broadened version of a claim in the patent, one may look to see whether the disclosure "reasonably conveys to one skilled in the art that the inventor had possession of the broad invention at the time the original application was filed." In re Peters, 723 F.2d 891, 894, 221 U.S.P.Q. (BNA) 952, 954 (Fed. Cir. 1984). [\*\*11] That language speaks to the reason why the inventor failed to claim more broadly an invention he had claimed in the patent. It does not speak to the present case, in which Weiler did not claim the subject matter of the reissue claims "at all," to use the board's phrase. The language referring to the "disclosure" in *Peters*, and in other cases dealing

with reissue, is directed ultimately to the question of error. <sup>HN6</sup> One cannot assert error in failing to claim that which was not disclosed at all, or that which was not so disclosed as to indicate that the inventor was possessed of the invention as it is being claimed in the reissue application.

Weiler's argument that the subject matter of claims 13 and 19 does not constitute "an independent and distinct invention" [\*\*1581] merely because that subject matter can be found somewhere in the overall disclosure of the '923 patent is meaningless. As above indicated, the subject matter must have been disclosed, § 112, or there is no basis for discussing whether the invention being claimed on reissue is independent or distinct. Moreover, § [\*\*12] 251 authorizes reissue for "the" invention disclosed in the original patent, not for just "any" and "every" invention for which one may find some support in the disclosure of the original patent.

The subject matter of claims 13 and 19 are clearly independent of and distinct from each other, from that of elected claims 1-7, from that of non-elected organic compound claims 8 and 11, and from that of non-elected protein compound claims 9 and 10. Weiler would thus have had no right to insert and present claims 13 and 19 in the original application after the examiner's requirement for restriction.

Here too, the question redounds to one of error, for when an applicant makes some disclosure, as Weiler did, of as many as five distinct inventions, claims one, and ignores the rest, it is difficult to find error in the failure to claim those ignored on the sole basis that they were disclosed. To so hold would render meaningless the statutory requirement that an applicant point out and distinctly claim subject matter he regards as his invention. 35 U.S.C. § 112, 2d para. n2

----- Footnotes -----

n2 I. Kayton, Kayton on Patents, § 22-64 (1985) ("the predecessor to our present statute required that a reissue application be for 'the same invention' rather than for 'the invention disclosed' in the original patent . . . Now it is only necessary to compare the reissue *claims* with the disclosure in the parent patent for the purpose of determining whether they are supported as required by 35 USC § 112" (emphasis in original)). As indicated in the text, compliance with § 112 is a threshold consideration, but such compliance does not establish error in a failure to claim every invention disclosed.

----- End Footnotes ----- [\*\*13]

### D. "Intent to Claim"

Language appearing first in the opinion in U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp., 315 U.S. 668, 676, 53 U.S.P.Q. (BNA) 6, 9-10, 86 L. Ed. 1105, 62 S. Ct. 839 (1942), has been

picked up and has metamorphosed into a requirement that an applicant show his original "intent to claim" the subject matter of the reissue claim sought. The phrase "intent to claim" does not appear in the statute. It is but judicial shorthand, signifying a means of measuring whether the statutorily required error is

present. Clearly, <sup>HN7</sup> a showing that an applicant had an intent to claim matter he did not claim can go a long way to support a finding that error occurred; and, conversely, a showing that an applicant never had any such intent makes a finding of error extremely difficult if not impossible.

<sup>HN8</sup> References to "intent to claim" in our cases, though occasionally including § 112 considerations, resolve ultimately into the question of error. "Determining [\*\*14] what protection [an inventor] intended to secure by [an] original patent for the purposes of § 251 is an essentially factual inquiry confined to the objective intent manifested by the original patent." In re Rowand, 526 F.2d 558, 560, 187 U.S.P.Q. (BNA) 487, 489 (CCPA 1975) (emphasis in original). As explained in a later decision, Rowand's test of "intent to claim" was not one of "intent" per se, but looked to "objective indicia of intent." In re Mead, 581 F.2d 251, 256, 198 U.S.P.Q. (BNA) 412, 417 (CCPA 1978). The court in Mead analogized that evidence of "intent" to the written description requirement of § 112, first paragraph, i.e., "a written description of the invention, and of the manner and process of making and using it." See also In re Peters, 723 F.2d 891, 894, 221

U.S.P.Q. (BNA) 952, 954 (Fed. Cir. 1984). It is true that <sup>HN9</sup> absence of compliance with § 112 will foreclose a finding of "intent" and preclude grant of the reissue, but, as indicated above, that absence dooms the application in any event. The converse [\*\*15] is not true. Compliance with § 112 does not alone establish "intent to claim" and does [\*\*1582] not alone establish error in a failure to claim. n3

----- Footnotes -----

n3 One commentator has recently stated: "The intent test and the *U.S. Industrial Chemicals* statement [see text *infra*] are perhaps best understood as expressions of the 'description of the invention' requirement, which the Court of Customs and Patent Appeals recognizes as distinct from the enablement requirement." D. Chisum, *Patents*, § 15.03[3] at 15-53 (1985). The commentator could not have meant that compliance with § 112's enablement requirement is sufficient in itself to warrant an automatic finding of "intent" and a resulting reissue, in disregard of § 251's requirement to show error.

----- End Footnotes -----

This court has recently moved the "intent to claim" approach toward closer conformity with the statute, describing it as <sup>HN10</sup> merely one factor "that sheds light [\*\*16] upon whether the claims of the reissue application are directed to the same invention as the original patent and the reissue would correct an inadvertent error in the original patent." In re Hounsfeld, 699 F.2d 1320, 1323, 216 U.S.P.Q. (BNA) 1045, 1048 (Fed. Cir. 1982) (emphasis added).

#### E. "Error"

Thus, we arrive at the central question in this appeal, which is not whether there is disclosure, but whether Weiler has established "error" which can be remedied by reissue. The reissue statute was not enacted as a panacea for all patent prosecution problems, nor as a grant to the patentee of a second opportunity to prosecute *de novo* his original application.

The language of *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. at 676, 53 U.S.P.Q. (BNA) at 9-10, is relevant here:

<sup>HN11</sup> It is not enough that an invention *might have been claimed* in the original patent because it was suggested or indicated in the specification. It must appear from the face of the instrument that what is covered by the reissue was intended [\*\*17] to have been covered and secured by the original. [Emphasis added.]



Weiler and the Solicitor argue as though the "error" to be corrected by reissue were a subjective error. It is not. We do not here deal with "deceptive intention."

**HN12** ↑ Though the term "error" is to be interpreted liberally, *In re Wesseler*, 367 F.2d 838, 84, 152 U.S.P.Q. (BNA) at 339, 348 (CCPA 1966), Congress did not intend to alter the test of "inadvertence, accident, or mistake" established in relation to the pre-1952 statutes. *In re Wadlinger*, 496 F.2d 1200, 1207, 181 U.S.P.Q. (BNA) 826, 831 (CCPA 1974). See *In re Mead*, 581 F.2d 251, 257, 198 U.S.P.Q. (BNA) 412, 418 (CCPA 1978) ("conscious choice" not to file continuing application not "error"); *In re Clark*, 522 F.2d 623, 626, 187 U.S.P.Q. (BNA) 209, 212 (CCPA 1975) (dereliction in duty of candor not "error"); *In re Byers*, 43 C.C.P.A. 803, 230 F.2d 451, 454, 109 U.S.P.Q. (BNA) 53 (CCPA 1956) (deliberate amendment of claim not "error"). See also *In re Petrov*, 56 C.C.P.A. 710, 402 F.2d 485, 159 U.S.P.Q. (BNA) 449 (CCPA 1968) ["\*18] (cancellation of claim in original application was "error"); *In re Willingham*, 48 C.C.P.A. 727, 282 F.2d 353, 127 U.S.P.Q. (BNA) 211 (CCPA 1960) (cancellation of claim was "error").

As above indicated, the discussions in the briefs concerning the failure to assert the non-elected claims in a divisional application are irrelevant. Those claims are not on appeal and were drawn to subject matter distinct from that of claims 13 and 19. Though Weiler *might have* filed a divisional application containing claims 13 and 19, there is nothing of record remotely indicating that Weiler or his counsel or anyone else ever thought of doing so, or ever intended doing so, or failed to do so only through error.

Significantly, Weiler accepted issuance of the '923 patent with its claims to a single elected invention.

**HN13** ↑ By acquiescing in the examiner's restriction requirement, and failing to file divisional applications on the subject matter of non-elected claims, Weiler foreclosed (because that was not error) his right to claim that subject matter. If it were not error to forego divisional applications on subject matter to which claims had been made in the original application, ["\*19] it cannot on the present record have been error to forego divisional applications on subject matter to which claims had never been made. Nor has Weiler made any ["\*1583] showing on which error could be found as the cause of his failure to claim the subject matter of claims 13 and 19. n4

----- Footnotes -----

n4 Weiler's reliance on allegations of the inventors' ignorance of drafting and claiming technique and counsel's ignorance of the invention is unavailing. Those allegations could be frequently made, and, if accepted as establishing error, would require the grant of reissues on anything and everything mentioned in a disclosure. Weiler supplies no facts indicating how the ignorance relied on caused any error as the basis of his failure to claim the subject matter of claims 13 and 19. As indicated in the text § 251 does not authorize a patentee to re-present his application. Insight resulting from hindsight on the part of new counsel does not, in every case, establish error.

----- End Footnotes -----

The board's notation that the subject matter ["\*20] of claims 13 and 19 was "not claimed at all" in the original application, and its finding that nothing in the original patent evidences Weiler's "intent to claim" that subject matter, reflect non-statutory language used by courts and others to support and convey the concept that an inventor's failure to claim particular subject matter was not the result of the "error" required by § 251. Having made that notation and finding, the board should have stated the resulting basis (no error) for its decision. That it did not do so does not require reversal in this case, in which the record clearly supports the notation and finding. Weiler has not shown that either was clearly erroneous, and Weiler has shown nothing in the record that would have required the board to determine that his failure to claim the subject matter of claims 13 and 19 was the result of error.

AFFIRMED.

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9. In re Doyle, 293 F.3d 1355, 63  
USPQ2d 1161 (Fed. Cir. 2002)

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*293 F.3d 1355, \*; 2002 U.S. App. LEXIS 11635, \*\*;  
63 U.S.P.Q.2D (BNA) 1161*

IN RE MICHAEL P. DOYLE

01-1439

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

293 F.3d 1355; 2002 U.S. App. LEXIS 11635; 63 U.S.P.Q.2D (BNA) 1161

June 12, 2002, Decided

**PRIOR HISTORY:** [\*\*1] Appealed from: United States Patent and Trademark Office Board of Patent Appeals and Interferences. (Serial no. 08/601,101).

**DISPOSITION:** REVERSED AND REMANDED.

**CASE SUMMARY**

**PROCEDURAL POSTURE:** Plaintiff patent holder appealed from a decision of the United States Patent and Trademark Office Board of Patent Appeals and Interferences, which affirmed the final rejection of certain claims of his reissue application based on the Orita doctrine.

**OVERVIEW:** The invention was a method of using catalysts to catalyze particular classes of chemical reactions. The examiner imposed a 9-way restriction requirement. The holder elected claims directed towards using the genus of catalysts to insert carbenes into certain bonds and cancelled the other claims. After the application issued, the holder did not file any divisional applications towards the nonelected groups. Before the running of the 2-year clock for broadening reissues, the holder filed a request for reissue, seeking to broaden his claims to cover the reaction of his catalysts with a genus of prochiral molecules. The examiner allowed the identical claims but rejected the new claims under the Orita doctrine. The court noted that the issue was one of first impression, i.e.: whether the failure to present a linking claim, a claim broad enough to read on--or link--2 or more groups of claims subject to a restriction requirement, was an error correctable by reissue. The court answered in the affirmative, holding that the reissue

claims came within the mandate of 35 U.S.C.S. § 251, for they were genus claims that read on, but were broader than, the species claims found in the issued patent.

**OUTCOME:** The Board's decision affirming the rejection of the pending claims was reversed, and the matter remanded for further proceedings.

**CORE TERMS:** reissue, patent, nonelected, elected, divisional, subject matter, chiral, examiner, atom, invention, linking, catalyst, genus, original application, complexing, compound, patentee, bonding, ligand, site, prosecuted, bridging, original patent, correctable, broadening, acquiesced, prochiral, metal, ring, public interest

**LexisNexis(R) Headnotes ♦ Hide Headnotes**

Administrative Law > Separation of Powers > Primary Jurisdiction

Patent Law > Double Patenting > Terminal Disclaimers

Patent Law > U.S. Patent & Trademark Office Proceedings > Examinations > General Overview

**HN1** An appeal from a final decision of the United States Patent and Trademark Office Board of Patent Appeals and Interferences rests within the exclusive jurisdiction of the United States Court of Appeals for the Federal Circuit pursuant to 28 U.S.C.S. § 1295 (a) (4) (A).

Patent Law > Double Patenting > Elements

Patent Law > Double Patenting > Terminal Disclaimers

**HN2** Obviousness-type double patenting is judicially created and prohibits an inventor from obtaining a second patent for claims that are not patentably distinct from the claims of the first patent. With obviousness-type double patenting, a terminal disclaimer may overcome that basis for unpatentability, assuming that the first patent has not expired.

Civil Procedure > Appeals > Standards of Review > De Novo Review

Patent Law > Claims & Specifications > Description Requirement > General Overview

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN3** The United States Court of Appeals for the Federal Circuit reviews de novo a legal determination regarding the scope of reissue and the applicability of the Orita doctrine to the undisputed facts of a case made by the United States Patent and Trademark Office Board of Patent Appeals and Interferences.

Patent Law > U.S. Patent & Trademark Office Proceedings > Filing Requirements > Drawings

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN4** See 35 U.S.C.S. § 251.



Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Requirements

**HN5** 35 U.S.C.S. § 251 restricts reissue to situations in which an error occurred--situations that include the patentee having claimed more or less than he had a right to claim in the patent. The statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally. Notwithstanding its remedial nature, § 251 is not a panacea designed to cure every mistake which might be committed by an applicant or his attorney.

Patent Law > Preclusion > General Overview

Patent Law > U.S. Patent & Trademark Office Proceedings > Continuation Applications > Divisionals & Restrictions

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Requirements

**HN6** The failure to file a timely divisional in response to a restriction requirement is not an error correctable by reissue. The so-called Orita doctrine therefore precludes a reissue applicant from obtaining substantially identical claims to those of nonelected groups identified in an examiner's restriction requirement when such claims could not have been prosecuted in the application from which they were restricted.

Patent Law > U.S. Patent & Trademark Office Proceedings > Continuation Applications > Divisionals & Restrictions

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN7** The "error" of failing to file a divisional on the nonelected groups is wholly irrelevant to the question whether any error was present in the patent that issued on the elected claims.

Patent Law > U.S. Patent & Trademark Office Proceedings > Continuation Applications > Divisionals & Restrictions

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Requirements

**HN8** Where the patentee knowingly acquiesces in a restriction requirement, such acquiescence, because it is by definition not inadvertent, cannot be error for purposes of the reissue statute. 35 U.S.C.S. § 251.

Patent Law > U.S. Patent & Trademark Office Proceedings > Continuation Applications > Divisionals & Restrictions

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN9** The Orita doctrine adheres to the previously established principle that applicants are estopped from obtaining by reissue claims which, because of a requirement for a restriction in which they had acquiesced, they could not claim in their patent.

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN10** Reissue lies only for correction of error in an existing patent.

Patent Law > U.S. Patent & Trademark Office Proceedings > Continuation Applications > Divisionals & Restrictions

Patent Law > U.S. Patent & Trademark Office Proceedings > Examinations > General Overview

**HN11** The Manual Pat. Examining P. § 809.04 expressly provides that if a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim.

Patent Law > U.S. Patent & Trademark Office Proceedings > Continuation Applications > Divisionals & Restrictions

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN12** If it was not error to forego divisional applications on subject matter to which claims had been made in the original application, it cannot be error to forego divisional applications on subject matter to which claims have never been made.

Patent Law > Claims & Specifications > Enablement Requirement > General Overview

Patent Law > U.S. Patent & Trademark Office Proceedings > Continuation Applications > Divisionals & Restrictions

**HN13** The co-pendency requirement of 35 U.S.C.S. § 120 refers to the requirement that a patent application filed as a continuation or divisional application upon an originally filed application must be

filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application in order to receive the benefit of the earlier filing date.

Patent Law > Claims & Specifications > Description Requirement > General Overview

Patent Law > Claims & Specifications > Enablement Requirement > General Overview

Patent Law > U.S. Patent & Trademark Office Proceedings > Continuation Applications > Divisionals & Restrictions

**HN14** 35 U.S.C.S. § 121 provides for divisional applications, and allows an invention that has been the subject of a restriction requirement to receive the benefit of the earlier filing date only if filed in accordance with 35 U.S.C.S. § 120.

Patent Law > U.S. Patent & Trademark Office Proceedings > Continuation Applications > Divisionals & Restrictions

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN15** Where a matter sought on reissue could have been presented with the original application, 35 U.S.C.S. §§ 120 and 121 are not implicated.

Patent Law > Ownership > Patents as Property

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Requirements

**HN16** The United States Congress has weighed the benefits and burdens of allowing corrections of error by reissue, and allows broadening reissues, subject, of course, to certain safeguards: the two-year time limitation and intervening rights. 35 U.S.C.S. §§ 251-252.

Patent Law > Claims & Specifications > Description Requirement > General Overview

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Requirements

**HN17** The public knows, or should know, that an issued patent can be broadened by reissue during a two-year period following issuance. The public is, therefore, on notice that at least some matter can be dedicated to the public in error, and that the error, if caught in time, can be corrected by reissue. And, if the patentee succeeds in obtaining a reissue that alters the scope of her right to exclude, then the public interest is protected through intervening rights.

**COUNSEL:** Meredith Martin Addy, Brinks Hofer Gilson & Lione, of Chicago, Illinois, argued for appellant. With her on the brief were Robert N. Carpenter and Jonathan M. Blanchard.

John M. Whealan, Solicitor, Office of the Solicitor, United States Patent and Trademark Office, of Arlington, Virginia, argued for the Director of the United States Patent and Trademark Office. With him on the brief were Mark Nagumo and Henry G. Sawtelle, Associate Solicitors.

**JUDGES:** Before MICHEL, CLEVINGER, and SCHALL, Circuit Judges.

**OPINION BY:** CLEVINGER

**OPINION:**

[\*1356] CLEVINGER, Circuit Judge.

Michael P. Doyle appeals the decision of the Board of Patent Appeals and Interferences ("Board") affirming the final rejection of claims 54 through 71 of his Reissue Application No. 08/601,101 based on the doctrine of In re Orita, 550 F.2d 1277, 193 U.S.P.Q. (BNA) 145 (CCPA 1977). Ex parte Doyle, No. 2000-0601, slip op. at 12 (December 29, 2000), request for reh'g denied (March 22, 2001). Because the

Board erred in extending *Orita* to affirm the rejection of [\*\*2] the pending claims, we reverse and remand.

The invention at issue in this case is a method of using chiral catalysts to catalyze enantioselectively particular classes of chemical reactions. Chiral compounds possess one or more chiral centers—centers that are asymmetric in all dimensions. Like a human hand, a chiral molecule cannot be superimposed on its mirror image, otherwise known as its enantiomer. Altering the relative orientation of the groups bonded to the various chiral centers of a molecule (i.e., creating a different stereoisomer n1 of the compound) can have profound effects on the compound's properties, especially with respect to how the compound interacts with other chiral molecules. These effects are important in pharmaceutical chemistry, among other areas of chemical endeavor, because often only one of the stereoisomers of a particular target compound possesses the desired pharmacological activity. Unfortunately, it is difficult to synthesize only one possible stereoisomer because most reactions produce what is known as a racemic mixture, which is an equal mixture of enantiomers. A category of reactions known as enantioselective reactions, however, will produce [\*\*3] either (ideally) one enantiomer or (somewhat less ideally) a mixture that is enriched in a target enantiomer.

----- Footnotes -----

n1 Compounds that differ only in the relative arrangement of the groups attached to their chiral centers are known as stereoisomers. Enantiomers, which—as noted above—are nonsuperimposable mirror images of one another, are one type of stereoisomer.

----- End Footnotes -----

The inventor, Michael Doyle, developed a genus of chiral transition metal catalysts and a method of using them to perform enantioselective reactions with prochiral starting materials. n2 Dr. Doyle originally filed an application that, according to the examiner, attempted to claim nine different inventions, and included both composition of matter claims and method claims. The examiner imposed a nine-way restriction requirement. Dr. Doyle elected group VI, a group of method claims directed towards using the genus of catalysts to insert carbenes n3 into carbon-hydrogen, oxygen-hydrogen, nitrogen-hydrogen, and silicon-hydrogen bonds. He cancelled the other pending [\*\*4] claims. The groups that he did not elect and that are relevant for purposes of this appeal include the following: (1) Group VII, drawn to a method of forming metal stabilized ylides using a chiral catalyst; (2) Group VIII, drawn to a method of adding a hydrogen atom using a chiral catalyst; and (3) Group IX, drawn to methods of adding silicon and hydrogen or boron and hydrogen using a chiral catalyst. The application eventually issued as U.S. Patent No. 5,296,595 on March 22, 1994. Dr. Doyle did not file any divisional applications directed towards the nonelected groups during the pendency of the application that matured into the '595 patent.

----- Footnotes -----

n2 A prochiral compound is one that, while not yet chiral, can become so when it undergoes a chemical transformation.

N3 A carbene is a CR[2] fragment, where R represents a group bonded to the carbon atom.

----- End Footnotes -----

[\*1357] On February 14, 1996, approximately one month before the running of the two-year clock for broadening reissues, see 35 U.S.C. § 251 (1994), [\*\*5] Dr. Doyle filed a request for reissue of the '595 patent. He gave as his reason for requesting reissue that



the 595 patent is partially defective because the claims are narrower than they should be in view of the 595 patent's disclosure and the prior art. In particular, all 53 claims of the 595 patent are drawn to a method of enantioselectively inserting a carbene with a chiral catalyst. I now believe that the claims should have been broader in order to cover the use of the defined catalysts to enantioselectively catalyze reactions with a prochiral compound.

Thus, Dr. Doyle seeks to broaden his claims to cover the reaction of his catalysts with a genus of prochiral molecules, i.e., not just insertion of a carbene. As Dr. Doyle concedes, the proposed reissue genus claims read on (but are broader than) the claims of nonelected Groups VII-IX.

All of the relevant claims at issue are new claims--not amendments to issued claims. Proposed claim 54 is illustrative of the reissue claims Dr. Doyle seeks:

A method of enantioselectively catalyzing a reaction comprising the steps of:

providing a prochiral compound,

providing a chiral catalyst comprising [\*\*6]

a nucleus with a first and second atom of the same metal aligned on an axis, said metal selected from the group consisting of rhodium, ruthenium, chromium, molybdenum, tungsten, rhenium and osmium; and

first, second, third and fourth bridging ligands oriented radially to the axis,

each ligand having a first and second complexing atom, the first complexing atom of each of said bridging ligands being complexed with said first metal atom, and the second complexing atom of each of said bridging ligands being complexed to said second metal atom,

said first bridging ligand further comprising a ring including said first complexing atom and attached to said second complexing atom, said ring also including a chiral center attached through a first bonding site to said first complexing atom, attached through a second bonding site to said ring, having a third bonding site occupied by a first substituent, and having a fourth bonding site occupied by a second substituent, and

said second bridging ligand further comprising a ring including said second complexing atom and attached to said first complexing atom, said ring also including a chiral center attached through a first bonding site to [\*\*7] said second complexing atom, attached through a second bonding site to said ring, having a third bonding site occupied by a first substituent, and having a fourth bonding site occupied by a second substituent, and wherein the R/S configuration of the chiral center on the second bridging ligand is the same as the R/S configuration of the chiral center on the first bridging ligand, and reacting said prochiral compound and said chiral catalyst under conditions sufficient [sic, to] cause the reaction.

The examiner allowed claims 1-53 of the reissue application, which were identical to the claims of the issued patent, but rejected new claims 54-71. Ex Parte Doyle, slip op. at 1. The examiner based his rejection on three grounds: (1) defective reissue declaration based on failure to specify an error correctable by reissue under the Orita doctrine; (2) recapture; and (3) obviousness-type double patenting over claims 1-13 of U.S. Patent No. 5,175,311. Dr. Doyle appealed the first two grounds to the Board. n4 The Board agreed with Dr. [\*1358] Doyle that the recapture doctrine, which prevents an applicant from recapturing through reissue matter surrendered to overcome a rejection based [\*\*8] on prior art, is inapplicable here because the pertinent claims were not cancelled to overcome prior art. Rather, they were cancelled in response to a restriction requirement without prejudice to refiling. Id. at 11. The Board

agreed with the examiner on the first ground of rejection, i.e., that the reissue declaration was invalid under *In re Orita*. Id. at 4. Doyle now appeals the *Orita* rejection. <sup>HN1</sup> This appeal from a final decision of the Board rests within our exclusive jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(A).

----- Footnotes -----

n4 Dr. Doyle has agreed to file a terminal disclaimer to cure the double-patenting rejection in the event that he prevails on the other ground for rejection. See *In re Lonardo*, 119 F.3d 960, 965, 43 U.S.P.Q.2D (BNA) 1262, 1266 (Fed. Cir. 1997) <sup>HN2</sup> ("Obviousness-type double patenting . . . is judicially created and prohibits an inventor from obtaining a second patent for claims that are not patentably distinct from the claims of the first patent. With obviousness-type double patenting . . . a terminal disclaimer may overcome that basis for unpatentability, assuming that the first patent has not expired" (internal citation omitted)).

----- End Footnotes----- [\*\*9]

II

This case involves a matter of first impression: whether failure to present a so-called linking claim, a claim broad enough to read on—or link—two or more groups of claims subject to a restriction requirement, is an error correctable by reissue. <sup>HN3</sup> We review de novo the Board's legal determination regarding the scope of reissue and the applicability of *In re Orita* to the undisputed facts of this case. *In re Kollar*, 286 F.3d 1326, 1329, 62 U.S.P.Q.2D (BNA) 1425, 1427 (Fed. Cir. 2002).

Section 251 sets forth the requirements for reissuance of a patent:

<sup>HN4</sup> Whenever any patent is, through error without any deceptive intention, deemed wholly or partially inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue. [\*\*10]

35 U.S.C. § 251 (1994) (emphasis added). By its terms <sup>HN5</sup> section 251 restricts reissue to situations in which an error occurred—situations that include the patentee having "claimed more or less than he had a right to claim in the patent." "The statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally." *In re Weiler*, 790 F.2d 1576, 1579, 229 U.S.P.Q. (BNA) 673, 675 (Fed. Cir. 1986). Notwithstanding its remedial nature, "section 251 is not a panacea designed to cure every mistake which might be committed by an applicant or his attorney." *In re Orita*, 550 F.2d at 1281, 193 U.S.P.Q. (BNA) at 149.

Dr. Doyle's reissue application claims appear to come squarely within the mandate of section 251, for they are genus claims that read on, but are broader than, the species claims found in the issued '595 patent. In other words, Dr. Doyle simply seeks a broadening reissue of his '595 patent to cover material that he invented and disclosed, but inadvertently failed to claim in his issued patent. However, our predecessor court long ago held that <sup>HN6</sup> failure to file a timely divisional in response [\*\*11] to a restriction requirement is not an error correctable by reissue. Id. at 1280, 193 U.S.P.Q. (BNA) at 148; see also *In re Cornell*, 32 C.C.P.A. 1251, 150 F.2d 702, 704, 66 U.S.P.Q. (BNA) 320, 322 (CCPA 1945); *In re [1359] Smyser*, 30 C.C.P.A. 1093, 135 F.2d 747, 751, 57 U.S.P.Q. (BNA) 402, 406 (CCPA 1943). The so-called *Orita* doctrine therefore precludes a reissue applicant from obtaining substantially identical claims to those

of nonelected groups identified in an examiner's restriction requirement when such claims could not have been prosecuted in the application from which they were restricted.

In this case, the Board affirmed the examiner's rejection because, in its view, Dr. Doyle was impermissibly seeking to "circumvent the Orita doctrine by presenting reissue claims that encompass not only the subject matter of the canceled, non-elected claims of the original patent application but also additional subject matter." *Ex Parte Doyle*, slip op. at 7. Thus, in the Board's view, *In re Orita* broadly precludes Dr. Doyle from obtaining reissue claims that read on the subject matter of nonelected groups. We disagree that *In re Orita* compels the Board's [\*\*12] decision and hold that section 251 affords Dr. Doyle his requested remedy.

### III

In *In re Orita*, the Court of Customs and Patent Appeals addressed whether failure to file a divisional in response to a restriction requirement is an error redressable by reissue. The applicant in *In re Orita* agreed to the restriction requirement and cancelled the nonelected claims. Then, following issuance of the patent on the elected claims, he filed an application for reissue asserting "four additional claims substantially identical to the originally non-elected claims." *In re Orita*, 550 F.2d at 1278, 193 U.S.P.Q. (BNA) at 147. The Board upheld the examiner's rejection of the reissue claims, and the court affirmed,

holding that <sup>HN7</sup> the "error" of failing to file a divisional on the nonelected groups was wholly irrelevant to the question whether any error was present in the patent that issued on the elected claims. The court agreed with the Board that while "appellants undoubtedly erred by failing to file a timely divisional application in order to obtain a divisional patent," *id.* at 1280, 193 U.S.P.Q. (BNA) at 148, the patent that issued on their elected claims was error-free: "Patentees [\*\*13] claimed exactly what they had a right to claim in the patent, no more nor less, and appellants' failure to timely re-file does not change this fact." *Id.*

The court also rested its decision on the ground that <sup>HN8</sup> the patentee knowingly acquiesced in the restriction requirement and that such acquiescence, because it is by definition not inadvertent, cannot be error for purposes of the reissue statute. This interpretation of error flowed from prior cases holding that "the substitution of 'error' in section 251 for 'inadvertence, accident, or mistake' in former R.S. section 4916 [which governed reissues before it was superseded by section 251] did not involve a substantive change." *Id.*

We have applied the rule enunciated in *In re Orita* on one occasion. In *In re Watkinson*, 900 F.2d 230, 231, 14 U.S.P.Q.2D (BNA) 1407, 1408 (Fed. Cir. 1990), the applicant acquiesced during prosecution to a two-way restriction requirement. She cancelled her nonelected claims and never filed a divisional application on the nonelected group. Following issuance of the patent on the elected claim, she filed a reissue application seeking to add the nonelected claims. *Id.* She explained that [\*\*14] the correctable error lay in her original acquiescence to the restriction requirement, which, she claimed, was improper. *Id.* The Board affirmed the rejection under *In re Orita*, and on appeal, we affirmed. We held that the propriety of the original restriction requirement was immaterial; the key thing was that Watkinson acquiesced to the

restriction and was bound by the effect of her original decision: <sup>HN9</sup> *Orita* must be read for adhering to the previously established principle that applicants are 'estopped' [\*\*1360] from obtaining by reissue claims which, because of a requirement for restriction in which they had acquiesced, they could not claim in their patent." *Id.* at 232, 14 U.S.P.Q.2D (BNA) at 1409 (quoting *In re Orita*, 550 F.2d at 1280, 193 U.S.P.Q. (BNA) at 148).

As Dr. Doyle notes, his situation is quite different from those of the applicants in *In re Orita* and *In re Watkinson*. First, Dr. Doyle's new claims are neither identical nor substantially similar to the nonelected claims. Dr. Doyle's new claims are genus claims, whereas the nonelected claims are species that fall within the new genus claims. In other words, the reissue claims are substantially broader [\*\*15] than the claims of the nonelected groups. Thus, the estoppel rationale underlying *In re Orita* and *In re Watkinson* does not apply here. In the earlier cases, it was crucial that the applicant explicitly agreed to the requirement of independent prosecution of the disputed claims (or claims substantially similar to the disputed claims) in a divisional, and not as a part of the application directed towards the elected group. When the applicants returned in reissue seeking to add the disputed claims, the examiner, the Board, and this court rightly held them to the terms of their original agreements. The case is different where, as here, the applicant never asserted the reissue claims or anything similar to them in his original application, and also never agreed to prosecute the reissue claims in a divisional application. The estoppel rationale underlying *In re Orita* and *In re Watkinson* cannot support a similar result here because there is simply no

agreement as to these particular claims whereby Dr. Doyle may be estopped.

There is another critical, and indeed dispositive difference between the present case and *In re Orita*: Dr. Doyle could have prosecuted his reissue [\*\*16] claims with the claims of the elected group. Indeed, as the Solicitor concedes, these linking claims not only could have but should have been prosecuted with the elected group. This undercuts the other, more important rationale of *In re Orita*: that the issued patent contains no error. This second rationale underlying the result in *In re Orita* turned on the fact that the applicant could not have asserted the new reissue claims with the elected group. The reason, of course, was the restriction requirement--the examiner specifically required *Orita* to prosecute those claims in a different application. In contrast, Dr. Doyle could have prosecuted his claims with the elected group without running afoul of the restriction requirement because they are linking claims. See Manual of Patent Examining Procedure § 809.03 (8th ed. 2001) ("MPEP"). Furthermore, the new claims are broader than the issued claims, and therefore the issued claims are "wholly or partly inoperative or invalid . . . by reason of the patentee claiming . . . less than he had a right to claim in the patent." 35 U.S.C. § 251 (1994). In other words, Dr. Doyle has successfully asserted [\*\*17] an error in the issued patent correctable by reissue and *In re Orita* does not--and cannot--limit his statutory right to seek reissue under the circumstances.

The Solicitor's reliance on the pre-1952 Act cases *In re Smyser* and *In re Cornell* falters under the same rationale. In both of those cases, the applicant tried to seek via reissue claims that, because of a restriction requirement, could not have been prosecuted with the original elected group. In *In re Smyser*, the original application claimed sandpaper, a process of making sandpaper, and an apparatus for making sandpaper. 135 F.2d at 747-48, 57 U.S.P.Q. (BNA) at 404. The applicant acquiesced in a two-way restriction requirement between the claims to sandpaper and the apparatus and process claims, and elected the process and apparatus claims. *In re Smyser* 135 F.2d at 749, [\*1361] 57 U.S.P.Q. (BNA) at 404. He sought to obtain the sandpaper claims via reissue, arguing that the reissue statute "expressly provides for the allowance in a reissue application of divisible subject matter" despite the fact that those claims were subject to restriction during the original prosecution. *In re Smyser* 135 F.2d at 749-50, 57 U.S.P.Q. (BNA) at 405. The court rejected *Smyser's* [\*\*18] argument and affirmed the rejection because "appellant is estopped from obtaining in a reissue application a claim which, because of the requirement for division in which he acquiesced, was not allowable in his original application." *In re Smyser* 135 F.2d at 751, 57 U.S.P.Q. (BNA) at 406. Similarly, in *In re Cornell*, we rejected an attempt to claim through reissue apparatus claims that, due to a restriction requirement, the applicant could not prosecute with the original claims. 150 F.2d at 704, 66 U.S.P.Q. (BNA) at 322 ("We hold, therefore, that appellants are not entitled to obtain, by reissue, claims, regardless of scope, which are limited to the liquid measuring apparatus per se, and which they conceded by their acquiescence in the requirement for division they were not entitled to claim in their patent."). In contrast to both *In re Smyser* and *In re Cornell*, Dr. Doyle could have prosecuted his linking claims with the elected group. Therefore an error exists in Dr. Doyle's issued patent (failure to claim the broad genus claims) that did not exist in the *Smyser*, *Cornell*, or *Orita* cases.

*Orita*, and *Smyser* and *Cornell* (cases upon which *Orita* rests), are best understood [\*\*19] for what they are: interpretations of the reissue statute. Each state the correct rule, which is that <sup>HN10</sup> reissue lies only for correction of error in an existing patent. As noted above, this rationale underlies the decision in each of those cases, where the patent in reissue contained no possible error because the matter sought on reissue could not have been prosecuted originally. That rationale cannot apply to Dr. Doyle's reissue application, in which he points to error in the existing patent, namely, failure to claim as broadly as possible matter that could have been sought in the original application.

The Solicitor views *Orita* as mandating that acquiescence to a restriction requirement forecloses the applicant's right to assert claims in reissue to any portion of the subject matter of the nonelected groups. Thus, in the Solicitor's view, because Dr. Doyle's linking claims read on the subject matter of some of the nonelected groups, he is estopped from seeking in reissue to add those claims to the patent claiming the elected group. The Solicitor takes too broad a view of *In re Orita*. *In re Orita* did not create a broad rule disallowing any reissue claims that read on [\*\*20] nonelected subject matter. As discussed above, the reissue claims asserted in *In re Orita* did not just read on nonelected subject matter, but rather were "substantially identical to those non-elected in [the] application." *In re Orita*, 550 F.2d at 1280, 193 U.S.P.Q. (BNA) at 149. As discussed above, the rationale underlying *In re Orita* and the holding of that case extend only to claims that are identical to or of substantially similar scope to those of the nonelected group.

The linking claims involved here are obviously not of substantially similar scope as the nonelected species claims--they are quite significantly broader. More importantly, they could have been asserted along with the elected group because they read on the species of the elected group. Indeed, had Dr. Doyle not inadvertently neglected to assert the linking claims in his prosecution of the elected group, and had those claims been allowed, the examiner would have been required to lift the restriction requirement as to the

other groups linked by the new claims and allow [\*1362] prosecution of those other groups. <sup>HN11</sup> The MPEP expressly provides that "if a linking claim is allowed, the examiner must thereafter [\*\*21] examine species if the linking claim is generic thereto, or he or she must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim." MPEP § 809.04 (emphases added). Viewed in this light, Dr. Doyle's failure to assert the linking genus claims truly was an error in the issued patent. It was not, as in *In re Orita*, merely an error pertaining to the prosecution (or lack thereof) of other, divisional applications directed towards the nonelected groups.

The Solicitor also relies on *In re Weiler*, 790 F.2d 1576, 229 U.S.P.Q. (BNA) 673 (Fed. Cir. 1986), which, in the Solicitor's view, belongs to the *In re Orita* line of cases and supports a broad estoppel based on failure to file a divisional application. The examiner in *In re Weiler* imposed a three-way restriction requirement. Weiler made an election, but failed to file divisional applications to assert the nonelected groups. *Id.* at 1578, 229 U.S.P.Q. (BNA) at 674. Following the issuance of his patent on the elected claims, he filed a reissue application asserting new claims that, according to Weiler, "should have been made in the original application. [\*\*22] " *Id.* Following rejection of all the reissue claims, Weiler appealed to the Board. The Board sustained the examiner's rejection of claims 14-18 based on *Orita* because those claims were "directed to the same subject matter as the non-elected conjugate claims 9 and 10' of the original application." *Id.* at 1579, 229 U.S.P.Q. (BNA) at 674. The Board sustained the rejection of two other claims (13 and 19) because they

are directed to subject matter not claimed at all in the original application. As to them, the Examiner's reliance on the case of *In re Rowand et al.* is entirely correct and that decision is controlling. Here, as in that case, "there is nothing in the original patent evidencing that appellants intended to claim (this now claimed subject matter)."

*Id.* (quoting *In re Rowand*, 526 F.2d 558, 560, 187 U.S.P.Q. (BNA) 487, 489 (CCPA 1975)).

Weiler did not appeal the *Orita* rejection of claims 14-18 to this court, and we therefore had no occasion to address the propriety of that rejection. He appealed only the rejection of claims 13 and 19. We affirmed that rejection because "Weiler's failure to have ever claimed, broadly or narrowly [\*\*23] or otherwise, the subject matter of claims 13 and 19, and his failure to show an 'intent to claim' that subject matter, indicated absence of the statutorily required 'error.'" *In re Weiler* 790 F.2d at 1580, 229 U.S.P.Q. (BNA) at 675. Aside from the lack of intent-to-claim, we also rested our decision on the fact that Weiler's new claims asserted a completely separate invention from the issued claims or any of the nonelected claims. See *In re Weiler* 790 F.2d at 1581, 229 U.S.P.Q. (BNA) at 676. Thus, because claims 13 and 19 claimed a distinct invention from the issued claims, they too would have been subject to the original restriction requirement and the applicant would not have been allowed to prosecute them with the original patent--he would have been required to assert them in a divisional. *Id.* Under *In re Orita*, of course, there is no correctable error in failing to prosecute divisional applications on inventions of the nonelected groups identified by the examiner in the original restriction requirement. In *In re Weiler*, we held that the result should be the same with respect to claims 13 and 19, which also asserted wholly distinct inventions from that covered by the issued patent. *In re Weiler* 790 F.2d at 1582, 229 U.S.P.Q. (BNA) at 677. [\*\*24] We explained that <sup>HN12</sup> "if it were not error to forego divisional applications on subject matter to which claims had been made in the original application, it cannot on the present record have been error to forego divisional applications [\*1363] on subject matter to which claims had never been made." *Id.*

There is a crucial difference between the situation in *Weiler* and the present case. Dr. Doyle's claims are not to an invention distinct from that of the issued claims. Rather, as the Solicitor admits, they are linking claims that read on, and could have been asserted with, the elected group. Therefore, the entire premise

of Weiler is inapplicable to this case, for Weiler applies only to an attempt to assert new claims in reissue that read on a separate invention and not on the subject matter of the issued claims.

The Solicitor also argues that allowing patentees in Dr. Doyle's position recourse to reissue will undercut the copendency requirements of sections 120 and 121, and will be detrimental to the public interest in the

certainty and finality of patent rights. <sup>HN13</sup> The copendency requirement of section 120 refers to the requirement that a patent application filed as a continuation <sup>HN13</sup> or divisional application upon an originally filed application must be filed "before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of

the first application" in order to receive the benefit of the earlier filing date. 35 U.S.C. § 120 (1994). <sup>HN14</sup> Section 121, which provides for divisional applications, allows an invention that has been the subject of a restriction requirement to receive the benefit of the earlier filing date only if filed in accordance with section 120. Thus, the Solicitor argues that allowing the restricted subject matter to receive the benefit of the earlier filing date via reissue would have the practical effect of circumventing the requirement that the subject matter be claimed in an application filed prior to the issuance of the original patent.

We do not agree. The Solicitor's argument presumes a situation in which the claims sought on reissue have been restricted from an application in earlier proceedings, i.e., the Orita situation. In that situation, the copendency requirements of sections 120 and 121 are relevant. <sup>HN15</sup> <sup>HN15</sup> See In re Orita, 550 F.2d at 1280-81. In this case, <sup>HN15</sup> the matter sought on reissue could have been presented with the original application, so sections 120 and 121 are not implicated.

As far as the public interest in the certainty and finality of patent rights is concerned, it is certainly true that allowing reissue, and particularly broadening reissue, undermines these various interests to some extent. But Dr. Doyle's situation is no more an affront to the public interest than any other broadening reissue. Congress spoke to this matter when it decided to allow broadening reissues, and we may not rewrite the

statute based on our own view of the proper outcome of that public policy debate. <sup>HN16</sup> Congress has weighed the benefits and burdens of allowing corrections of this sort of error by reissue, and has decided to allow broadening reissues, subject, of course, to certain safeguards: the two-year time limitation and intervening rights. <sup>n5</sup> See 35 U.S.C. §§ 251-252 (1994) (providing for two-year time limit and intervening rights). These safeguards are no less effective in Dr. Doyle's case than in any other situation in which a patentee alters the scope <sup>HN17</sup> of his property right through reissue.

----- Footnotes -----

<sup>n5</sup> The doctrine of intervening rights is based on the second paragraph of 35 U.S.C. § 252, which "provides that when certain conditions are present a reissue shall not abridge or affect certain rights of those who acted before the reissue was granted. Because of such pre-reissue activity, an infringer might enjoy a 'personal intervening inventing right' to continue what would otherwise be infringing activity after reissue." Seattle Box Co. v. Indus. Crating and Packing Inc., 756 F.2d 1574, 1579, 225 U.S.P.Q. (BNA) 357, 361 (Fed. Cir. 1985).

----- End Footnotes -----

[\*1364] The Solicitor also urges us to hold that Dr. Doyle dedicated the subject matter of his linking claims to the public by failing to file a divisional application on the nonelected groups. He urges that "the public is entitled, on the basis of the prosecution of the '595 patent, to conclude that it can practice any of inventions I-V or VII-IX, without apprehension of infringing claims to the non-elected inventions <sup>HN17</sup> [\*28] in

any patent claiming the benefit of priority of the '595 patent." However, <sup>HN17</sup> the public knows, or should know, that an issued patent can be broadened by reissue during a two-year period following issuance. The public is therefore on notice that at least some matter can be "dedicated to the public" in error, and that the error, if caught in time, can be corrected by reissue. And if the patentee succeeds in obtaining a reissue that alters the scope of her right to exclude, then the public interest is protected through intervening rights. If those statutory rights are insufficient to protect the public interest in this instance, then the remedy lies with Congress, and not the courts.

#### IV

For the reasons given above, we reverse the Board's decision affirming the rejection of the pending claims and remand for further proceedings not inconsistent with this decision.

#### COSTS

No costs.

#### REVERSED AND REMANDED

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10. Hester Industries, Inv. v. Stein, Inc.,  
142 F.3d 1472, 46 USPQ2d 1641 (Fed.  
Cir. 1998)



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*142 F.3d 1472, \*; 1998 U.S. App. LEXIS 9288, \*\*;  
46 U.S.P.Q.2D (BNA) 1641*

HESTER INDUSTRIES, INC., Plaintiff-Appellant, v. STEIN, INC., Defendant-Cross Appellant.

97-1352, 97-1353

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

142 F.3d 1472; 1998 U.S. App. LEXIS 9288; 46 U.S.P.Q.2D (BNA) 1641

May 7, 1998, Decided

**SUBSEQUENT HISTORY:**

Certiorari Denied October 19, 1998, Reported at: 1998 U.S. LEXIS 6705.

**PRIOR HISTORY:** [\*\*1] Appealed from: United States District Court for the Eastern District of Virginia. Judge Ellis.

**DISPOSITION:** AFFIRMED.

**CASE SUMMARY**

**PROCEDURAL POSTURE:** Plaintiff patent holder appealed an order of the United States District Court for the Eastern District of Virginia, which granted a summary judgment of invalidity in favor of defendant manufacturer on the patent holder's suit alleging infringement on several reissue claims in two reissue patents. The claims were invalid for failure to meet the statutory "error" and "original patent" requirements set forth in 35 U.S.C.S. § 251.

**OVERVIEW:** The patent holder of a process for cooking food using high humidity steam, which had been reissued, brought suit against the manufacturer alleging infringement on the reissued claims. On appeal from a grant of summary judgment in favor of the manufacturer, the court affirmed, holding that the asserted reissue claims impermissibly recaptured subject matter surrendered by the patent holder through deliberate arguments repeatedly made to the Patent Office to overcome

prior art. The "error" requirement limited the availability of a reissue patent to certain correctable errors, and the recapture rule prevented a patentee from regaining through reissue subject matter that he surrendered in an effort to obtain allowance of the original claim. The court held that the asserted claims were broader than the original patent as they did not include two limitations found in each of the original claims. The asserted claims were not materially narrower than the original claim. Because the asserted claims were invalid, the court did not reach the manufacturer's claim construction allegations.

**OUTCOME:** The order granting summary judgment in favor of the manufacturer on the patent holder's infringement suit was affirmed. The realm of corrections contemplated by patent law did not include recapturing surrendered subject matter, without the addition of materially-narrowing limitations, in an attempt to custom-fit the reissue claims to a competitor's product.

**CORE TERMS:** steam, reissue, patent, original patent, recapture, cooking, humidity, invention, cooker, path, surrender, housing, spiral, food, atmosphere, conveyance, subject matter, surrendered, invalid, conveyor belt, summary judgment, examiner, patentee, estoppel, chamber, invalidity, materially, written description, patentability, appreciate

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Civil Procedure > Summary Judgment > Standards > Appropriateness  
Civil Procedure > Summary Judgment > Standards > Genuine Disputes  
Civil Procedure > Summary Judgment > Standards > Materiality

**HN1** Summary judgment is appropriate only when the record shows that  
↓ there is no genuine issue as to any material fact and that the  
moving party is entitled to judgment as a matter of law under Fed.  
R. Civ. P. 56(c).

Civil Procedure > Trials > Bench Trials

**HN2** Whether the statutory requirements of 35 U.S.C.S. § 251 have been met is  
↓ a question of law. This legal conclusion can involve underlying  
factual questions.

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN3** The "error" and "original patent" requirements are found in the  
↓ first paragraph of 35 U.S.C.S. § 251. The "error" requirement limits the  
availability of a reissue patent to certain correctable errors. One  
such correctable error is the patentee claiming his invention too  
broadly or too narrowly.

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Broadening Reissues & Recapture

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Requirements

**HN4** The last paragraph of 35 U.S.C.S. § 251 requires that a request to  
↓ enlarge the scope of claims be applied for within two years from the  
grant of the original patent. 35 U.S.C.S. § 251.

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Requirements

**HN5** The "original patent" requirement is a second and independent  
↓ requirement, which restricts a reissue patent to the invention  
disclosed in the original patent. 35 U.S.C.S. § 251.

Criminal Law & Procedure > Appeals > Standards of Review > De Novo Review > General Overview  
Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN6** In considering the "error" requirement of 35 U.S.C.S. § 251, a court keeps in mind that the reissue statute is based on fundamental principles of equity and fairness, and should be construed liberally. A court also keeps in mind that not every event or circumstance that might be labeled "error" is correctable by reissue. The reissue procedure does not give the patentee the right to prosecute de novo his original application.

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN7** One of the most commonly asserted "errors" in support of a broadening reissue is the failure of the patentee's attorney to appreciate the full scope of the invention during the prosecution of the original patent application. This form of error is generally been accepted as sufficient to satisfy the "error" requirement of 35 U.S.C.S. § 251.

Patent Law > U.S. Patent & Trademark Office Proceedings > Continuation Applications > General Overview

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Broadening Reissues & Recapture

**HN8** The recapture rule prevents a patentee from regaining through reissue subject matter that he surrendered in an effort to obtain allowance of the original claims. The rule is rooted in the "error" requirement in that such a surrender is not the type of correctable "error" contemplated by the reissue statute.

Patent Law > Claims & Specifications > Description Requirement > General Overview

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Broadening Reissues & Recapture

**HN9** Under the recapture rule, claims that are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible. Application of the recapture rule begins with a determination of whether and in what respect the reissue claims are broader than the original patent claims. A reissue claim that does not include a limitation present in the original patent claims is broader in that respect.

Patent Law > Claims & Specifications > Description Requirement > General Overview

Patent Law > U.S. Patent & Trademark Office Proceedings > Continuation Applications > General Overview

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN10** To determine whether an applicant surrendered particular subject matter, a court looks to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. A surrender can occur by way of arguments or claim changes made during the prosecution of the original patent application.

Evidence > Procedural Considerations > Exclusion & Preservation by Prosecutor

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN11** In determining whether there is a surrender, the prosecution history of the original patent should be examined for evidence of an admission by the patent applicant regarding patentability. In this regard, claim amendments are relevant because an amendment to overcome a prior art rejection evidences an admission that the claim was not patentable. Arguments made to overcome prior art can equally evidence an admission sufficient to give rise to a finding of surrender. Logically, this is true even when the arguments are made in the absence of any claim amendment. Amendment of a claim is

not the only permissible predicate for establishing a surrender.

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Broadening Reissues & Recapture

**HN12** The view that arguments alone can give rise to a surrender is consistent with the policy behind the reissue statute and the accompanying recapture rule. The reissue statute is based on fundamental principles of equity and fairness. There is no unfairness in binding the patentee to deliberate assertions made in order to obtain allowance of the original patent claims over the prior art. Indeed, fairness to the public must also be considered. In this regard the reissue statute cannot be construed in such a way that competitors, properly relying on prosecution history, become patent infringers when they do so. The recapture rule operates to prevent this from happening. The recapture rule is based on principles of equity and therefore embodies the notion of estoppel.

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN13** The recapture rule is quite similar to prosecution history estoppel, which prevents the application of the doctrine of equivalents in a manner contrary to the patent's prosecution history. Like the recapture rule, prosecution history estoppel prevents a patentee from regaining subject matter surrendered during prosecution in support of patentability.

Patent Law > Infringement Actions > Prosecution History Estoppel > General Overview

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN14** Prosecution history estoppel can arise by way of unmistakable assertions made to the Patent Office in support of patentability, just as it can by way of amendments to avoid prior art.

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Broadening Reissues & Recapture

**HN15** In a proper case, a surrender can occur through arguments alone.

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN16** Having concluded that there has been a surrender, a court must next determine whether the surrendered subject matter has crept back into the asserted reissue claims. When the surrender occurs by way of claim amendment or cancellation, comparing the reissue claim with the canceled claim is one way to do this. This analysis is not available when the surrender is made by way of argument alone.

Patent Law > Claims & Specifications > Description Requirement > General Overview

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Broadening Reissues & Recapture

**HN17** Because the recapture rule may be avoided in some circumstances, a court considers whether the reissue claims were materially narrowed in other respects. In the context of a surrender by way of argument, this principle, in appropriate cases, may operate to overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.

Patent Law > Claims & Specifications > Definiteness > General Overview

Patent Law > Claims & Specifications > Description Requirement > General Overview

Patent Law > Infringement Actions > Claim Interpretation > Means Plus Function

**HN18** A so-called means-plus-function clause drafted pursuant to 35

↓ U.S.C.S. § 112 is to be construed to cover the corresponding structure described in the specification and equivalents thereof.

Patent Law > Claims & Specifications > Definiteness > General Overview

Patent Law > Claims & Specifications > Description Requirement > General Overview

**HN19** Use of the word "means" in a claim clause triggers a presumption

↓ that 35 U.S.C.S. § 112 applies. The presumption can be overcome if the clause recites sufficient structure.

Patent Law > U.S. Patent & Trademark Office Proceedings > Continuation Applications > General Overview

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Requirements

**HN20** The realm of corrections contemplated within 35 U.S.C.S. § 251 does not  
↓ include recapturing surrendered subject matter, without the addition of materially-narrowing limitations, in an attempt to custom-fit the reissue claims to a competitor's product.

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN21** Error under the reissue statute, 35 U.S.C.S. § does not include a  
↓ deliberate decision to surrender specific subject matter in order to overcome prior art, a decision which in light of subsequent developments in the marketplace might be regretted.

Patent Law > Claims & Specifications > Description Requirement > General Overview

Patent Law > U.S. Patent & Trademark Office Proceedings > Continuation Applications > General Overview

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN22** 35 U.S.C.S. § 251 does not include a separate requirement of an  
↓ objective intent to claim. The essential inquiry under the "original patent" clause of 35 U.S.C.S. § 251 is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. This inquiry is analogous to the "written description" requirement of 35 U.S.C.S. § 112. To the extent the construct of an objective intent to claim is useful, it is only one factor that sheds light on whether the "original patent" clause of 35 U.S.C.S. § 251 is satisfied.

**COUNSEL:** Robert W. Adams, Nixon & Vanderhye, P.C., of Arlington, Virginia, argued for plaintiff-appellant. With him on the brief were Robert A. Vanderhye, James T. Hosmer, Robert W. Faris, and William J. Griffin.

Charles H. De La Garza, Arnold, White & Durkee, of Minneapolis, Minnesota, argued for defendant-cross appellant. With him on the brief were L. Gene Spears, Attorney of Record, and James C. Pistorino, of Houston, Texas.

**JUDGES:** Before PLAGER and SCHALL, Circuit Judges. n1

n1 A member of the panel that heard argument in this case was unable to continue with consideration of the case because of recusal. Pursuant to Rule 47.11 of this court, the matter was decided by the remaining members of the panel.

**OPINION BY:** PLAGER

## OPINION:

[\*1474] PLAGER, Circuit Judge.

Hester Industries, Inc. ("Hester") appeals from a summary judgment of invalidity entered by the United States District Court for the Eastern District of Virginia. The district court ruled that the reissue patent claims asserted by Hester against Stein, Inc. ("Stein") are invalid for failing to meet the statutory "error" and [\*2] "original patent" requirements for reissue patents set forth in 35 U.S.C. § 251 P 1 (1994). Hester Indus., Inc. v. Stein, Inc., 963 F. Supp. 1403 (E.D. Va. 1997). Stein cross-appeals a pretrial oral ruling in which the district court adopted Hester's proposed construction of the claim term "high humidity steam."

Because the asserted reissue claims impermissibly recapture subject matter surrendered by Hester through deliberate arguments repeatedly made to the Patent Office to overcome prior art, we hold that Hester is barred from asserting "error" within the meaning of 35 U.S.C. § 251 P 1. We accordingly affirm the summary judgment of invalidity. Because the asserted claims are invalid, we need not and do not reach the claim construction issue.

## BACKGROUND

At issue in this case are two reissue patents, U.S. Patent No. Re. 33,510 (the "'510 reissue patent") and U.S. Patent No. Re. 35,259 (the "'259 reissue patent"). The two patents are reissues of the same original patent, U.S. Patent No. 4,582,047 (the "'047 patent" or "original patent"), which they replaced pursuant to 35 U.S.C. § 251. n2 The patents are directed to a high humidity steam cooker having a continuously running [\*3] conveyor for cooking food items such as poultry and other meat products. Hester, a processor of pre-cooked poultry and other meat products, owns the patents, and Charles E. Williams ("Williams"), a Hester employee, is the sole named inventor. After the '259 reissue patent (the second reissue) issued in 1996, Hester sued Stein, a manufacturer of industrial appliances, for allegedly infringing several reissue claims in the two reissue patents.

----- Footnotes -----

n2 The district court noted that the issuance of two reissue patents for the same original patent was a "curiosity" that appeared to be unprecedented. Hester, 963 F. Supp. at 1405 n.2. However, the propriety of two reissues for the same patent was not addressed below and has not been raised on appeal. Accordingly, we express no opinion on the matter.

----- End Footnotes -----

The two reissue patents and the original patent have the same written description; the patents differ only with respect to their claims. That written description describes an industrial-size steam cooker for cooking large [\*4] quantities of food products. The cooker is described as having a cooker chamber in which a steam atmosphere is maintained. The food products are carried through the cooker chamber on a conveyor belt that runs through a spiral path. The written description teaches that efficient cooking is achieved without the loss of humidity, flavor, or appearance by maintaining a water-drop-free steam atmosphere within the chamber at near 100 degrees C and 100% humidity, at above atmospheric pressure.

Two separate sources of steam, one internal and one external, are described for maintaining the steam atmosphere. The internal source of steam described is a pool of water on the floor of the cooker chamber, heated by a heating element in the pool. The external source described is a steam generator, located outside the cooker chamber and connected by pipes to various locations within the cooker chamber to inject steam at those locations. The written description states that the external steam source typically provides 25% of [\*1475] the steam, with the remainder provided by the internal source. '047 patent, col. 3, ll. 42-45, 57-59. The heating element in the internal steam source is controlled to maintain [\*5] the desired amount of steam and pressure within the cooker chamber. Id. col. 3, ll. 59-63.

The section of the written description entitled DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT describes the cooking atmosphere thus:

The cooking is solely with water droplet free steam near 100 degrees C. and 100% humidity at a pressure above atmospheric. The high humidity atmosphere prevents losses of humidity of the product as it passes through the cooker and helps retain juices, essences and flavor of the product. Also it improves the heating steam interface heat exchange at the product surface for more efficient cooking.

The higher pressure not only produces a pressure-cooker like cooking efficiency to the cooking process, but is critical in connection with the flavor and conveyor type product flow as well.

Id. col. 3, ll. 22-33.

The original patent contains one independent claim, claim 1, directed to a food cooking system. The claim specifies that the cooking system cooks solely with steam and that the system includes two sources of steam to provide the steam atmosphere. Characteristics of the steam atmosphere are set forth, and the cooking system is said to include **[\*\*6]** a means passing a conveyor belt through the cooker housing. Claim 1, with relevant text emphasized, reads:

A food cooking system *cooking solely with steam* foods such as fish, fowl, meats or produce carried through a cooker on a continuously running conveyor belt, comprising in combination, a cooker housing, *means passing said conveyor belt through said housing* to expose food products within the cooker housing only to *said steam as the sole cooking medium*, and *two sources of steam providing said steam* to cook the food products, nozzles for releasing steam located inside said housing, one comprising a steam generator supplying supplemental steam into said housing at said nozzles located there inside to *maintain the atmosphere together with the other steam source at near 100% humidity 100 degrees C. and a pressure above atmospheric*, and the other source of steam comprising a pool of water within said housing with heating means for boiling the water to create steam.

Id. col. 5, l. 59 to col. 6, l. 8. For purposes here, this is substantially the same form in which the claim was first filed (as application claim 1) in the application for the original **[\*\*7]** patent. Accordingly, we do not distinguish between the issued claim and the application claim, but instead simply refer to claim 1.

In addition to the independent claim, the original patent contains several claims which are dependent upon claim 1. Relevant here is dependent claim 12, which specifies in pertinent part: "A system as defined in claim 1 *wherein the conveyor belt is passed inside said housing in a spiral path* coiling downwardly . . . ." Id. col. 6, ll. 59-61 (emphasis added). This claim stemmed from original application claim 16, which specified that the conveyor belt is "passed . . . in a spiral path."

The application for the '047 patent (the original patent) was filed in 1979. The patent did not issue until 1986, nearly seven years later. Over the almost seven years in which the application was prosecuted before the United States Patent and Trademark Office ("Patent Office"), inventor Williams, through his attorney, repeatedly emphasized the "solely with steam" and "two sources of steam" features of the claimed invention in attempting to establish patentability over the prior art. For example, after the Examiner first rejected claim 1 as well as all the **[\*\*8]** other claims as obvious, Office Action of Feb. 6, 1980, at 2, Williams distinguished a cited prior art cooker that cooked with a combination of infra-red dry heat and steam on the ground that the claimed invention cooked solely with steam, stating: "This principle is completely different from applicant's invention where the claims define cooking solely with steam." Applicant Response of Apr. 28, 1980 (emphasis in original). Williams also distinguished claim 1 on the basis of the "two sources of steam" limitation, the specified characteristics of the steam atmosphere, and **[\*1476]** the recited continuously running conveyor belt. Id.

Application claim 16, which specified a spiral conveyance path, was rejected as obvious in view of an additional prior art cooker that included a spiral conveyor. Office Action of Feb. 6, 1980, at 4. In response, Williams amended claim 16 to specify further details of the spiral conveyance path and then argued that

the claimed spiral conveyance path was distinguished from that shown in the prior art. Applicant Response of Apr. 28, 1980.

However, the Examiner continued to reject all claims as obvious. Office Action of July 9, 1980. At that point, Williams [\*\*9] placed even greater reliance on the "solely with steam" and "two sources of steam" limitations in an attempt to overcome the obviousness rejection. For example, in his first appeal of the obviousness rejection to the Board of Patent Appeals and Interferences ("Board"), Williams stated, "The claimed system cooks solely with steam . . . by means of two separate and critical steam sources . . . ." Applicant Brief on Appeal, at 2 (Aug. 20, 1980) (emphasis in original). Later in the same brief, Williams specifically distinguished the cited prior art on the basis of these limitations:

The primary reference Vischer cooks with IR radiation not steam. Clearly the claimed feature of cooking solely with steam is directly contrary to the teaching of the Vischer patent, which could therefore never make obvious any process or equipment cooking solely with steam as claimed.

....

The Examiner errs in any implication that Jourdan shows two sources of steam.

Id. at 9-10 (emphasis in original).

Prior to the Board hearing Williams' appeal, the Examiner reopened prosecution on the merits in view of newly discovered prior art, thereby removing the appeal from the Board. n3 [\*\*10] Office Action of Mar. 17, 1981. The Examiner then rejected all of the claims as obvious over the new prior art. Id. In response, Williams distinguished claim 1 over that prior art on the same bases, i.e., the "solely with steam" and "two sources of steam" limitations. Applicant Response to Office Action (Apr. 17, 1981). However, the Examiner was not persuaded, even after these same arguments were repeated in subsequent papers submitted to the Patent Office.

----- Footnotes -----

n3 Accordingly, the Board never heard Williams' first appeal.

----- End Footnotes -----

Accordingly, Williams initiated a second appeal to the Board. He again emphasized the "solely with steam" and "two sources of steam" limitations. Applicant Brief on Appeal, at 13 (Dec. 22, 1981). He explained that the two sources of steam interact to provide a "synergy" that is "novel and nowhere suggested in any of the cited [prior] art." Id. Williams drove home his reliance on the "solely with steam" limitation most forcefully in his reply brief to the Board: "Clearly the Examiner [\*\*11] reversibly errs as a matter of fact and in his efforts to make a case out against the very material claimed feature that steam is the sole cooking medium (claim 1). Thus reversal is respectfully solicited." Applicant Reply Brief on Appeal, at 6 (Sep. 30, 1982) (emphasis in original).

The Board was persuaded and accordingly reversed the obviousness rejection in its opinion dated June 21, 1985, stating:

We find no suggestion in the combined teachings of the references which would have led the ordinarily skilled worker in the art to an apparatus utilizing steam as the sole cooking medium; utilizing two separate sources of steam, one of which includes a pool of water in the cooking chamber with means for boiling the water; and wherein the atmosphere within the cooking chamber is maintained above atmospheric by the two sources of steam.



Thereafter the claims were allowed and the application issued as the '047 patent on April 15, 1986.

On the two-year anniversary of the '047 patent's issuance, Williams applied for a reissue pursuant to 35 U.S.C. § 251, alleging that the patent claims had been drawn too narrowly due to attorney error. In the required oath accompanying **[\*\*12]** the reissue application, Williams explained that he became **[\*1477]** aware of this alleged error after learning that Stein was in the process of developing a competing cooker in early 1988. According to his oath, Williams and his employer Hester concluded that the '047 patent should cover the Stein cooker, notwithstanding the fact that the cooker used a non-steam heat source and only one source of steam in the cooking process. Williams further explained that Hester's present counsel advised Hester that the '047 patent claims, as written, might not cover Stein's cooker. Thus, Williams, by oath, declared that the patent was insufficient because it claimed less than he had a right to claim.

Specifically, Williams identified two relevant deficiencies of the '047 patent, as follows (indentation and numbering added): n4

[1] that each of claims 1-14 therein requires cooking "solely with steam" and exposing food products within the cooker housing "only to said steam as the sole cooking medium" . . . .  
[and]

[2] that each of claims 1-14 therein requires "two sources of steam providing said steam to cook the food products, nozzles for releasing steam located inside said housing" [.]

**[\*\*13]**

These deficiencies, according to Williams, "arose after [he] executed and filed the original application from which the '047 patent issued" and were caused by "the failure of [his prior] patent attorney . . . to appreciate the full scope of [his] invention."

----- Footnotes -----

n4 The reissue oath specifies two further insufficiencies, namely, that the '047 patent requires:

[3] "a steam generator supplying supplemental steam into said housing at said nozzles located there inside to maintain the atmosphere together with the other steam source at near 100% humidity 100 degrees C, and a pressure above atmospheric" and

[4] "a pool of water within the housing with heating means for boiling the water to create steam."

(Indentation and numbering added.)

----- End Footnotes -----

This application ripened into the '510 reissue patent nearly three years later on January 1, 1991. However, prior to its issuance, Williams filed a second reissue application, for reasons not relevant here, on June 21, 1990, alleging the same errors used **[\*\*14]** to support the first reissue. Six years later, this second reissue application issued as the '259 reissue patent. Hester then filed this action, accusing Stein of infringing two claims in the first reissue patent and six claims in the second. Specifically, Hester accused Stein of infringing reissue claims 26 and 59 of the '510 reissue patent and reissue claims 28, 30, 31, 32,

75, and 76 of the '259 reissue patent.

The requirement in original claim 1 that cooking is "solely with steam" is absent from each of the asserted reissue claims. Also absent is the "two sources of steam" limitation. Rather, the asserted reissue claims merely recite a source of steam or at least one source of steam. None of the asserted reissue claims explicitly recite the steam atmosphere characteristics specified in original claim 1, i.e., the characteristics of near 100 degrees C and 100% humidity at above atmospheric pressure. Instead, all but one of the asserted reissue claims recite "high humidity steam." n5

----- Footnotes -----

n5 Claim 30 of the '259 reissue patent does not contain the "high humidity steam" language.

----- End Footnotes----- [\*\*15]

Claim 26 of the '510 reissue patent is representative of the two asserted reissue claims in that patent. It provides in pertinent part:

A food cooking system for cooking food products carried on a moving conveyor belt, comprising:

a cooker housing[.]

*means disposed within said housing for defining a conveyance path,*

a conveyor belt disposed along said conveyance path for supporting and conveying said food products along said path,

means coupled to said belt for causing said belt and said food products supported thereby to substantially continually translate along said conveyance path . . . , and

*a source of steam providing steam to contact and cook the food products, said steam source comprising at least one of the following:*

an external steam generator supplying steam into said housing, and a pool of water within said housing with heating means communicating with said pool of water for creating steam.  
... [.]

[\*1478] *wherein said steam source provides high humidity steam and said food products are directly exposed to said high humidity steam.*

'510 patent, col. 8, ll. 8-31, 36-38 (emphasis added, and text of claim 24, upon [\*\*16] which claim 26 depends, incorporated).

The asserted reissue claims of the '259 reissue patent are, for purposes here, substantially similar. One difference is that several of these claims explicitly recite a "spiral conveyance path." Claim 28, which is representative, provides in pertinent part:

A spiral steam cooker for at least partially cooking exposed food products, said cooker comprising:

a housing defining an internal volume therein;

a conveyor belt at least partially *disposed along a spiral conveyance path* within said internal volume . . . ; and

a *steam source* operatively coupled to said housing, said steam source *providing a high humidity steam atmosphere* within said internal volume, said high humidity steam atmosphere directly contacting and at least partially cooking the exposed food products . . .

'259 patent, col. 9, l. 61 to col. 10, l. 12 (emphasis added).

Before the district court, Stein moved for summary judgment that the asserted reissue claims are invalid for failing to meet the requirements of the reissue statute, 35 U.S.C. § 251. That section (with emphasis added) reads:

Whenever any patent is, through *error* <sup>['\*\*17]</sup> without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or *by reason of the patentee claiming more or less than he had a right to claim in the patent*, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent *for the invention disclosed in the original patent*, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

In particular, Stein argued that the "error" requirement of § 251 P 1, as well as the requirement therein that the reissue claims be "for the invention disclosed in the original patent" (the "original patent" requirement), were not met. With regard to the "error" requirement, Stein argued that Williams had not erred in including the "solely with steam" and "two sources of steam" limitations in the original claims, and further argued that the removal of those limitations violated the "recapture" rule. Stein further argued that the asserted reissue claims violated the "original patent" requirement because, <sup>['\*\*18]</sup> Stein asserted, the original patent does not evidence an "objective" intent to claim the invention in the manner of the asserted reissue claims.

The district court granted Stein's motion. The court first concluded that there was no "error" as contemplated by § 251 P 1. Specifically, the court concluded that the alleged failure of counsel to appreciate the scope of the invention was belied by the clear language in the original patent claims, the prosecution history of the patent, and the absence of any explanation as to the nature or cause of the attorney's failure to appreciate the full scope of the invention. Hester, 963 F. Supp. at 1408. The court did not reach Stein's assertion that the asserted reissue claims violate the recapture rule, though the court relied heavily on the original patent's prosecution history in determining that the "error" requirement was not met. See id. at 1409-11.

The district court ruled that the asserted reissue claims are alternatively invalid for failing to meet the "original patent" requirement. Id. at 1412. The district court concluded that the "original patent" clause of § 251 P 1 includes a separate requirement that the original <sup>['\*\*19]</sup> patent manifest an "objective" intent to claim the invention as later claimed on reissue. Id. at 1412-13. The court concluded that the original patent does not manifest such an objective intent, and thus the claims are also invalid under the "original patent" clause of § 251 P 1. Id. at 1412-15.

In its appeal of the invalidity judgment, Hester argues that the district court erred in concluding that the "error" and "original patent" requirements of § 251 P 1 were not met. <sup>['\*1479]</sup> Stein, in seeking to uphold the judgment, makes the same arguments presented to the district court in its motion for summary judgment. Hester, on the other hand, argues that the "error" requirement was met by way of prior patent counsel's failure to appreciate the full scope of the invention. Hester further asserts that the recapture rule is inapplicable because the reissue claims were never presented during prosecution of the original patent

and later abandoned by amendment or cancellation. With regard to the "original patent" clause of § 251 P 1, Hester submits that there is no separate requirement of a manifestation of an objective intent to claim.

Also at issue on appeal is the district court's resolution [\*\*20] of a "Motion For Claim Interpretation" brought by Stein. In that motion, Stein argued that the claim term "high humidity steam" should be construed in accordance with the only specific description of the steam atmosphere provided in the patents, *i.e.*, as water-droplet-free steam near 100 degrees C and 100% humidity at above atmospheric pressure. Hester, relying on the opinion of its expert, proposed a broader construction, arguing that the description contained in the patents is merely one example of "high humidity steam." The district court, in a ruling delivered from the bench prior to holding the asserted reissue claims invalid, adopted Hester's proposed construction of the claim term. The ruling was never reduced to a formal order or judgment. The parties, by way of cross-appeal by Stein, present the same issue on appeal.

## DISCUSSION

I

In reviewing the summary judgment of invalidity, we keep in mind that <sup>HN1</sup> summary judgment is appropriate only when the record shows that "there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). <sup>HN2</sup> Whether the statutory requirements of 35 U.S.C. § 251 have been [\*\*21] met is a question of law. See *In re Clement*, 131 F.3d 1464, 1468, 45 U.S.P.Q.2D (BNA) 1161, 1163 (Fed. Cir. 1997). This legal conclusion can involve underlying factual questions. See *id.*

II

As previously explained, <sup>HN3</sup> the "error" and "original patent" requirements at issue here are found in the first paragraph of § 251. The "error" requirement limits the availability of a reissue patent to certain correctable errors. See *In re Amos*, 953 F.2d 613, 616, 21 U.S.P.Q.2D (BNA) 1271, 1273 (Fed. Cir. 1991). As seen in the above-emphasized text of § 251, one such correctable error is the patentee claiming his invention too broadly or too narrowly. <sup>n6</sup> See *id.*

----- Footnotes -----

<sup>n6</sup> <sup>HN4</sup> The last paragraph of § 251 requires that a request to enlarge the scope of claims be "applied for within two years from the grant of the original patent." 35 U.S.C. § 251 P 4 (1994).

----- End Footnotes -----

<sup>HN5</sup> The "original patent" requirement is a second and independent requirement, see *Amos*, 953 F.2d at 615, 21 U.S.P.Q.2D (BNA) at 1272, which restricts a reissue patent to "the invention disclosed [\*\*22] in the original patent." 35 U.S.C. § 251 P 1. We address each of these requirements in turn.

A

1

<sup>HN6</sup> In considering the "error" requirement, we keep in mind that the reissue statute is "based on fundamental principles of equity and fairness, and should be construed liberally." *In re Weiler*, 790 F.2d 1576, 1579, 229 U.S.P.Q. (BNA) 673, 675 (Fed. Cir. 1986). We also keep in mind that "not every event or circumstance that might be labeled 'error' is correctable by reissue." *Id.* Indeed, the reissue procedure does not give the patentee the right "to prosecute *de novo* his original application." *Id.* at 1582, 229 U.S.P.Q. (BNA) at 677; see also *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995, 27 U.S.P.Q.2D (BNA) 1521, 1524 (Fed. Cir. 1993).

**HN7**↑ One of the most commonly asserted "errors" in support of a broadening reissue is the failure of the patentee's attorney to appreciate the full scope of the invention during the prosecution of the original patent application. See Amos, 953 F.2d at 616, 21 U.S.P.Q.2D (BNA) [\*1480] at 1273; In re Wilder, 736 F.2d 1516, 1519, 222 U.S.P.Q. (BNA) 369, 371 (Fed. Cir. 1984). This form of error has generally been accepted as sufficient to satisfy the "error" requirement of § 251. See [\*23] Clement, 131 F.3d at 1468, 45 U.S.P.Q.2D (BNA) at 1163; Wilder, 736 F.2d at 1519, 222 U.S.P.Q. (BNA) at 371. Williams asserted this form of error as the basis for his reissue applications, and the Patent Office accepted his assertion as adequate.

However, the district court concluded that there was no such error by Williams' attorney. Hester, 963 F. Supp. at 1411. In reaching this conclusion, the court was particularly persuaded by the prosecution history of the original patent. The court concluded that the attorney's repeated attempts to distinguish Williams' invention on the basis of the "solely with steam" and "two sources of steam" limitations belied Williams' assertion that his attorney failed to appreciate the full scope of his invention. Id. at 1409-11. The court also determined that there was no other form of § 251 "error" and thus held the asserted reissue claims invalid. Id. at 1411-12.

2

We share the district court's discomfort with Williams' attempt to remove, through reissue, the "solely with steam" and "two sources of steam" limitations after having relied so heavily on those limitations to obtain allowance of the original patent claims over the prior art. This concern [\*24] is addressed most squarely by the "recapture rule," recently discussed at length in Clement, 131 F.3d 1464, 45 U.S.P.Q.2D (BNA)

1161. **HN8**↑ The recapture rule "prevents a patentee from regaining through reissue . . . subject matter that he surrendered in an effort to obtain allowance of the original claims." Clement, 131 F.3d at 1468, 45 U.S.P.Q.2D (BNA) at 1164. The rule is rooted in the "error" requirement in that such a surrender is not the type of correctable "error" contemplated by the reissue statute. See Mentor, 998 F.2d at 995-96, 27 U.S.P.Q.2D (BNA) at 1525.

In its motion for summary judgment, Stein presented the recapture rule as one basis for finding the asserted reissue claims invalid, and Stein repeats this argument on appeal as one basis for affirming the summary judgment of invalidity. While the district court did not explicitly rule on this ground, its opinion indicates the view that Hester, through the reissue patents, recaptured surrendered subject matter. Hester, 963 F. Supp. at 1412 (stating that through the reissues, Hester obtained claims covering "ovens with characteristics repeatedly distinguished and disclaimed in the PTO" and that that was contrary to the "error" requirement [\*25] of § 251). As will be next explained, we conclude that the asserted reissue claims violate the recapture rule and that the summary judgment ruling is appropriately affirmed on this ground.

**HN9**↑ "Under [the recapture] rule, claims that are 'broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution' are impermissible." Clement, 131 F.3d at 1468, 45 U.S.P.Q.2D (BNA) at 1164 (quoting Mentor, 998 F.2d at 996, 27 U.S.P.Q.2D (BNA) at 1525). Application of the recapture rule begins with a determination of whether and in what respect the reissue claims are broader than the original patent claims. See id. A reissue claim that does not include a limitation present in the original patent claims is broader in that respect. See id. Here, it is undisputed that the asserted reissue claims are broader than the original patent claims in that the reissue claims do not include the "solely with steam" and "two sources of steam" limitations found in each of the original patent claims.

Having determined that the reissue claims are broader in these respects, under the recapture rule we next examine whether these broader aspects relate to surrendered [\*26] subject matter. See 131 F.3d at

1468-69, 45 U.S.P.Q.2D (BNA) at 1164. **HN10**↑ "To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for *arguments* and changes to the claims made in an effort to overcome a prior art rejection." Id. at 1469, 45 U.S.P.Q.2D (BNA) at 1164 (emphasis added). This statement in Clement indicates that a surrender can occur by way of arguments or claim changes made during the prosecution of the [\*1481] original patent application. To date, the cases in which this court has found an impermissible recapture have involved claim amendments or cancellations. See, e.g., id. at 1469-70, 45 U.S.P.Q.2D (BNA) at 1164-65; Mentor, 998 F.2d at 995-96, 27 U.S.P.Q.2D

(BNA) at 1524-25. However, in addition to the suggestion in *Clement* that argument alone can effect a surrender, this court expressly left open that possibility in *Ball Corp. v. United States*: "If reissue is sought where claims have not been previously canceled, analysis becomes more difficult. In that case relative claim scope is not available to illuminate the alleged error. We are not faced with that situation in this proceeding." 729 F.2d 1429, 1436 n.19, 221 U.S.P.Q. (BNA) 289, 295 n.19 [\*\*27] (Fed. Cir. 1984). Prior to this case, this court has not squarely addressed the question.

This court's prior opinions indicate that, as a general proposition, <sup>HN11</sup> in determining whether there is a surrender, the prosecution history of the original patent should be examined for evidence of an admission by the patent applicant regarding patentability. See *Clement*, 131 F.3d at 1468, 45 U.S.P.Q.2D (BNA) at 1164 (noting that, with regard to claim amendments, the recapture rule does not apply in the absence of evidence that the amendment was an admission that the scope of the claim was not patentable); *Mentor*, 998 F.2d at 995, 27 U.S.P.Q.2D (BNA) at 1524 (same); *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 U.S.P.Q. (BNA) 568, 574 (Fed. Cir. 1984) (declining to apply the recapture rule when there was no evidence that the "amendment . . . was in any sense an admission that the scope of [the] claim was not patentable"). In this regard, claim amendments are relevant because an amendment to overcome a prior art rejection evidences an admission that the claim was not patentable. See *Mentor*, 998 F.2d at 995-96, 27 U.S.P.Q.2D (BNA) at 1524-25 (finding surrender by way of claim amendments); [\*\*28] *Ball*, 729 F.2d at 1436, 221 U.S.P.Q. (BNA) at 294 (noting that a court may draw inferences from changes in claim scope).

Arguments made to overcome prior art can equally evidence an admission sufficient to give rise to a finding of surrender. Indeed, in *Mentor* and *Clement* the findings of a surrender were based in part on the arguments made in conjunction with the claim amendments. *Mentor*, 998 F.2d at 995-96, 27 U.S.P.Q.2D (BNA) at 1524-25; *Clement*, 131 F.3d at 1470-71, 45 U.S.P.Q.2D (BNA) at 1165-66. Logically, this is true even when the arguments are made in the absence of any claim amendment. Amendment of a claim is not the only permissible predicate for establishing a surrender.

<sup>HN12</sup> The view that arguments alone can give rise to a surrender is consistent with the policy behind the reissue statute and the accompanying recapture rule. As already noted, the reissue statute is "based on fundamental principles of equity and fairness." *Weiler*, 790 F.2d at 1579, 229 U.S.P.Q. (BNA) at 675. There is no unfairness in binding the patentee to deliberate assertions made in order to obtain allowance of the original patent claims over the prior art. Indeed, fairness to the public must also be considered. In this [\*\*29] regard, as stated in *Mentor*, "the reissue statute cannot be construed in such a way that competitors, properly relying on prosecution history, become patent infringers when they do so." 998 F.2d 992 at 996, 27 U.S.P.Q.2D (BNA) 1521 at 1525. The recapture rule operates to prevent this from happening. See *id.* Furthermore, as recognized in *Ball*, the recapture rule is based on principles of equity and therefore embodies the notion of estoppel. 729 F.2d at 1439, 221 U.S.P.Q. (BNA) at 296.

Indeed, <sup>HN13</sup> the recapture rule is quite similar to prosecution history estoppel, which prevents the application of the doctrine of equivalents in a manner contrary to the patent's prosecution history. See *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 137 L. Ed. 2d 146, 117 S. Ct. 1040, 1051 (1997). Like the recapture rule, prosecution history estoppel prevents a patentee from regaining subject matter surrendered during prosecution in support of patentability. See *id.*

Hester argues that an analogy cannot be made with prosecution history estoppel because the reissue procedure and prosecution history estoppel are the antithesis of one another--reissue allows an expansion of patent rights whereas prosecution history [\*\*30] estoppel [\*\*1482] is limiting. However, Hester's argument is unpersuasive. The analogy is not to the broadening aspect of reissues. Rather, the analogy is with the recapture rule, which restricts the permissible range of expansion through reissue just as prosecution history estoppel restricts the permissible range of equivalents under the doctrine of equivalents.

This court earlier concluded that <sup>HN14</sup> prosecution history estoppel can arise by way of unmistakable assertions made to the Patent Office in support of patentability, just as it can by way of amendments to avoid prior art. See, e.g., *Texas Instruments, Inc. v. International Trade Comm'n*, 988 F.2d 1165, 1174, 26 U.S.P.Q.2D (BNA) 1018, 1025 (Fed. Cir. 1993). The same reasoning that led us to conclude that arguments alone can give rise to prosecution history estoppel lends support to the proposition that

arguments alone can give rise to a surrender for purposes of the recapture rule.

Thus we conclude that, <sup>HN15</sup> in a proper case, a surrender can occur through arguments alone. We next evaluate whether such a surrender occurred here with respect to the "solely with steam" and "two sources of steam" limitations, the pertinent aspects in which the asserted <sup>HN31</sup> reissue claims are broader than the original patent claims. The obvious conclusion is that there has been a surrender.

As detailed above, Williams repeatedly argued that the "solely with steam" and "two sources of steam" limitations distinguished the original claims from the prior art. These were Williams' primary bases for distinguishing the broadest claim, independent claim 1, from the prior art. At no less than 27 places in six papers submitted to the Patent Office, Williams asserted that the "solely with steam" limitation distinguished the claimed invention from the prior art, and Williams did the same with respect to the "two sources of steam" limitation at no less than 15 places in at least five papers.

Williams argued that each of these limitations was "critical" with regard to patentability, and Williams further stated that the "solely with steam" limitation was "very material" in this regard. In essence, these repeated arguments constitute an admission by Williams that these limitations were necessary to overcome the prior art. Indeed, when the Board reversed the Examiner's rejection of the original claims, these were the primary bases indicated for patentability. Williams, <sup>HN32</sup> through his admission effected by way of his repeated prosecution arguments, surrendered claim scope that does not include these limitations.

<sup>HN16</sup> Having concluded that there has been a surrender, we must next determine whether the surrendered subject matter has crept back into the asserted reissue claims. See Clement, 131 F.3d at 1469, 45 U.S.P.Q.2D (BNA) at 1164. When the surrender occurs by way of claim amendment or cancellation, "comparing the reissue claim with the canceled claim is one way to do this." See *id.* This analysis is not available when the surrender is made by way of argument alone. Instead, in this case, we simply analyze the asserted reissue claims to determine if they were obtained in a manner contrary to the arguments on which the surrender is based.

Clearly they were. None of the asserted reissue claims include either the "solely with steam" limitation or the "two sources of steam" limitation. Thus, this surrendered subject matter—*i.e.*, cooking other than solely with steam and with at least two sources of steam—has crept into the reissue claims. The asserted reissue claims are unmistakably broader in these respects.

Finally, <sup>HN17</sup> because the recapture rule may be <sup>HN33</sup> avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects. See, e.g., Mentor, 998 F.2d at 996, 27 U.S.P.Q.2D (BNA) at 1525 ("Reissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule."); Clement, 131 F.3d at 1470, 45 U.S.P.Q.2D (BNA) at 1165. For example, in Ball the recapture rule was avoided because the reissue claims were sufficiently narrowed (described by the court as "fundamental narrowness") despite the broadened aspects of the claims. 729 F.2d at 1438, 221 U.S.P.Q. (BNA) at 296. In the context of a surrender by way of argument, this principle, in appropriate cases, may operate to overcome the recapture rule when the reissue claims are materially narrower in <sup>HN1483</sup> other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.

However, this is not such a case. The asserted reissue claims are not materially narrower, despite Hester's arguments to the contrary. Hester argues that the claims are materially narrower by <sup>HN34</sup> the addition of the "spiral conveyance path" and "high humidity steam" limitations. The term "high humidity steam" is included in each of the asserted reissue claims except reissue claim 30 of the '259 reissue patent. However, the term "high humidity steam" is actually the same as or broader than the limitation in original claim 1 that this term replaced. Original claim 1 specifies a steam atmosphere "at near 100% humidity 100 degrees C. and a pressure above atmospheric." '047 patent, col. 6, ll. 3-4. Hester concedes that the term "high humidity steam" is not narrower than this limitation in original claim 1. In fact, with respect to the claim construction issue, Hester argues that the limitation in original claim 1 is but one example of "high humidity steam." Accordingly, the use of the term "high humidity steam" does not save the reissue claims from the recapture rule.

The term "spiral conveyance path" is also not materially limiting. This term appears explicitly in asserted reissue claims 28, 32, 75, and 76 of the '259 reissue patent; it does not appear explicitly in the other reissue claims asserted. Original claim 1 includes a corresponding limitation, namely, "means

passing [\*\*35] said conveyor belt through said housing . . . ." This is <sup>HN18</sup> a so-called means-plus-function clause drafted pursuant to 35 U.S.C. § 112 P 6 (1994). n7 According to § 112 P 6, the clause is to be construed to "cover the corresponding structure . . . described in the specification and equivalents thereof." The only corresponding structure described in the specification (more properly, the written description of the patent) passes the conveyor belt through a spiral path. See '047 patent, col. 4, l. 64 to col. 5, l. 8. Thus, the explicit recitation of a "spiral conveyance path" in some of the asserted reissue claims does not materially narrow those claims. Indeed, Hester does not explain how the explicit recitation of a spiral conveyance path—which is present in prior art cookers cited by the examiner during the prosecution of the original patent—materially narrows these claims. In sum, neither alone nor together do the terms "high humidity steam" and "spiral conveyance path" materially narrow the claims.

----- Footnotes -----

n7 <sup>HN19</sup> Use of the word "means" in a claim clause triggers a presumption that § 112 P 6 applies. See York Prods., Inc. v. Central Tractor Farm & Family Ctr., 99 F.3d 1568, 1574, 40 U.S.P.Q.2D (BNA) 1619, 1623-24 (Fed. Cir. 1996). The presumption can be overcome if the clause recites sufficient structure. See id. The clause at issue here recites no structure for performing the function of passing the conveyor belt through the housing. Accordingly, § 112 P 6 unquestionably applies.

----- End Footnotes ----- [\*\*36]

Furthermore, the "spiral conveyance path" and "high humidity steam" limitations are not aspects of the invention that were overlooked during prosecution of the original patent. To the contrary, as just explained, these aspects were included in original claim 1. Additionally, with regard to the "spiral conveyance path" limitation, original dependent claim 12 explicitly recites "a spiral path." '047 patent, col. 6, l. 60. In prosecuting the original patent, Williams pointed out these features in an attempt to overcome the Examiner's obviousness rejection. Hester cannot now argue that Williams overlooked these aspects during the prosecution of the original patent application. In conclusion, this is not a case which involves the addition of material limitations that overcome the recapture rule.

In effect, Hester, through eight years of reissue proceedings, prosecuted Williams' original patent application anew, this time placing greater emphasis on aspects previously included in the original patent claims and removing limitations repeatedly relied upon to distinguish the prior art and described as "critical" and "very material" to the patentability of the invention. The reissue statute [\*\*37] is to be

construed liberally, but not that liberally. <sup>HN20</sup> The realm of corrections contemplated within § 251 does not include recapturing surrendered subject matter, without the addition of materially-narrowing [\*\*1484] limitations, in an attempt to 'custom-fit' the reissue claims to a competitor's product.

No doubt if two patent attorneys are given the task of drafting patent claims for the same invention, the two attorneys will in all likelihood arrive at somewhat different claims of somewhat different scope. And such differences are even more likely when, as here, the second attorney drafts the new claims nearly a decade later and with the distinct advantage of having before him the exact product offered by the now accused infringer. This reality does not justify recapturing surrendered subject matter under the mantra of "failure to appreciate the scope of the invention." The circumstances of the case before us simply do not fit within the concept of "error" as contemplated by the reissue statute. See Mentor, 998 F.2d at 996, 27 U.S.P.Q.2D

(BNA) at 1525 (<sup>HN21</sup> "Error under the reissue statute does not include a deliberate decision to surrender specific subject matter in order to overcome prior art, a [\*\*38] decision which in light of subsequent developments in the marketplace might be regretted.").

With respect to the recapture issue, there are no underlying material facts as to which there is a genuine issue in dispute. The original patent's prosecution history, on which we rely, is before us and undisputed. All that remains is the ultimate legal conclusion as to whether the asserted reissue claims fail to meet the "error" requirement because the claims impermissibly recapture surrendered subject matter. See id. at



994, 27 U.S.P.Q.2D (BNA) at 1524 (stating that whether the "error" requirement has been met is a legal conclusion). For the reasons explained above, we conclude as a matter of law that the asserted reissue claims fail in this regard. Summary judgment of invalidity of the asserted reissue claims under § 251 is called for. Accordingly, we affirm the district court's entry of summary judgment.

## B

As an alternative basis for holding the asserted reissue claims invalid, the district court concluded that the reissue claims do not meet the "original patent" clause of § 251 P 1, which requires that the reissue patent be "for the invention disclosed in the original patent." Hester, [<sup>\*\*39</sup>] 963 F. Supp. at 1412. In reaching this conclusion, the court interpreted the "original patent" clause as requiring an "objective" intent, manifested in the original patent, to claim the invention as claimed in the reissue patent. *Id.* The court based this interpretation on the Supreme Court's statement in U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp., 315 U.S. 668, 676, 86 L. Ed. 1105, 62 S. Ct. 839 (1942), that there was an objective intent requirement under the predecessor reissue statute, 35 U.S.C. § 64 (1964), which required that the reissue patent be "for the same invention." 963 F. Supp. at 1413.

Based on this construction of the "original patent" clause, the district court framed the issue as, "whether the 047 patent manifests an objective intent to cover ovens that utilize heat sources other than steam, and have less than two steam sources." *Id.* The district court concluded that the asserted reissue claims failed to meet this test and thus were invalid under the "original patent" clause. *Id.* at 1413-15. On appeal, the parties focus on whether the "original patent" clause embodies the requirement of an objective intent to claim.

This court [<sup>\*\*40</sup>] squarely addressed the issue in Amos, 953 F.2d at 616, 21 U.S.P.Q.2D (BNA) at 1273.

The Amos court held that <sup>HN22</sup> § 251 does not include a separate requirement of an objective intent to claim. 953 F.2d at 618-19, 21 U.S.P.Q.2D (BNA) at 1275-76. Rather, the court concluded: "the essential inquiry under the 'original patent' clause of § 251 . . . is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees." *Id.* at 618, 21 U.S.P.Q.2D (BNA) at 1275. The court noted that this inquiry is analogous to the "written description" requirement of 35 U.S.C. § 112 P 1 (1994). *Id.* The court further stated that, to the extent the construct of an objective intent to claim is useful, it is "only one factor that sheds light" on whether the "original patent" clause of § 251 is satisfied. *Id.* at 619 & n.2, 21 U.S.P.Q.2D (BNA) at 1275-76 & n.2 (quoting In re Hounsfield, 699 F.2d 1320, 1323, [<sup>\*1485</sup>] 216 U.S.P.Q. (BNA) 1045, 1047-48 (Fed. Cir. 1983)).

With regard to the Supreme Court's opinion in U.S. Industrial, 315 U.S. 668, 86 L. Ed. 1105, 62 S. Ct. 839, the Amos court noted that that case was decided under the predecessor reissue statute [<sup>\*\*41</sup>] which required reissue claims to be for the "same invention," and concluded that U.S. Industrial does not now mandate a separate "objective intent to claim" requirement. *Id.* The Amos court noted that this court reached the same conclusion eight years earlier in Hounsfield, 699 F.2d at 1323, 216 U.S.P.Q. (BNA) at 1047-48. *Id.*

Thus, the district court's conclusion that the "original patent" clause of § 251 was not satisfied based on an "objective intent to claim" requirement was in error. Stein does not contend that the test set forth in Amos for the "original patent" clause--i.e., whether one skilled in the art would identify the subject matter of the reissue claims as invented and disclosed by the patentee--is not met by the asserted reissue claims. Rather, Stein relies entirely on its assertion that there is an "objective intent to claim" requirement and that that requirement is not met. However, we need not resolve this issue further, having already concluded that the asserted reissue claims are invalid for failing to meet the "error" requirement of § 251.

## III

Finally, Stein presents to us the question of whether the district court properly construed the claim [<sup>\*\*42</sup>] term "high humidity steam." It is not immediately apparent whether this issue is properly before us. The district court did not construe the term in conjunction with a final judgment, such as a summary judgment of noninfringement or invalidity. Rather, the district court issued an oral ruling on the matter in preparation for trial. However, the district court having held the asserted claims invalid on summary judgment, which we here affirm, there can be no question of liability and hence the claim construction issue is moot. Therefore, we need not decide whether Stein's appeal of the claim construction is proper, and if so,

whether the district court's construction was correct.

#### CONCLUSION

We affirm the grant of summary judgment of invalidity of the asserted reissue claims for failure to comply with 35 U.S.C. § 251 P1. Stein's cross-appeal is dismissed.

#### COSTS

Each party shall bear its own costs.

#### AFFIRMED

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11. Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 27 USPQ2d 1521 (Fed. Cir. 1993)

**Document Links:**

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OPINION:

SHEPARD'S® 998 F.2d 992, \*, 1993 U.S. App. LEXIS 18350, \*\*;  
27 U.S.P.Q.2D (BNA) 1521

MENTOR CORPORATION, Plaintiff/Cross-Appellant, v. COLOPLAST, INC., Defendant-Appellant.

92-1428, 92-1429

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

998 F.2d 992; 1993 U.S. App. LEXIS 18350; 27 U.S.P.Q.2D (BNA) 1521

July 20, 1993, Decided

**SUBSEQUENT HISTORY:** As Corrected September 15, 1993. Petition for Rehearing Denied and In Banc Suggestion Declined November 1, 1993, Reported at: 1993 U.S. App. LEXIS 28688.

**PRIOR HISTORY:** [\*\*1] Appealed from: U.S. District Court for the Middle District of Florida. Judge Conway

**DISPOSITION:** AFFIRMED-IN-PART, REVERSED-IN-PART, AND VACATED-IN-PART

**CASE SUMMARY**

**PROCEDURAL POSTURE:** Defendant appealed a decision by the United States District Court for the Middle District of Florida that found that plaintiff's patent was valid and that defendant had infringed it. Plaintiff cross-appealed the district court's judgment as a matter of law that defendant had not willfully infringed plaintiff's patent.

**OVERVIEW:** Plaintiff patented a catheter system. Plaintiff sued defendant for patent infringement. Defendant counterclaimed for a declaration of invalidity of plaintiff's patent, unenforceability of patent, and noninfringement. The jury found for plaintiff. The district court upheld the jury's finding of infringement but set aside the finding of willfulness. Both plaintiff and defendant appealed. The court held that part of plaintiff's patent was invalid because plaintiff had attempted to recapture a portion of its original patent application that it had removed so that its patent would be granted. Plaintiff's reissue claim could not be broader than its original application. Defendant did

not infringe the other portion of plaintiff's patent because defendant's transfer system was different from plaintiff's patented system. Lastly, because the court reversed the district court's decisions as to infringement and invalidity, the court did not address plaintiff's appeal. Therefore, the court affirmed in part, reversed in part, and vacated in part.

**OUTCOME:** The court reversed the judgment for infringement and invalidity because plaintiff's reissue claim had improperly expanded the scope of its patent and defendant's system did not infringe the remaining portion of plaintiff's patent, but the court did not consider plaintiff's appeal where its other decisions disposed of the case.

**CORE TERMS:** surface, adhesive, outer, reissue, inner, catheter, sheath, patent, layer, recapture, matter of law, cylindrical, rolled, roll, infringement, unrolled, male, transferred, recite, surrendered, patentee, materially, rolling, penis, original patent, condom, unrolling, examiner, invalid, original application

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Civil Procedure > Trials > Judgment as Matter of Law > General Overview

Civil Procedure > Judgments > General Overview

**HN1** On appeal of a judgment entered on a verdict after denial of a motion for judgment as a matter of law under Fed. R. Civ. P. 50(b), appellant must show (1) that reasonable persons could not in light of evidence before them have found the facts necessary to support the jury's verdict; or (2) that the facts properly found cannot in law support that verdict.

Civil Procedure > Appeals > Standards of Review > De Novo Review

Civil Procedure > Appeals > Standards of Review > Substantial Evidence > General Overview

**HN2** Whether the statutory requirement of "error" under 35 U.S.C.S. § 251 (1988) has been met is an issue of law which the court reviews de novo. This legal conclusion is based on underlying factual inquiries which are reviewed for substantial evidence.

Patent Law > U.S. Patent & Trademark Office Proceedings > Filing Requirements > Drawings

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Requirements

**HN3** See 35 U.S.C.S. § 251.

Criminal Law & Procedure > Appeals > Standards of Review > De Novo Review > General Overview

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Requirements

**HN4** Reissue "error" is generally liberally construed, and the court recognizes that an attorney's failure to appreciate the full scope of the invention is not an uncommon defect in claiming an invention. However, the reissue procedure does not give the patentee a second opportunity to prosecute de novo his original application.

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN5** The deliberate cancellation of a claim of an original application in order to secure a patent cannot ordinarily be said to be an "error" and will in most cases prevent the applicant from obtaining the cancelled claim by reissue. The extent to which it may also prevent him from obtaining other claims differing in form or substance from that cancelled necessarily depends upon the facts in each case and particularly on the reasons for the cancellation.

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Requirements

**HN6** If a patentee tries to recapture what he or she previously  
↓ surrendered in order to obtain allowance of original patent claims,  
that deliberate withdrawal or amendment cannot be said to involve  
the inadvertence or mistake contemplated by 35 U.S.C. § 251 (1988),  
and is not an error of the kind which will justify the granting of a  
reissue patent which includes the matter withdrawn.

Patent Law > Claims & Specifications > Description Requirement > General Overview  
Patent Law > U.S. Patent & Trademark Office Proceedings > Examinations > General Overview  
Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Broadening Reissues &  
Recapture

**HN7** The recapture rule bars the patentee from acquiring, through  
↓ reissue, claims that are of the same or of broader scope than those  
claims that were cancelled from the original application. The  
recapture rule does not apply where there is no evidence that  
amendment of the originally filed claims was in any sense an  
admission that the scope of that claim was not in fact patentable.

Patent Law > Infringement Actions > Prosecution History Estoppel > General Overview  
Patent Law > Statutory Bars > Abandonment & Forfeiture Bar > Abandonment  
Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

**HN8** The reissue statute cannot be construed in such a way that  
↓ competitors, properly relying on prosecution history, become patent  
infringers when they do so.

Patent Law > Claims & Specifications > Description Requirement > General Overview  
Patent Law > U.S. Patent & Trademark Office Proceedings > Continuation Applications > General  
Overview  
Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Broadening Reissues &  
Recapture

**HN9** Reissue claims that are broader in certain respects and narrower in  
↓ others may avoid the effect of the recapture rule. If a reissue  
claim is broader in a way that does not attempt to reclaim what was  
surrendered earlier, the recapture rule may not apply.

Civil Procedure > Appeals > Standards of Review > De Novo Review  
Patent Law > Claims & Specifications > Claim Language > Product by Process  
Patent Law > Jurisdiction & Review > Standards of Review > General Overview

**HN10** Claim construction is an issue of law which the court reviews de  
↓ novo.

Patent Law > Claims & Specifications > Claim Language > Product by Process  
Patent Law > Infringement Actions > Claim Interpretation > General Overview

**HN11** Product-by-process claims recite how a product is made, not how it  
↓ is used.

**COUNSEL:** William L. Anthony, Jr., Brobeck, Phleger & Harrison, of Palo Alto, California, argued for  
plaintiff/cross-appellant. With him on the brief was Robert W. Duckworth, Maguire, Voorhis & Wells, P.A.,  
of Orlando, Florida. Of counsel was Robert L. Walter.

Edward A. Meilman, Ostrolenk, Faber, Gerb & Soffen, of New York, New York, argued for  
defendant-appellant. With him on the brief were Marvin C. Soffen and William O. Gray, III.

**JUDGES:** Before LOURIE, CLEVINGER, and SCHALL, Circuit Judges.

**OPINION BY:** LOURIE

## OPINION:

[\*993] LOURIE, Circuit Judge.

This is an appeal and cross-appeal from the April 7, 1992 judgment of the United States District Court for the Middle District of Florida, *Mentor Corp. v. Coloplast, Inc.*, Case Nos. 89-954-Civ-T-22A, 90-528-Civ-T-22A (M.D. Fla. 1992). Following a March 1992 jury verdict, judgment was entered against Coloplast, Inc., holding, inter alia, that all the original and reissued claims of Mentor Corporation's U.S. Patent Re. 33,206 were willfully infringed, that the '206 patent was not invalid, and that Coloplast was liable for \$ 250,000 [\*2] in damages. The district court subsequently granted Coloplast's motion for judgment as a matter of law that willfulness was not shown, and denied its motion in all other respects. Coloplast appeals on the issues of validity and infringement. Mentor cross-appeals on the issue of willfulness. We affirm-in-part, reverse-in-part, and vacate-in-part.

## BACKGROUND

In July 1989, Mentor sued Coloplast for infringement of U.S. Patent 4,475,910, entitled "Male Condom Catheter Having Adhesive on Rolled Portion." While the lawsuit was pending, it was reissued as the '206 patent and Coloplast filed a separate suit for a declaration of invalidity, unenforceability, and noninfringement of that patent. Mentor amended its complaint in the original action to allege infringement of the '206 patent and the two cases were consolidated.

The claimed invention relates to a condom catheter which is used on male patients suffering from incontinence. Claims 1-4 of the '206 patent recite a catheter having a pressure sensitive adhesive on a non-stick (release) layer located on the outer surface of a condom sheath prior to it being rolled up, such that on rolling the sheath outwardly, the adhesive on the [\*3] outer surface comes into contact with and sticks to the inner surface. When unrolled, the adhesive which was initially applied to the release layer on the outer surface is thereby transferred to the inner surface. Claim 1, from which claims 2-4 depend, reads:

A male condom catheter designed to be connected to a urine collection means and comprising a thin cylindrical sheath member of resilient material rolled outwardly upon itself to form consecutively larger rolls, said sheath member having an outer surface and an inner surface designed to engage a penis when the catheter is unrolled, and the outer surface of the sheath member having prior to the rolling thereof a layer of pressure sensitive adhesive over a substantial portion thereof with a release layer between said adhesive and the outer surface of the sheath member so that as the sheath member is rolled up the pressure sensitive adhesive on the outer surface is in direct contact with the inner surface of an adjacent roll so that as the sheath member is unrolled the adhesive on the outer surface is transferred to the portion of the inner surface in engagement with the outer surface, without rolling the catheter inside [\*4] out, to cause the inner surface to adhere to the penis over which the sheath is placed.

(Emphasis added.)

Claims 6-9, which were added during reissue, do not recite the transfer of adhesive from the outer to the inner surface of the catheter. They read as follows:

6. A male condom catheter to be adhesively secured to a penis and designed to be connected to a urine collection means, said catheter comprising a thin, flexible [\*994] cylindrical member of resilient material rolled outwardly upon itself to form a single roll with consecutively larger turns, the outer surface of the cylindrical member having an adhesive release layer thereon and said turns having a layer of pressure sensitive adhesive therebetween in contact with the inner surface of the cylindrical member and in contact with the release layer so that upon said cylindrical member being unrolled onto a penis, the adhesive releases from the adhesive release layer due to the unrolling of the cylindrical member and adheres only to the inner surface of the cylindrical member to cause the cylindrical member to adhere to the penis.

7. The catheter of claim 6 in which the adhesive release layer and the adhesive extend over [\*\*5] at least one turn of the roll.
8. The catheter of claim 6 in which there is a bulbous surge chamber secured to the outlet side of the cylindrical member.
9. The catheter of claim 6 in which the adhesive release layer is formed of silicon rubber.

Coloplast sells the Coloplast Self Sealing Urosheath, which is made by applying adhesive directly to the inner surface, the outer surface being coated with a non-stick, release layer. Use of the Coloplast device does not involve the transfer of adhesive from the outer to the inner surface. Coloplast admitted that its device was covered by broadened reissue claims 6-9, but asserted that it had acquired intervening rights and, in any event, that the claims were invalid.

The district court entered judgment according to the jury's answers to special interrogatories, finding, *inter alia*, that Coloplast infringed claims 1-4 of the '206 patent by the sale of the Coloplast Urosheath, that Coloplast had willfully infringed the '206 patent, that Mentor's broadened reissue claims 6-9 did not recapture any subject matter deliberately cancelled by Mentor, and that Coloplast had not acquired intervening rights with respect to claims 6-9. Following [\*\*6] Coloplast's post-trial motion for judgment as a matter of law, the court upheld the jury's finding of infringement, but set aside the finding of willfulness.

#### DISCUSSION

**HN1** ↑ On appeal of a judgment entered on a verdict after denial of a motion for judgment as a matter of law under Fed. R. Civ. P. 50(b), Coloplast must show

(1) that reasonable persons could not in light of . . . evidence [before them] have found the facts necessary to support the jury's verdict; or (2) that the facts properly found cannot in law support that verdict.

Railroad Dynamics, Inc. v. A. Stucki Co., 727 F.2d 1506, 1513, 220 U.S.P.Q. (BNA) 929, 936 (Fed. Cir.), cert. denied, 469 U.S. 871, 83 L. Ed. 2d 150, 105 S. Ct. 220 (1984).

Coloplast argues that claims 6-9 of the reissue patent are invalid because they are not based on "error" within the meaning of 35 U.S.C. § 251 (1988). Coloplast argues that Mentor deliberately and intentionally amended its claims in response to a prior art rejection and that such conduct is not reissuable error. Thus, it asserts, the court erred as a matter of law. We agree.

**HN2** ↑ Whether the statutory requirement [\*\*7] of "error" has been met is an issue of law which we review *de novo*. This legal conclusion is based on underlying factual inquiries which are reviewed for substantial evidence. See Ball Corp. v. United States, 729 F.2d 1429, 1439, 221 U.S.P.Q. (BNA) 289, 297 (Fed. Cir. 1984) ("On the basis of the facts before us and the reasons given for the cancellation of the claims from the original application, we cannot find, as a matter of law, that [the patentee] is barred from securing reissue. . . .").

Section 251 provides in pertinent part:

**HN3** ↑ Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall . . . reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of



the term of the original patent.

[\*995] <sup>HN4</sup> Reissue "error" is generally liberally construed, and we have recognized that "an attorney's failure to appreciate the full scope of the [\*8] invention" is not an uncommon defect in claiming an invention. In re Wilder, 736 F.2d 1516, 1519, 222 U.S.P.Q. (BNA) 369, 371 (Fed. Cir. 1984), cert. denied, 469 U.S. 1209, 84 L. Ed. 2d 323, 105 S. Ct. 1173 (1985). However, the reissue procedure does not give the patentee "a second opportunity to prosecute de novo his original application," In re Weiler, 790 F.2d 1576, 1582, 229 U.S.P.Q. (BNA) 673, 677 (Fed. Cir. 1986).

<sup>HN5</sup> The deliberate cancellation of a claim of an original application in order to secure a patent cannot ordinarily be said to be an "error" and will in most cases prevent the applicant from obtaining the cancelled claim by reissue. The extent to which it may also prevent him from obtaining other claims differing in form or substance from that cancelled necessarily depends upon the facts in each case and particularly on the reasons for the cancellation.

In re Willingham, 48 C.C.P.A. 727, 282 F.2d 353, 357, 127 U.S.P.Q. (BNA) 211, 215 (CCPA 1960).

<sup>HN6</sup> If a patentee tries to recapture what he or she previously surrendered in order to obtain allowance of original patent claims, [\*9] that "deliberate withdrawal or amendment . . . cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. § 251, and is not an error of the kind which will justify the granting of a reissue patent which includes the matter withdrawn." Haliczer v. United States, 174 Ct.

Cl. 507, 356 F.2d 541, 545, 148 U.S.P.Q. (BNA) 565, 569 (Ct. Cl. 1966). <sup>HN7</sup> "The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or of broader scope than those claims that were cancelled from the original application." Ball Corp., 729 F.2d at 1436, 221 U.S.P.Q. (BNA) at 295 (citations omitted). The recapture rule does not apply where there is no evidence that amendment of the originally filed claims was in any sense an admission that the scope of that claim was not in fact patentable, Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 U.S.P.Q. (BNA) 568, 574 (Fed. Cir. 1984), but that is not the situation here.

During prosecution of the original patent application, the examiner rejected claim [\*10] 1 as unpatentable over U.S. Patent 4,187,851 to Hauser in view of U.S. Patent 2,389,831 to Welsh and U.S. Patent 3,403,682 to McDonell. According to the examiner, Hauser lacked the positioning of an adhesive means between the rolls, which was taught by Welsh and McDonell. Mentor responded by replacing claim 1, which did not require "transfer" of adhesive from an outer layer to an inner layer, with a new claim 7, which read in part as follows:

A male condom catheter . . . comprising a thin cylindrical sheath member . . . having an outer surface and an inner surface . . . and the outer surface of the sheath member having a layer of pressure sensitive adhesive over a substantial portion thereof with a release layer between said adhesive and the outer surface of the sheath member so that as the sheath member is unrolled the adhesive on the outer surface is transferred to the portion [sic] of the inner surface in engagement with the outer surface to cause the inner surface to adhere to the penis over which the sheath is placed.

(Emphasis added.)

The claims were again rejected under 35 U.S.C. § 103 as unpatentable over McDonell in view [\*11] of

Welsh. The examiner stated that McDonell disclosed a male catheter with a sheath having an outer surface with adhesive and a release layer, and that Welsh showed a sheath with adhesive, which when unrolled was transferred from the outer surface to the inner surface. In response, Mentor further amended claim 7 to recite that as the sheath member is

rolled up the pressure sensitive adhesive on the outer surface is in direct contact with the inner surface of an adjacent roll so that as the sheath member is unrolled, the adhesive on the outer surface is transferred without rolling the catheter inside out. . . .

(Emphasis added.) Mentor argued that "none of the references relied upon actually showed the transfer of adhesive from the outer surface to the inner surface as the sheath is rolled up and then unrolled." Mentor [\*\*996] characterized the prior art references as disclosing the "transfer" of adhesive from the outer to the inner surface solely by turning the sheath inside out so that the outer surface becomes the inner surface and the adhesive always remains on the same surface. Amended claim 7 then issued as claim 1 as a result of Mentor's amendments and argument.

Within [\*\*12] two years of issuance, Mentor filed a reissue application accompanied by an attorney declaration, stating that Mentor claimed less than it had a right to claim because the claims of the '910 patent did not "read literally upon male external catheters manufactured using a process in which the adhesive is applied to the inner latex surface of the sheath at the time of manufacture, before the device was rolled." The declaration further stated that "the error arose because [the attorney] assumed that the manufacture of male external catheters by applying the adhesive to the inner latex surface of the catheter was too impractical to be commercially feasible . . . ." Mentor thus added new claims lacking the requirement of transfer of adhesive from the outer to the inner layer. The examiner rejected the claims as obvious over McDonell in view of Welsh. After Mentor submitted detailed information on commercial success, the examiner allowed the claims and the patent was reissued with original claims 1-4 and new claims 6-9.

Coloplast correctly argues that reissue claim 6, which does not include the adhesive transfer limitation, impermissibly recaptures what Mentor deliberately surrendered [\*\*13] in the original prosecution. Specifically, the reissue claims do not contain the limitation that, during rolling and unrolling, the adhesive be transferred from the outer to the inner surface of the catheter.

Error under the reissue statute does not include a deliberate decision to surrender specific subject matter in order to overcome prior art, a decision which in light of subsequent developments in the marketplace might be regretted. It is precisely because the patentee amended his claims to overcome prior art that a member of the public is entitled to occupy the space abandoned by the patent applicant. Thus, <sup>HNS</sup> the reissue statute cannot be construed in such a way that competitors, properly relying on prosecution history, become patent infringers when they do so. In this case, Mentor narrowed its claims for the purpose of obtaining allowance in the original prosecution and it is now precluded from recapturing what it earlier conceded.

Mentor argues that the reissue claims do not recapture subject matter surrendered during the original prosecution. Mentor specifically alleges that recapture is avoided because newly-added reissue claims 6-9 are materially narrower in some respects, [\*\*14] albeit broader in others.

<sup>HN9</sup> Reissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule. If a reissue claim is broader in a way that does not attempt to reclaim what was surrendered earlier, the recapture rule may not apply. However, in this case, the reissue claims are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution. Mentor thus attempted to reclaim what it earlier gave up. Moreover, the added limitations do not narrow the claims in any material respect compared with their broadening.

The limitation in claim 6 that the catheter material be "flexible" did not materially narrow the claims, which already recited that the material be "resilient." Likewise, the limitation that the catheter be rolled outward to form a "single" roll did not materially limit the claims; the catheter can only be rolled and applied from a single end to form a single roll when the other end is connected to a urine collection means. Further, the addition of the words "thereon," referring to the location of the adhesive release layer on the outer surface

prior to unrolling. [\*\*15] and "only," referring to the adhering of the adhesive to the inner surface after unrolling, did not materially narrow the claims.

Additionally, claims 7-9, which depend from claim 6, do not avoid recapture because they do not add any limitations, material in relation to the impermissible broadening, that distinguish them over claim 6, which we [\*\*997] have determined is not a proper subject for reissue. Reissue claim 7, which requires adhesive on "at least one turn of the roll," is not materially narrower than original claim 7, the subject matter of which was partially surrendered. Reissue claim 8 recites a bulbous surge chamber, which was already in the prior art. Reissue claim 9, which recites the material of the adhesive release layer, does not materially narrow the claim. Accordingly, they do not avoid recapture.

Thus, since none of reissue claims 6-9 meets the legal requirements for reissue, the court erred in denying the motion for judgment of invalidity as a matter of law. We therefore reverse that part of the court's judgment finding claims 6-9 not invalid. At this stage of the proceedings, we need not reach the issue of infringement of the reissue claims in light of our conclusion [\*\*16] regarding their invalidity. We thus vacate the holding on infringement of claims 6-9.

Coloplast also argues that it did not infringe claims 1-4 of the Mentor patent as a matter of law. We agree. Neither party disputes the structure of the Coloplast device or how it is used. The parties only dispute the

proper scope of the claims. <sup>HN10</sup> Claim construction is an issue of law which we review de novo. ZMI Corp. v. Cardiac Resuscitator Corp., 844 F.2d 1576, 1578, 6 U.S.P.Q.2D (BNA) 1557, 1559 (Fed. Cir. 1988). Mentor argues that claims 1-4 are product-by-process claims and that, under Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 18 U.S.P.Q.2D (BNA) 1001 (Fed. Cir. 1991), the process limitations do not prevent the claims from encompassing an identical product made by a different process. Mentor's argument, however, is inapplicable to the present case. The claims in issue here are not in fact product-by-process claims; <sup>HN11</sup> product-by-process claims recite how a product is made, not how it is used. The only process aspect of the present claims relates to how the product is used, and that is [\*\*17] an essential aspect of the claims.

Claims 1-4 recite a catheter in which the adhesive is transferred from the outside of the catheter to the inside upon rolling and unrolling. Neither party disputes that Coloplast's device excludes the transfer of adhesive from the outer to inner surface. Thus, as a matter of law, Coloplast's device cannot infringe those claims, and no reasonable juror could have found otherwise. The court therefore erred in denying Coloplast motion for judgment of noninfringement as a matter of law.

Because of our disposition on the issues of infringement and validity, we do not address Mentor's cross-appeal on willfulness. We affirm the judgment in all other respects.

## CONCLUSION

We reverse the district court's decision denying the motion for judgment as a matter of law concerning noninfringement of claims 1-4 and invalidity of claims 6-9. We vacate the court's judgment with respect to infringement of claims 6-9. We affirm the judgment in all other respects.

## COSTS

Costs to Coloplast.

AFFIRMED-IN-PART, REVERSED-IN-PART, AND VACATED-IN-PART

12. Ex parte Durckheimer et al., Appeal No. 94-2004, U.S. Application Ser. No. 07/551,615

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

AUG 6 - 1996

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte WALTER DURCKHEIMER, DIETER BORMANN,  
EBERHARD EHLERS, ELMAR SCHRINNER and RENE HEYMES

Appeal No. 94-2004  
Application 07/551,615<sup>1</sup>

ON BRIEF

Before GOFFNEY, Acting Deputy Assistant Secretary of Commerce and Acting Deputy Commissioner of Patents and Trademarks,<sup>2</sup> HARKCOM, Vice Chief Administrative Patent Judge, GOLDSTEIN, COHEN, LYDDANE, JOHN D. SMITH and STAAB, Administrative Patent Judges, MCKELVEY, Senior Administrative Patent Judge, and BARRETT, FLEMING, WEIFFENBACH and HANLON, Administrative Patent Judges.

WEIFFENBACH, Administrative Patent Judge.

<sup>1</sup>Application for reissue filed July 11, 1990, seeking to reissue of Patent No. 4,758,556, granted July 19, 1988, based on Application 05/891,850, filed March 30, 1978.

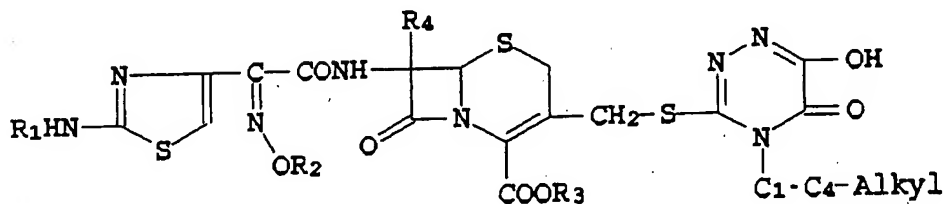
<sup>2</sup>Mr. Goffney was appointed as Assistant Commissioner for Patents. He is currently also serving as the Acting Deputy Assistant Secretary of Commerce and Acting Deputy Commissioner of Patents and Trademarks.

### DECISION ON APPEAL

This appeal is from the examiner's final rejection of claims 1-17 which are all of the original claims in the patent sought to be reissued.

The invention is related to a syn compound of a cephem derivative for pharmaceutical formulations which are active against bacterial infections. Claim 1 is illustrative of the claimed invention:

1. A syn compound of the formula



wherein in the above formula

R<sub>3</sub> is hydrogen, an alkali metal cation, or a carboxylic acid protecting group;

R<sub>4</sub> is hydrogen or methoxy;

R<sub>1</sub> is hydrogen or an amino protecting group; and

R<sub>2</sub> is hydrogen or C<sub>1</sub>-C<sub>4</sub> alkyl.

Appellant, Hoechst Aktiengesellschaft, a corporation of the Federal Republic of Germany, seeks reissue of Patent No. 4,758,556 to withdraw a terminal disclaimer filed three years before the patent issued. Appellant states that at the time the

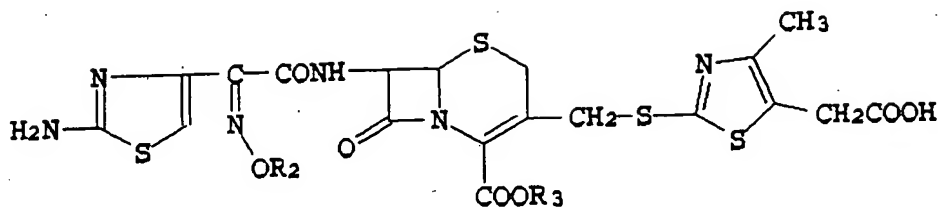
terminal disclaimer was filed it was proper, but that it later became unnecessary when the examiner made a restriction requirement and divided the generic claims subject to the disclaimer into four separate and patentably distinct inventions. The patent was granted with the terminal disclaimer. Appellant seeks by reissue to have the terminal disclaimer withdrawn or nullified.

There are no outstanding rejections based upon prior art under 35 U.S.C. § 102 and/or § 103. Claims 1-17 stand rejected under 35 U.S.C. § 251 on the ground that since the terminal disclaimer was voluntarily submitted during the prosecution of the original patent, the reissue statute does not authorize the withdrawal of a terminal disclaimer once a patent issues. For reasons discussed *infra*, we will not sustain the rejection. However, we will enter a new ground of rejection of claims 1-17 under 35 U.S.C. § 251 on the ground that the claims are based on a defective reissue declaration.

#### **Background**

The application which matured into the patent sought to be reissued, Patent No. 4,758,556, was filed on March 30, 1978 with eleven claims. The examiner determined that Markush groups in the claims embraced multiple patentably distinct inventions. He made a telephone restriction requirement requesting an election of a single species to be examined on the merits. The patent applicants

electd as the single species a compound having the following  
formula:



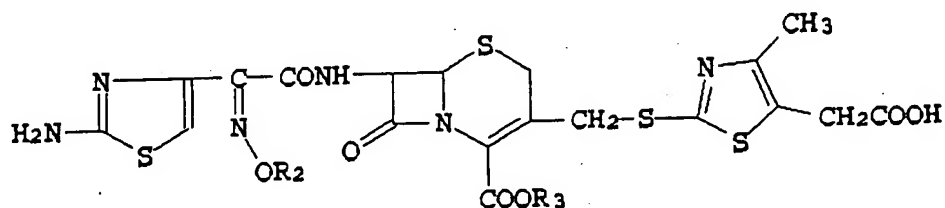
wherein  $R_2$  is  $CH_3$  and  $R_3$  is H.

In a first Office action on the merits dated November 30, 1978, the examiner rejected all of the claims on numerous grounds, none of which are relevant to this decision. The patent applicants never responded to this action because on January 16, 1979, the examiner suggested a claim for interference. The patent applicants filed a timely response and copied the claim as suggested by the examiner and presented it as new claim 12. On May 1, 1979, the examiner suggested still another claim for the purpose of interference. Again, the patent applicants filed a timely response copying the suggested claim. This claim was presented as new claim 13. Two interferences were declared. The first interference was declared on September 25, 1979 with claim 13 as the count. The second interference was declared on November 5, 1979 with claim 12 as the count.

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On July 21, 1980, the patent applicants filed a continuation application of their original patent application. The only claim in the continuation application was the species elected in the original patent application, namely, a compound having the following formula



wherein  $R_2$  is  $CH_3$  and  $R_3$  is H. The continuation application was examined by another examiner in the same examining group and allowed with the single claim. The continuation application issued on July 14, 1981 as Patent No. 4,278,793. On February 13, 1981, the second interference was dissolved as to the patent applicants. On April 28, 1981, the patent applicants filed an amendment copying claims from a patent to Katner, Patent No. 4,200,745, which had issued on April 29, 1980. The amendment was filed for the purpose of provoking an interference with the Katner patent.<sup>3</sup> On January 21, 1982, the examiner held that no interference would be declared because the copied claims were not patentable to the patent

<sup>3</sup>The Katner patent was not involved in either of the two previously declared interferences.

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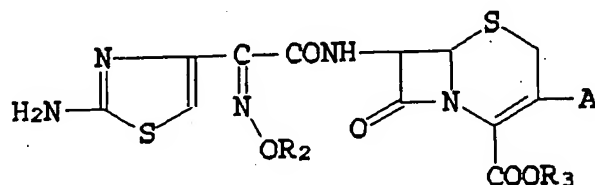
applicants since the claim did not comply with the written description requirement of 35 U.S.C. § 112.

On February 12, 1982, the first interference was dissolved as to the patent applicants. On May 24, 1982, the patent applicants filed an amendment copying still another claim from the Katner patent for the purpose of provoking an interference. On July 30, 1982, the examiner resumed ex parte examination and issued a written restriction requirement requiring the patent applicants to elect between an undefined group of process claims and an undefined group of composition claims and to further elect a single disclosed and supported species to be examined on the merits. The examiner did not require that the patent applicants adhere to the original election of species made in the Office action dated November 30, 1978. Applicants elected the composition claims and a species different from the originally elected species.

In December 1984, the examiner held an oral interview with counsel for the patent applicants. At that interview, Patent No. 4,278,793 was discussed. Because the parties were of the opinion that the pending claims generically covered the single claim in Patent No. 4,278,793, it was agreed that a terminal disclaimer should be filed. Accordingly, a proper terminal disclaimer was filed on January 17, 1985 disclaiming the terminal portion of any patent granted on the application which would extend beyond July 14, 1998, the expiration date of Patent No. 4,278,793.

Prosecution continued in the application until January 21, 1987 when an interference was declared between the application and the Katner patent. On July 7, 1987, a decision favorable to applicants in the Katner interference was made by the Board of Patent Appeals and Interferences. The following generic claim was present in the application when it was returned to the examiner:

42. A cephem compound of the formula



wherein

R<sub>2</sub> is C<sub>1</sub>-C<sub>4</sub>-alkyl or C<sub>1</sub>-C<sub>4</sub>-alkyl substituted by carboxyl, and the group -OR<sub>2</sub> is in the syn-position;

R<sub>3</sub> is hydrogen, a physiologically acceptable ester group, or a physiologically acceptable cation; and

A is -CH<sub>2</sub>Y, wherein

Y is pyridinium bound to -CH<sub>2</sub>- by the nitrogen atom thereof, or wherein

Y is -SR<sub>5</sub>, wherein

R<sub>5</sub> is tetrazolopyridazinyl, purinyl, triazinyl, or triazinyl which is partially or completely hydrogenated, or wherein

R<sub>5</sub> is a 5- or 6-membered heterocycle which is thiazolyl, oxadiazolyl, triazolyl, tetrazolyl, pyrimidinyl, triazinyl, or thiadiazolyl, or is such a heterocycle which is partially or completely hydrogenated, said heterocycle or partially or completely hydrogenated heterocycle being substituted by carboxyloweralkyl, trifluoromethyl, aminoloweralkyl, acetylaminoloweralkyl, loweralkyloxycarbonyl-loweralkylcarbox-

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amido, hydroxy, oxo, oxido, carboxy, furyl, thienyl, thiazolyl, or pyridyl, and also by lower alkyl if said heterocycle or partially or completely hydrogenated heterocycle is triazinyl or partially or completely hydrogenated triazinyl.

There is no dispute that this claim was generic to the species claim in Patent No. 4,278,793 and that the terminal disclaimer was needed to obviate any obviousness-type double patenting rejection. When ex parte prosecution was resumed on September 9, 1987, the examiner made a written restriction requirement and grouped the inventions as follows:

Group A. In claim 42 compounds wherein the variable "A" is a "pyridinium" system.

Group B. In claim 42 compounds when the variable R<sub>5</sub> may be a "five membered" hetero system.

Group C. In claim 42 compounds wherein the variable R<sub>5</sub> may be a "six membered hetero system". As the art has developed each group has become patentably distinct.

The examiner held that the inventions as grouped above were separate and patentably distinct inventions and required the patent applicants to elect one invention to be examined.

The patent applicants filed a timely response electing Group C, without traverse. Applicants canceled claim 42 and presented new claims limited to Group C compounds. Other amendments were made by adding new claims and canceling or amending existing

claims such that three additional sets of new claims were presented: the first set was directed only to Group A compounds, the second limited only to Group B compounds, and a third set was drawn to a fourth invention which the examiner subsequently held to be new Group D.<sup>4</sup> On January 28, 1988, the examiner closed prosecution and by examiner's amendment canceled all claims to the non-elected inventions. The application was passed to issue and issued as Patent No. 4,758,556 on July 19, 1988. On the record before us, the patent applicants did not make any effort to seek to withdraw or remove the terminal disclaimer before the patent issued.

On April 12, 1990, the patentees filed a request for certificate of correction under 37 CFR § 1.323 to delete the terminal disclaimer notice in the patent arguing that the terminal disclaimer had become unnecessary and that reference to it should be deleted from the patent. On June 13, 1990, the request was denied on the ground that "the request would require reexamination of the application" because "the issue of whether any of claims 1-17 of Patent No. 4,758,556 would be subject to rejection based upon

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<sup>4</sup>In their response to the restriction requirement (Paper No. 69 in Patent No. 4,758,556), applicants recommended modifying the restriction to include a further "Group D" because it was not clear whether one of the claims subject to restriction was a substituted 6-membered heterocyclic ring or a compound which was not defined by any of Groups A, B or C. The examiner in his amendment (Paper No. 71 in Patent No. 4,758,556) agreed with the suggestion and modified his restriction requirement to include a new Group D and concluded that "[e]ach group A, B, C and D will support separate patents."

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the ground of obvious type double patenting over Patent No. 4,278,793, is raised by the request." The Office of the Deputy Assistant Commissioner for Patents denied the patentees' request for reconsideration on the ground that

While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "unhappy circumstance" by Judge Rich in *In re Jentoft*<sup>5</sup>, [392 F.2d 633, 639,] 157 USPQ 363, 368 (footnote 6) (1988) [sic: CCPA 1968], there is no statutory prohibition against nullifying or otherwise cancelling the effectiveness of a terminal disclaimer. Accordingly, the Office has granted petitions under 37 CFR 1.182 to withdraw or nullify a terminal disclaimer only when the public has not had an opportunity to rely on the terminal disclaimer.

In this instance, the terminal disclaimer took effect when the patent issued, and the public has had an opportunity to rely on the terminal disclaimer. Accordingly, the mistake in

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<sup>5</sup> In its opinion, the *Jentoft* court was querying how the Office normally treats double patenting issues, which the court determined was a two step process, namely, determining first whether there would be double patenting without the terminal disclaimer and then whether the disclaimer obviates the double patenting. To this, the court made the following remark in footnote 6:

One might almost take the filing of a terminal disclaimer in response to a "double patenting" rejection to be a tacit admission that, without it, there would be double patenting except for the observation we have made in these cases that applicants frequently like to argue both issues. It is an unhappy circumstance to file a terminal disclaimer in a case where, on appeal, it turns out to have been unnecessary.

While many inferences could be drawn from this statement, it is dicta which is not relevant to this case herein since we agree with appellant that the court did not hold that the "unhappy circumstance" cannot be remedied by reissue.

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filing the terminal disclaimer is not "of minor character" as required by 37 CFR 1.323.<sup>6</sup>

On July, 11, 1990, this reissue application was filed seeking to withdraw the terminal disclaimer. In its reissue declaration, appellant states that

Although the patent was reviewed upon its issuance, the fact that the Terminal Disclaimer is unnecessary and inappropriate in this case was only discovered this year during an in depth review of the complete prosecution of the application.

The examiner rejected all of the reissue claims under 35 U.S.C. § 251. The examiner based his decision on the policy set forth in section 1490 of the *Manual of Patent Examining Procedure* (hereinafter MPEP) which states, in part, that "[a]lthough the remedial nature of reissue (35 U.S.C. 251) is well recognized, reissue is not available to correct all errors ... [and that] reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent." The examiner did not reject any of the claims on the ground of obviousness-type double patenting over Patent No. 4,278,793. The claims stand rejected on the ground that the reissue statute does not authorize the withdrawal of a terminal disclaimer once a patent

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<sup>6</sup>37 CFR § 1.323 provides, in part, that "Whenever a mistake of a clerical or typographical nature or of minor character which was not the fault of the Office, appears in a patent and a showing is made that such mistake occurred in good faith, the Commissioner may, upon payment of the fee set forth in §1.20(a), issue a certificate, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination."

issues because the reissue statute prohibits extension of the term of the issued patent and because public policy and the recapture rule prohibit the withdrawal of a terminal disclaimer.

#### Opinion

There are two facts in this case that are not in dispute. First, the terminal disclaimer was proper at the time it was filed because both the examiner and the patent applicants agree that the generic claims then pending in the patent sought to be reissued covered the single claim in Patent No. 4,278,793. Second, the terminal disclaimer later became unnecessary because of the examiner's restriction requirement and the examiner's amendment cancelling all subject matter which would have been subject to an obviousness-type double patenting rejection over the single claim in Patent No. 4,278,793.<sup>7</sup>

The purpose for which the patent applicants filed and recorded the terminal disclaimer appears to be the need to obviate a potential obviousness-type double patenting rejection. At the time the terminal disclaimer was filed, there were generic claims which the patent applicants believed were patentably indistinct from the single claim in Patent No. 4,278,793. *In re Kaye*, 332

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<sup>7</sup>The examiner agrees with appellant that the terminal disclaimer is unnecessary. On page 2 of the answer, the examiner states, "There is no controversy that the terminal disclaimer became unnecessary in view of the requirement for restriction ...."



F.2d 816, 819, 141 USPQ 829, 831 (CCPA 1964); *In re Robeson*, 331 F.2d 610, 615, 141 USPQ 485, 489 (CCPA 1964). However, approximately 2½ years after the terminal disclaimer was filed, the examiner determined that the generic claims were directed to or covered four separate and patentably distinct inventions. In response to the restriction requirement, the patent applicants elected an invention which was patentably distinct from the single claim in Patent No. 4,278,793. None of the claims of the issued patent would have been subject to an obviousness-type double patenting rejection because the claims in the patent are limited to a compound having a 6-membered heterocycle whereas the claim in Patent No. 4,278,793 is a compound having 5-membered heterocycle (this compound being within non-elected Group B). Unequivocally, the restriction requirement and the examiner's amendment cancelling all claims to the non-elected inventions obviated the purpose for which the terminal disclaimer had been originally filed.<sup>8</sup>

Our reviewing court has consistently held that the purpose of the reissue statute, 35 U.S.C. § 251, is to allow patentees to correct errors due to accident, inadvertence or

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<sup>8</sup>Appellant states that the PTO played a part in the mistake regarding the terminal disclaimer in that the examiner did not *sua sponte* take action to withdraw the terminal disclaimer after making the restriction requirement. See pages 10, 11, and 19 of the supplemental brief; pages 33-34 of the reply brief; and pages 8-9 of the surreply brief. Assuming that it could be established that the examiner made a mistake, a mistake by the examiner is not an "error" under 35 U.S.C. § 251. *Ex parte Zihlerl*, 116 USPQ 162 (Bd. App. 1958).

mistake without any deceptive intention. *In re Bennett*, 766 F.2d 524, 528, 226 USPQ 413, 416 (Fed. Cir. 1985) (in banc); *Ball Corp. v. United States*, 729 F.2d 1429, 1439 n.28, 221 USPQ 289, 296 n.28 (Fed. Cir. 1984); *In re Hay*, 534 F.2d 917, 919, 189 USPQ 790, 791 (CCPA 1976); *In re Byers*, 230 F.2d 451, 109 USPQ 53 (CCPA 1956). The statute is remedial and should be liberally construed. *Brenner v. The State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968). As stated by the court in *In re Willingham*, 282 F.2d 353, 354-55, 127 USPQ 211, 214 (CCPA 1960):

The reissue provisions of the Patent Act of 1952, like the reissue provisions of the earlier patent statutes, are remedial in nature. They are based on the fundamental principles of equity and fairness and should be so applied to the facts of any given case that justice will be done both to the patentee and to the public.

In order for appellant to be entitled to reissue, appellant must establish an error without deceptive intention.<sup>9</sup> For reasons hereinafter set forth in a new ground of rejection pursuant to the provisions of 37 CFR § 1.196(b), we find that appellant's reissue declaration is defective under 35 U.S.C. § 251 in that,

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<sup>9</sup>In his answer, the examiner believed that the question to be decided in this case was whether the reissue statute, 35 U.S.C. § 251, authorizes the withdrawal of a terminal disclaimer, submitted voluntarily, even though the terminal disclaimer has become unnecessary in view of further action taken in the case. As we see it, the question is not whether the Commissioner has authority under the statute to withdraw the terminal disclaimer, but whether the original patent is defective through error without deceptive intention. See *In re Weiler*, 790 F.2d 1576, 229 USPQ 673 (Fed. Cir. 1986); *In re Orita*, 550 F.2d 1277, 193 USPQ 145 (CCPA 1977).

*inter alia*, it fails to set forth an error. However, appellant has stated an error in the appeal brief and the supplemental brief as being the failure to petition under 37 CFR § 1.182 or otherwise to request during the prosecution of the Patent No. 4,758,556 to have the terminal disclaimer canceled, withdrawn or nullified.<sup>10</sup> At the time Patent No. 4,758,556 was granted, the MPEP did not provide any guidance for withdrawing an unnecessary terminal disclaimer.<sup>11</sup> However, in 1987 and 1988, the provisions of 37 CFR § 1.182 were

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<sup>10</sup>Appellant states in its appeal brief and supplemental brief that "the error during the prosecution of [the patent sought to be reissued] was in not petitioning under 37 C.F.R. §1.182 or otherwise requesting to cancel, withdraw or nullify the terminal disclaimer after the September 10, 1987 Office Action or the January 22, 1988 Examiner's Amendment when the Examiner had mooted the need for the terminal disclaimer." See the paragraph bridging pages 7 and 8 of the appeal brief and see also the top of page 9 of the supplemental brief.

<sup>11</sup>Section 1490 of the MPEP, 6th Ed., January 1995 provides, in pertinent part, that

While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "unhappy circumstance" in *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968), there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. Since the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition or by refiling the application.

Under appropriate circumstances, consistent with the orderly administration of the examination process, the nullification of a recorded terminal disclaimer may be addressed by filing a petition under 37 CFR 1.182 requesting withdrawal of the recorded terminal disclaimer. Petitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of the terminal disclaimer have not been favorably considered. The filing of a continuing application, while abandoning the application in which the terminal disclaimer has been filed, will typically nullify the effect of a terminal disclaimer.

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available to petition for matters not specifically provided for in the rules and regulations. Among the known types of petitions under 37 CFR § 1.182 are petitions to expunge papers from patent application files.<sup>12</sup>

Considering all of the facts of record in this case and the prosecution history of the patent sought to be reissued, we conclude that the record establishes that the terminal disclaimer became unnecessary as a result of the examiner's action and that an error within the meaning of 35 U.S.C. § 251 could have occurred by the patent applicants' or their appointed representative's failure to petition or to take some other action<sup>13</sup> to nullify or expunge the terminal disclaimer from the application file before Patent No. 4,758,556 was granted.

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<sup>12</sup>37 CFR § 1.182 states, in part, that "[a]ll cases not specifically provided for in the regulations of this part [Part 1, rules of practice in patent cases] will be decided in accordance with the merits of each case by or under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing." See also Sections 724.05 and 1002.02(a) of the MPEP, 5th Ed., Rev.3, May 1986, which provided for expunging papers from patent application or patent files by petition under 37 CFR § 1.182. All registered practitioners are expected to know the rules and how to apply them.

<sup>13</sup>At the time of the allowance of the claims in Patent No. 4,758,556, the patent applicants could have filed a continuation application without the terminal disclaimer and abandoned the allowed application. Section 1490 of the MPEP, 5th Ed., 1987 states that

A terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application identified in the disclaimer. For example, a terminal disclaimer filed in a parent application has no effect on a continuing application claiming filing date benefits of the parent application under 35 U.S.C. 120.

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The examiner's position for rejecting the claims in this application for reissue is based on Office policy set forth in section 1490 of the MPEP which provides, in pertinent part, that

Although the remedial nature of reissue (35 U.S.C. 251) is well recognized, reissue is not available to correct all errors. It has been the Office position that reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent. First, the reissue patent statute only authorizes the Commissioner to reissue a patent "for the unexpired part of the term of the original patent". Since the granting of a reissue patent without the effect of a recorded terminal disclaimer would result in extending the term of the original patent, reissue under these circumstances would be contrary to the statute. Second, the principle against recapturing something that has been intentionally dedicated to the public dates back to *Leggett v. Avery* [citation omitted]. The attempt to restore that portion of the patent term that was dedicated to the public to secure the grant of the original patent would be contrary to this recapture principle. Finally, applicants have the opportunity to challenge the need for a terminal disclaimer during the prosecution of the application that issues as a patent. "Reissue is not a substitute for Patent Office appeal procedures." *Ball Corp. v. United States* [citation omitted]. Where applicants did not challenge the propriety of the examiner's obvious-type double patenting rejection, but filed a terminal disclaimer to avoid the rejection, the filing of the terminal disclaimer did not constitute error within the meaning of 35 U.S.C. 251. *Ex parte Anthony* [citation omitted].

To the extent that this section of the MPEP is interpreted to mean that reissue is never available for whatever reason to withdraw or

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otherwise nullify the effect of a terminal disclaimer recorded in an issued patent, we find this interpretation to be inconsistent with the provisions of 35 U.S.C. § 251. The reissue statute, in pertinent part, provides that

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, ... by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

The statute does not specifically exclude certain errors as not being correctable by reissue. If a reissue oath or declaration presents facts and circumstances to establish that the filing of a terminal disclaimer or the failure to take appropriate action to remove a terminal disclaimer was an error without any deceptive intention within the meaning of the 35 U.S.C. § 251, the reissue statute clearly mandates that the Commissioner shall reissue the original patent for the unexpired term of the original patent if the original patent is surrendered and payment of the appropriate fee is made.

MPEP section 1490 sets forth three reasons why "reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent." The first

reason is that the "granting of a reissue patent without the effect of a recorded terminal disclaimer would result in extending the term of the original patent, [and granting] reissue under these circumstances would be contrary to the statute." We are in full agreement with appellant's statement that

A terminal disclaimer does not alter "the term of the original patent". Rather, a terminal disclaimer is only a "disclaim[er] [of a] terminal part of the term, of the patent granted or to be granted."<sup>14</sup>

At the time the patent sought to be reissued was granted, 35 U.S.C. § 154 stated that "[E]very patent shall contain ... a grant to the patentee, his heirs or assigns, for the term of seventeen years, ... of the right to exclude others from making, using, or selling the invention ...." (Emphasis ours.) The statute did not make any exception for shortening the term of a patent with regard to terminal disclaimers 35 U.S.C. § 253.<sup>15</sup> We agree with appellant

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<sup>14</sup>See page 15 of the reply brief.

<sup>15</sup>Terminal disclaimers are provided for in the second paragraph of 35 U.S.C. § 253. The statute provides that

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent and Trademark Office, and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

(continued...)

that the phrase "unexpired term of the original patent" in section 251 refers to the remainder of the 17 year term granted under section 154. As pointed out by appellant, the patent statute is a unified statute and all provisions must be read in harmony. In *re Bennett*, 766 F.2d at 528, 226 USPQ at 416. Thus, the patent sought to be reissued was granted for a term of seventeen years with the terminal portion being disclaimed beginning on the date the seventeen year term of Patent No. 4,278,793 lapses. For the aforementioned reasons, we do not see that a reissue in this case would extend the term of the original patent sought to be reissued under 35 U.S.C. § 251.

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<sup>15</sup>(...continued)

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

35 U.S.C. § 154 is directed to the contents and term of a patent. The statute was amended on December 8, 1994, effective June 8, 1995 to extend the term of a patent to 20 years. The following statute was in effect at the time Patent No. 4,758,556 was granted:

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, subject to the payment of fees as provided for in this title, of the right to exclude others from making, using, or selling the invention throughout the United States and, if the invention is a process, of the right to exclude others from using or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.



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This case presents an unique set of facts and circumstances wherein the claims which were secured by the filing of the terminal disclaimer were cancelled before the patent was granted. Since none of the claims in the patent grant were secured by the filing of the terminal disclaimer, the owner of the patent should be entitled to enforce the claims for the full term of the patent. *Cf. Autogiro Co. of America v. United States*, 384 F.2d 391, 410, 155 USPQ 697, 713 (Ct. Cl. 1967).

The second reason for denying reissue set forth in MPEP section 1490 is that any "attempt to restore that portion of the patent term that was dedicated to the public to secure the grant of the original patent would be contrary to this recapture principle." The facts in this case do not involve recapture. The reissue applicant is not seeking to recapture the claims cancelled as a result of the restriction requirement or to add new claims which would be generic to the claimed subject matter in Patent No. 4,200,745 and subject to an obviousness-type double patenting rejection. This application for reissue was filed without any changes to the original patent claims. Moreover, for reasons already stated, this case does not involve recapture or restoration of the patent term. Accordingly, recapture is not an issue under the facts presented by this case.

The third reason for denying reissue set forth in MPEP section 1490 is that "[w]here applicants did not challenge the

propriety of the examiner's obvious-type double patenting rejection, but filed a terminal disclaimer to avoid the rejection, the filing of the terminal disclaimer did not constitute error within the meaning of 35 U.S.C. 251." A decision of the Board in *Ex parte Anthony*, 230 USPQ 467 (Bd. App. 1982), *aff'd. memo.*, 770 F.2d 182 (Fed. Cir. 1985) (non-precedential) is cited as controlling.

The facts in *Ex parte Anthony* are clearly distinguishable over this case. In *Anthony*, an application for reissue of a patent was filed to remove a terminal disclaimer which had been filed during the prosecution of the patent to obviate an obviousness-type double patenting rejection of all of the patent claims. During the prosecution of the patent, the patent applicant never pointed out any error in the examiner's double patenting rejection. At pages 469-70 of the decision, the PTO Board of Appeals held that

The deliberate filing of the terminal disclaimer to overcome the [obviousness-type double patenting] rejection cannot now be considered as such an error as contemplated by 35 USC 251 to permit the reissuance of the patent in order to cancel or withdraw the terminal disclaimer.

Under the circumstances here present, the reissue is not to correct [a] mere formal matter. The terminal disclaimer which is now attempted to be nullified was of substantive significance which had a direct bearing in the issuance of the original patent. Nor is the reissue being sought to correct a defect in the specification or drawing or because the patentee is claiming more or less than he had a right to claim in the patent. The purpose of the reissue here, in effect, is to nullify

a deliberate action taken in order to remove an outstanding rejection, which rejection, as a consequence of the action taken, was withdrawn. (Emphasis ours.)

In the record before us, the examiner has stated that the claims in the patent sought to be reissued would not have been subject to an obviousness-type double patenting rejection covered by the terminal disclaimer filed in 1985.<sup>16</sup> No such rejection has been made by the examiner in this reissue application. Considering all of the facts of record, although in the original patent there was a need to challenge the need for a terminal disclaimer after the examiner cancelled claims to the non-elected inventions, there was no apparent obviousness-type double patenting rejection to challenge. Therefore, contrary to the holding in *Ex parte Anthony*, the terminal disclaimer did not have a direct bearing on the patent claims ultimately appearing in Patent No. 4,758,558.

MPEP section 1490 also relies on *Ball Corp. v. United States, supra*, for the proposition that reissue is not a substitute for failure to use Patent and Trademark Office procedures during the prosecution of the original patent to challenge the need for a terminal disclaimer. Whether or not the patent applicants had opportunity to challenge the need for a terminal disclaimer has yet to be determined since the reissue declaration, for reasons set

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<sup>16</sup>See footnote 7.

forth in the new ground of rejection, *infra*, fails to set forth sufficient facts upon which to make a determination that an error due to accident, inadvertence or mistake without deceptive intention was made that deprived the patent applicants of the opportunity to challenge the necessity of a terminal disclaimer during the prosecution of the original patent. However, inadvertent error for failure to take advantage of an opportunity of or to follow Office procedure before a patent issues is not *per se* a ground for denying a reissue. See *A.F. Stoddard & Co., Ltd. v. Dann*, 564 F.2d 556, 195 USPQ 97 (D.C. Cir. 1977) (reissue was granted for failure to name the correct inventor, the patent was amended to change the originally named sole inventor to another sole inventor); *Sampson v. Commissioner of Patents and Trademarks*, 195 USPQ 136 (D.D.C. 1976) (reissue was granted for failure to include the dates, serial numbers, and relationships of prior patent applications in the original patent specification as required by 35 U.S.C. § 120 to obtain the benefit of an earlier filing date); *Brenner v. The State of Israel*, *supra* (reissue was granted for failure to file a certified copy of the original foreign patent application as required by 35 U.S.C. § 119 for a claim for priority). It is evident from these cases that the term error under section 251 is to be construed broadly. See also *In re Wadlinger*, 496 F.2d 1200, 1207-08, 181 USPQ 826, 832 (CCPA 1974);

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*In re Richman*, 409 F.2d 269, 273-75, 161 USPQ 359, 362-63 (CCPA 1969).

In view of the facts presented herein and for all of the foregoing reasons, we conclude that reissue of the patent should not be barred if the reissue applicant satisfies the requirements of 35 U.S.C. § 251 and the regulations pertaining thereto. Accordingly, we will not sustain the examiner's rejection claims 1-17 under 35 U.S.C. § 251. Nevertheless, we enter the following new ground of rejection of the claims under 35 U.S.C. § 251 for other reasons.

#### New Ground of Rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 1-17 are rejected under 35 U.S.C. § 251 on the ground that the reissue declaration does not set forth an error without any deceptive intention which would warrant reissue of Patent No. 4,758,556.

Paragraph 8 of appellant's reissue declaration states that Patent No. 4,758,556 is partly inoperative by reason of the patent applicants claiming less than they had a right to claim in the patent. In particular, paragraph 8 of the declaration states that

8. U.S. Patent No. 4,758,556 is partly inoperative because of error without any deceptive intention on the part of the

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applicants as set forth in detail below [presumably paragraphs 9 to 16]. U.S. Patent No. 4,758,556 is partly inoperative by reason of the patentees claiming less than they had a right to claim in the patent by reason of a Terminal Disclaimer which is unnecessary and inappropriate for this patent. The reasons that the Terminal Disclaimer is unnecessary and inappropriate are particularly specified below [presumably paragraphs 9 to 16]. That Terminal Disclaimer disclaimed the term of U.S. Patent No. 4,758,556 beyond the expiration date of U.S. Patent No. 4,278,793. The errors relied upon, and how they arose or occurred, are particularly specified below [presumably paragraphs 9 to 16].

Paragraphs 9 to 14 of the declaration summarize the facts leading up to the mailing of the examiner's amendment in Patent No. 4,758,556. These facts establish that applicants filed a proper terminal disclaimer to obviate a potential obviousness type double patenting rejection of the broad generic claims over the single species claim in Patent No. 4,278,793, that the generic claims were subjected to a restriction requirement, that applicants elected without traverse the 6-membered heterocycle, and that the examiner by amendment canceled claims directed to the non-elected invention. Paragraphs 15 and 16 then recite that

15. Since the allowed claims were directed to the 6-membered heterocycle containing compounds, there was no need for a Terminal Disclaimer over the '793 patent which contained a claim covering a patentably distinct 5-membered heterocycle containing compound. Accordingly, U.S. Patent No. 4,758,556 should be reissued to withdraw the Terminal Disclaimer as it pertains to the patentably distinct claims.

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16. Applicants verily believe the original Letters Patent No. 4,758,556 to be partly inoperative without any deceptive intention on the part of applicants.

Paragraphs 9 to 16 do not establish an error upon which a reissue can be based. The fact that the terminal disclaimer was unnecessary is not an error because the filing of the terminal disclaimer, the requirement for restriction, the election made by applicants and the examiner's amendment were all appropriate at the time the actions were taken.

In the appeal brief and supplemental brief, appellant states that "the error ... was in not petitioning under 37 C.F.R. §1.182 or otherwise requesting to cancel, withdraw or nullify the terminal disclaimer after the September 10, 1987 Office Action or the January 22, 1988 Examiner's Amendment when the Examiner had mooted the need for the terminal disclaimer."<sup>17</sup> This error is not set forth in the reissue declaration. If this is the error, then the reissue declaration must state how the error arose or occurred to establish that the error was due to accident, inadvertence or mistake and occurred without any deceptive intention.

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<sup>17</sup>See the paragraph bridging pages 7 and 8 of the appeal brief. See also the top of page 9 of the supplemental brief.

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In paragraph 17 of the reissue declaration, appellant states that

Although the patent was reviewed upon its issuance, the fact that the Terminal Disclaimer is unnecessary and inappropriate in this case was only discovered this year during an in depth review of the complete prosecution of the application.

This statement also does not establish an error. The fact that the terminal disclaimer was discovered as being "unnecessary and inappropriate" after the patent issued is not the error, but the result of a possible error. Appellant states that "the patent was reviewed upon its issuance." It is not clear whether the patent was reviewed upon issuance by the examiner or after the patent was granted. This statement does not point out why the terminal disclaimer was not discovered as being unnecessary before the issuance of the patent. Of particular importance is why no effort was made by the patent applicants or their appointed legal representatives to have the disclaimer expunged or withdrawn prior to the granting of the patent. Appellant's statement that "the fact that the Terminal Disclaimer is unnecessary and inappropriate in this case was only discovered this year during an in depth review of the complete prosecution of the application" falls short of showing when and by whom it was discovered that the terminal disclaimer was unnecessary. Also, the term "this year" is



ambiguous and does not establish with certainty a date or the specific year when the discovery was made.

In responding to this rejection, appellant must set forth all relevant facts and circumstances surrounding how, when and why the terminal disclaimer was discovered to have been unnecessary and who discovered the error. The response must also set forth all of the facts and circumstances surrounding the review of the patent application between the time the examiner indicated allowability of the application and the granting of the patent. The response must identify when and who reviewed the application file, what was reviewed, the results of the review with regard to the terminal disclaimer, and if the terminal disclaimer was noted, an explanation as to why no effort was made by applicants or their legal counsel to have the terminal disclaimer removed or expunged before Patent No. 4,758,556 was granted. All of this information will be necessary for the examiner to make a proper determination of whether there was an error without deceptive intention within the meaning of the reissue statute.

The reissue declaration is also deficient in that it does not comply with the requirements of 37 CFR § 1.172. The reissue declaration is signed by an officer of the assignee of the patent. The assignee declarant states that the patent sought to be reissued is partly inoperative by reason of the patent applicants claiming less than they had a right to claim in the patent. Although the

horizontal scope of the original patent claims has not changed, this is interpreted to mean that appellant is seeking to enlarge the vertical scope of the claims or the period of enforceability of the original patent.<sup>18</sup> This reissue application was filed less than two years after the grant of the original patent. The reissue statute permits the granting of reissues to broaden the scope of claims, whether vertical scope or horizontal scope, if an application for reissue is filed within two years after the date the original patent was granted. When the scope is enlarged, 37 CFR § 1.172 requires that the reissue oath must be signed and sworn to or a declaration made by the inventors, and not the assignee (except as otherwise provided for in 37 CFR §§ 1.42, 1.43 and 1.47, none of which appear to be applicable here). Accordingly, any supplemental reissue oath or declaration filed in this application for reissue must be signed and sworn to by the inventors and must

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<sup>18</sup>In the paragraph bridging pages 12 and 13 of the appeal brief, appellant states that "[t]he present circumstances are analogous to the situation where the claims as granted are narrower than what applicants were entitled to claim." The Board in *Ex parte Anthony*, 230 USPQ at 470, discussed enlarging the scope of claims in terms of the vertical scope and stated that

"We are also of the view that the reissue application is not here proper since, in effect, the granting of the reissue would enlarge the scope of the claims of the original patent. The claims would be able to be sued upon for a longer period than would the claims of the original patent. Therefore, the vertical scope, as opposed to the horizontal scope (where the subject matter is enlarged), would be enlarged. Since this application was filed more than two years from the grant of the original patent, the reissue is barred by section 251."

also be accompanied by the written assent of the assignee pursuant to the rule.

### Conclusion

For the foregoing reasons, we will not sustain the examiner's rejection of claims 1-17 under 35 U.S.C. § 251 based on the ground that the reissue statute does not authorize the withdrawal of a terminal disclaimer. We enter a new ground of rejection of claims 1-17 under 35 U.S.C. § 251 based on a defective reissue oath.

We must emphasize that no inferences should be drawn from this decision beyond the facts presented herein. Our decision in this case is based solely on the facts of record. In addition, we must emphasize that we have made no determination in this opinion as to whether appellant can effectively withdraw a terminal disclaimer by merely filing this reissue application and requesting through its reissue declaration that the terminal disclaimer be withdrawn.<sup>19</sup> Whether or not the terminal disclaimer has been effectively withdrawn is a procedural matter to be decided by the examiner.<sup>20</sup>

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<sup>19</sup>Section 1490 of the MPEP, 6th Ed., January 1995, sets forth the procedures for withdrawing a recorded terminal disclaimer.

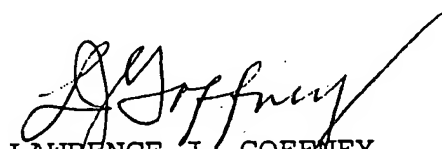
<sup>20</sup>The provisions under 37 CFR § 1.182 would appear to be available for filing in the patented file a petition to expunge the terminal disclaimer.

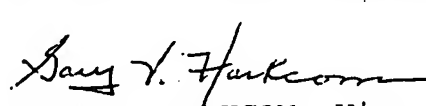
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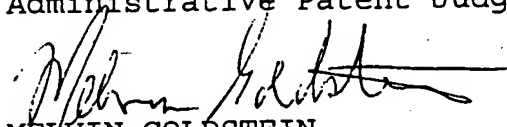
### Request for Reconsideration

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision. 37 CFR § 1.197. Should appellant elect to have further prosecution before the examiner in response to the new rejection under 37 CFR § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED - 37 CFR § 1.196(b)


  
LAWRENCE J. GOFFNEY,  
Acting Deputy Assistant  
Secretary of Commerce and  
Acting Deputy Commissioner  
of Patents and Trademarks

  
GARY V. HARKCOM, Vice Chief  
Administrative Patent Judge

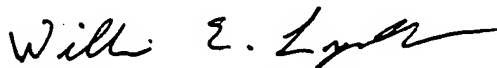
  
MELVIN GOLDSTEIN  
Administrative Patent Judge

BOARD OF  
PATENT APPEALS  
AND  
INTERFERENCES

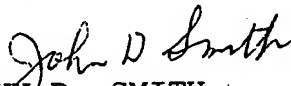
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IRWIN CHARLES COHEN  
Administrative Patent Judge



WILLIAM E. LYDDANE  
Administrative Patent Judge



JOHN D. SMITH  
Administrative Patent Judge



LAWRENCE J. STAAB  
Administrative Patent Judge



FRED E. MCKELVEY, Senior  
Administrative Patent Judge



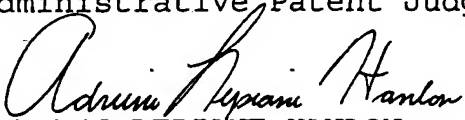
LEE E. BARRETT  
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MICHAEL R. FLEMING  
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CAMERON WEIFFENBACH  
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New York, NY 10036

13. Ex parte Anthony, 230 USPQ 467  
(PTO Bd. App. 1982)

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SHEPARD'S® 1982 Pat. App. LEXIS 25, \*; 230 U.S.P.Q. (BNA) 467

Ex parte William C. Anthony and Joseph J. Ursprung

Appeal No. 503-13 from Art Unit 122

Application filed December 10, 1979, Serial No. 101,536, for the Reissue of Patent No. 3,461,461, granted August 12, 1969, based on Application Serial No. 505,993, filed November 1, 1965.

6-Amino-4-(Substituted Amino)-1,2-Dihydro-1-Hydroxy-2-Iminopyrimidines.

Board of Patent Appeals and Interferences

1982 Pat. App. LEXIS 25; 230 U.S.P.Q. (BNA) 467

April 22, 1982, Heard  
April 28, 1982, Decided

**CORE TERMS:** patenting, double, examiner, disclaimer, terminal, patent, reissue, obviousness, subject matter, original patent, moiety, consisting, compound, outstanding, traversal, copending, overlap, heterocyclic, hydrogen, formula, alkyl, deliberately, erroneously, penultimate, deliberate, acquiesced, issuance, disputed, unsound, cycloalkyl

[\*1]

Before Serota and Milestone, Examiners-in-Chief, and Pellman, Acting Examiner-in-Chief.

**COUNSEL:**

Robert A. Armitage, John Kekich and Lawrence T. Welch for appellants.

Lawrence T. Welch and John Kekich  
Patent Law Department  
The Upjohn Company  
Kalamazoo, Michigan 49001

**OPINIONBY:** SEROTA

**OPINION:**

Serota, Examiner-in-Chief.

This appeal was taken from the Examiner's decision finally rejecting claims 1 through 7. Claims 5 and 6 were amended subsequent to the final rejection.

The claims on appeal are directed to certain chemical compounds, which compounds are asserted to be useful as anti-hypertensive agents.

Claim 1 is illustrative and reads as follows:



1. A compound selected from the group consisting of the free base form and acid addition salts of a compound of the formula:

[See Formula in Original]

wherein R[1] is a moiety selected from the group consisting of moieties of the formula

[See Formula in Original]

wherein R[3] and R[4] are selected from the group consisting of hydrogen, lower alkyl, lower alkenyl, lower aralkyl, and lower cycloalkyl, with the proviso that both R[3] and R[4] are not hydrogen, and the heterocyclic moieties, aziridinyl, azetidiny, pyrrolidinyl, piperidino, hexahydroazepinyl, [\*2] heptamethylenimino, octamethylenimino, morpholino, and 4-lower-alkylpiperazinyl, each of said heterocyclic moieties having attached as substituents on carbon atoms thereof zero to 3 lower alkyls, inclusive, a nitrogen atom of each of said heterocyclic moieties being the point of attachment of R[1] to the ring in said formula, and wherein R[2] is selected from the group consisting of hydrogen, lower alkyl, lower alkenyl, lower alkoxyalkyl, lower cycloalkyl, lower[.] aryl, lower aralkyl, lower alkaryl, lower alkaralkyl, lower alkoxyaralkyl, and lower haloaralkyl.

There are no outstanding rejections based upon prior art under 35 USC 102 and/or 103. The only outstanding rejection against the claims is under 35 USC 251. The principal issue raised by the rejection is whether or not the statute provides for the granting of a reissue patent for the sole purpose of, in effect, withdrawing or cancelling a terminal disclaimer filed during the prosecution before the Patent Examiner of the application which resulted in the granting of the patent for which the present application seeks reissue.

A review of the prosecution history of application Serial No. 505,993, the application which resulted [\*3] in the patent for which the application now before us seeks reissue, reveals that, in the first action on the merits of the application, Paper No. 3, the Examiner rejected the active claims under 35 USC 103 as obvious from Ursprung et al, Patent No. 3,270,014, in view of a number of other patents. In addition, all of the active claims were "rejected on the ground of double patenting over claims 1 and 6 of applicants' copending Serial No. 505,992" filed on November 1, 1965. This latter application issued as Patent No. 3,382,248. It is apparent from the Examiner's discussion of the rejection in the paragraph bridging pages 4 and 5 of Paper No. 3 that the Examiner intended the rejection to be on the judicially created doctrine of "obviousness type" of double patenting. It also appears that the Examiner, in addition to the '992 application, was also relying upon Ursprung Patent No. 3,270,015 to support his "double patenting" rejection.

The applicants in a paper filed October 20, 1967, Paper No. 5, responded to the Examiner's action of September 26, 1967. The response included an extensive traversal of the Examiner's rejections under 35 USC 103. With respect to the double patenting [\*4] rejection, the response calls the Examiner's attention to the Commissioner's Notice with regard to double patenting published at 834 OG 1615 (Jan. 31, 1967). The Commissioner's Notice is summarized by the applicants as permitting the issuance of two patents provided the "claims do not overlap, even though the subject matter to which the claims on one case are directed may be obvious in view of the subject matter claimed in the other case. In re Robeson, 1964 C.D. 561, 141 USPQ 485; In re Kaye, 1964 C.D. 630, 141 USPQ 829." (See page 6 of Paper No. 5.) In the penultimate paragraph of Paper No. 5, there is an assertion that the claims of the application do not overlap the claims of the '992 application. There is also a reference to an interview with the Examiner in charge of the '992 application at which "the potential double patenting problem . . . has been discussed." The applicants continued with the assertion that:

"Every effort is being made by the applicants to prosecute these applications simultaneously, thus striving for a common issue date. In the event a common issue date becomes impracticable at a later date, the filing of a terminal disclaimer in the application [\*5] last to issue will be considered."

As is evident from this summary of the applicants' first response to the double patenting rejection, there is no traversal of the rejection. The applicants merely indicate that they would try to have both applications issue simultaneously or failing that, they would file a terminal disclaimer, thereby complying with the Commissioner's Notice and the two cited cases.

In the next Office action, Paper No. 6, the examiner maintained his rejections under 35 USC 103 and also maintained his double patenting rejection. The rejections were made final. In their response, Paper No. 7, to the final rejection, the applicants again traversed the rejections under 35 USC 103. Their only comment

with regard to the double patenting rejection was as follows:

"Inasmuch as the copending application Serial No. 505,992 has been allowed, a terminal disclaimer is filed concurrently herewith to obviate a double patenting rejection." (Penultimate paragraph of Paper No. 7.)

A terminal disclaimer was indeed filed on March 21, 1968.

Thereafter, an appeal was taken to the Board of Appeals from the final rejection. In the Appeal Brief, the appellants, at page 11, state: [\*6]

"Inasmuch as there is no overlap between the present claims and those of the aforesaid copending application, a terminal disclaimer has been submitted under the authority of *In re Robeson* . . . and *In re Kaye* . . . so as to expedite prosecution and obviate the rejection. Inasmuch as the double patenting rejection is still maintained, review of the adequacy of submitted terminal disclaimer is requested."

In his Answer, the Examiner stated that the double patenting rejection was not an issue in the appeal since a terminal disclaimer had been filed. In effect, the Examiner did not maintain his double patenting rejection.

The Board of Appeals, in its decision on the appeal, did not sustain the Examiner's rejections under 35 USC 103. The Board did not comment on the double patenting rejection since it was no longer an issue in the appeal.

From our review of the prosecution history of the application which issued as the patent for which the present application seeks reissue, it appears that, although the rejections under 35 USC 103 were vigorously contested, the appellants did not on the written record enter any traversal of the Examiner's double patenting rejection. It [\*7] does not appear that the appellants disputed the Examiner's holding that the subject matter of the claims of that application were obvious from the claims of the '992 application, which application issued as Patent No. 3,382,248. The only action taken to overcome the double patenting rejection was the filing of a terminal disclaimer. No arguments were presented during the prosecution leading to the grant of the '461 patent pointing out why the claims of that patent would not have been obvious from the claims of the '248 patent. Nor was there any indication either in the terminal disclaimer itself or in the simultaneously filed amendment that the terminal disclaimer was being filed "provisionally," contingent on any finding by the Board of Appeals or higher authority with respect to the Examiner's rejections under 35 USC 103.

We will sustain the Examiner's rejection in the reissue application before us.

We do not agree with the appellants that the terminal disclaimer was filed by them because of an error. It is clear from the above summary of the prosecution history of the application which resulted in the patent now sought to be reissued that the terminal disclaimer was deliberately [\*8] filed in order to overcome an untraversed obviousness type of double patenting rejection. This procedure for overcoming a double patenting rejection is a judicially approved method. As pointed out above, the appellants never on the record disputed the propriety of the Examiner's holding that the claims of the 505,993 application would have been obvious from the claims of the appellants' '992 application. The appellants never during prosecution of the application presented any reasons why the claims of the '993 application would not have been obvious to the worker of ordinary skill in the art from the claims of the '992 application (now Patent No. 3,382,248). The appellants filed the terminal disclaimer in order to remove the rejection. This was their stated intent. The terminal disclaimer was filed and, as a consequence, the Examiner withdrew his rejection. If the appellants were of the view that the double patenting rejection was legally or factually unsound, they could have presented arguments to that end as they did with respect to the rejections under 35 USC 103 and, if necessary, sought review of the rejections via the appeal procedures. This was not done during the prosecution [\*9] of the '993 application. It therefore appears that the appellants acquiesced in the rejection and deliberately filed the terminal disclaimer. Therefore, there does not appear to be any proper basis for a finding that an error of such nature as is permitted to be corrected by reissue has been committed; cf. *Ex parte Lawrence*, 70 USPQ 326 (Bd. App. 1946); 588 OG 519, 1946 C.D. 1.

The failure to seek review during the prosecution of the '993 application of the Examiner's "obviousness type" of double patenting rejection, if in fact the appellants did not agree with that rejection, is not such an action (failure to act) as may be remedied via a reissue application. In our view, this is especially true here since there is no evidence on the record that the appellants ever intended to contest the Examiner's

obviousness type double patenting rejection. From the record, it would appear that the appellants acquiesced in the rejection. Under these circumstances, we do not believe the filing of a terminal disclaimer constitutes "error" within the meaning of section 251; cf. In re Mead, 581 F.2d 251, 198 USPQ 412 (CCPA 1978); and In re Orita, 550 F.2d 1277, 193 USPQ 145 (CCPA [\*10] 1977).

The appellants' arguments to the effect that the reversal by the Board of Appeals of the Examiner's rejections under 35 USC 103 establishes that the Examiner's obviousness type of double patenting rejection was also erroneous and that, therefore, the appellants were in some way induced by the Patent and Trademark Office to erroneously file the terminal disclaimer are unsound. There is no basis for us to now conclude or to speculate what the Board's decision would have been with respect to the obviousness type of double patenting rejection. The Board's departure point for determining the obviousness under 35 USC 103 was different from that of the double patenting rejection. With respect to the latter rejection, the jump-off point was the claims of the '992 application. This '992 application was not considered by the Board for determining whether the claimed subject matter would have been obvious. The Board only held that the combination of references relied upon in support of the section 103 rejection did not render the claimed subject matter obvious. We therefore do not agree that the terminal disclaimer was erroneously filed as a result of error by the Office in rejecting [\*11] the claims on the grounds of obviousness type of double patenting. As the record now stands, especially since the appellants never during the prosecution of the original patent pointed out any error in the Examiner's holding, the obviousness type of double patenting rejection must be presumed to have been correct. The deliberate filing of the terminal disclaimer to overcome the rejection cannot now be considered as such an error as contemplated by 35 USC 251 to permit the reissuance of the patent in order to cancel or withdraw the terminal disclaimer.

Under the circumstances here present, the reissue is not to correct mere formal matter. The terminal disclaimer which is now attempted to be nullified was of substantive significance which had a direct bearing in the issuance of the original patent. Nor is the reissue being sought to correct a defect in the specification or drawing or because the patentee is claiming more or less than he had a right to claim in the patent. The purpose of the reissue here, in effect, is to nullify a deliberate action taken in order to remove an outstanding rejection, which rejection, as a consequence of the action taken, was withdrawn.

Nor is the [\*12] reissue being sought to remove a possible reference that may have been a statutory bar as in the State of Israel v. Brenner, 155 USPQ 486 (D.D.C. 1967), aff'd., 158 USPQ 584 (D.C. Cir. 1968). Therefore, the State of Israel case is not apposite to the facts of this case.

We are also of the view that the reissue application is not here proper since, in effect, the granting of the reissue would enlarge the scope of the claims of the original patent. The claims would be able to be sued upon for a longer period than would the claims of the original patent. Therefore, the vertical scope, as opposed to the horizontal scope (where the subject matter is enlarged), would be enlarged. Since this application was filed more than two years from the grant of the original patent, the reissue is barred by section 251.

We also note that the appellants' oath does not set forth the circumstances surrounding the discovery of the error or why the long delay, over ten years, in seeking the reissue.

Accordingly, for the reasons given in the Examiner's Answers and those emphasized above, we will affirm the Examiner's decision.

AFFIRMED [\*13]

#### Legal Topics:

For related research and practice materials, see the following legal topics:  
Patent LawDouble PatentingTerminal DisclaimersPatent LawU.S. Patent & Trademark Office  
ProceedingsAppealsPatent LawU.S. Patent & Trademark Office ProceedingsExaminationsGeneral  
Overview

14. Altoona Publix Theatres v. American  
Tri-Ergon Corp., 294 U.S. 477, 24  
USPQ 308 (1935)

## U.S. Supreme Court

### ALTOONA PUBLIX THEATRES v. AMERICAN TRI-ERGON CORP., 294 U.S. 477 (1935)

294 U.S. 477

ALTOONA PUBLIX THEATRES, Inc.,  
v.  
AMERICAN TRI-ERGON CORPORATION et al. \*  
WILMER & VINCENT CORPORATION et al.  
v.  
AMERICAN TRI-ERGON CORPORATION et al.

Nos. 255, 256.

Argued Feb. 5, 1935.

Decided March 4, 1935.

[294 U.S. 477, 479] Messrs. Merrell E. Clark, of New York City, Thomas G. Haight, of Jersey City, N.J., and Charles Neave, of New York City, for petitioners.

Mr. Thomas D. Thacher, of New York City, for respondents.

Mr. Justice STONE delivered the opinion of the Court.

These cases come here on certiorari, 293 U.S. 528, 548, 629 S., 55 S.Ct. 139, 79 L.Ed. --, to review a decree of the Court of Appeals for the Third Circuit, 72 F.(2d) 53, which affirmed a decree of the District Court, 5 F. Supp. 32, holding valid and infringed the patent of Vogt and others, No. 1, 713,726, of May 21, 1929, applied for March 20, 1922, for a 'device for phonographs with linear phonogram carriers.' The two cases were tried together and have been brought here on a single record.

Petitioners, the defendants below, are operators of motion picture theaters whose sound reproduction machines are said to infringe certain claims of the patent in suit. The Radio Corporation of America is defending both cases on behalf of its subsidiary, R.C.A. Photophone, Inc., which supplied the petitioners' machines. Respondents, the plaintiffs below, are a patent holding company and a licensee.

Of the nineteen claims of the patent, seven are in issue. Five of them, numbered 5, 7, 17, 18, and 19, relate to a device for securing uniformity of speed in machines used for recording and reproducing talking motion pictures, and are referred to as the 'flywheel claims.' They may conveniently be considered separately from claims 9 and 13, which present the flywheel claims in a different aspect. Claim 9, as originally allowed, was for the arcuate flexing of the film record; claim 13 similarly was for a combination for a means for projecting a narrow line of light upon and through the moving film to a photoelectric cell in [294 U.S. 477, 480] sound reproduction. A disclaimer, filed by respondent shortly before the trial, purports, in varying terms, to add the flywheel device to each of these claims.

While both courts below have found invention and sustained the patent, the Court of Appeals, as will presently appear in more detail, did not pass on the separate claims in issue, but found invention in a combination of elements not embraced in any single claim. In consequence, the case presents no question of concurrent findings by the courts below that the claims in issue severally involve invention. See *Concrete Appliances Co. v. Gomery*, 269 U.S. 177, 180, 46 S.Ct. 42.

#### The Flywheel Claims.

'Phonograms,' or sound records, for the recordation and reproduction of sound, are of several types. They include discs or cylinders to which, and from which, sound vibrations are transmitted mechanically by a stylus in the course of recording and reproducing sound. Long strips of waxed paper carrying sound record grooves, similarly made, are used. Other types are long strips of film on which sound is photographically recorded, and long steel wires on which sound variations have been magnetically recorded. The claims relate to an improvement in mechanisms for recording and reproducing sound by the use of linear photographic record carriers. The typical procedure in recording and reproducing sound by the use of photographic film strips is described in *Paramount Publix Corporation v. American Tri-Ergon Corporation*, 294 U.S. 464, 55 S.Ct. 449, decided this day, and need not be repeated here.

Both in recording and reproducing sound, by any form of record, uniform speed in the movement of the phonogram is of the highest importance, in order to secure evenness and regularity in the reproduced sound. The specifications state:

'The recording and the reproduction of sound waves by the use of linear phonogram carriers such as film strips, [294 U.S. 477, 481] steel wires, and so forth, can only be effected in absolutely satisfactory manner, even after the removal of all other occurring difficulties, when the speed of the record carrier is uniform both for the receiving and the reproduction, and when in both cases no variations of any kind occur. Especially in the case of musical reproductions is the

record extremely sensitive to the slightest variations of speed.'

They also point out that linear phonograms such as the photographic film, because of their lightness and their want of the momentum afforded by a revolving cylinder or disc record, are peculiarly susceptible to irregularities of movement caused by the play or friction in the projections and connections of the many parts of the propelling apparatus, and declare that:

'According to the present invention, this draw-back which attaches to all hitherto known propulsion mechanisms for linear phonogram records is obviated by the arrangement, that the light sound record has given to it at the controlling point the property of a weighty mass. This is attained by the arrangement that the record carrier (a film strip or the like) is firmly pressed against one or more rollers connecting with a heavy rotating mass, so that the record moves in exact conformity with the rollers and the rotating mass.'

The references to a 'weighty mass' or 'a heavy rotating mass' used to secure uniformity of motion are to the familiar flywheel. The specified 'property' of a rotating heavy mass is inertia, the tendency of matter in motion to continue in motion, the force of which is increased by the mass of the moving body. It is the property which gives to the flywheel its peculiar efficacy in securing uniformity of speed in mechanisms with which it is associated.

The first three flywheel claims, 5, 7, and 17, are apparatus claims. The others, 18 and 19, are, in form, method claims, defining the method of securing uniformity in [294 U.S. 477, 482] movement of the record film by apparatus defined by claims 5 and 17. Claim 5 reads as follows:

'In phonographic apparatus in which the sound record is formed on an elongated ribbon of inconsiderable mass, having feeding perforations therein, the combination of

'(a) Means for supporting and progressing the record ribbon from one point to another point and past an intermediate point at which the record is made on the ribbon in recording or from which the record is taken from the ribbon in reproducing, including

'(1) A toothed cylinder over a portion of which the ribbon passes adjacent to said intermediate point, the teeth of said cylinder engaging the perforations of the ribbon,

'(2) A fly-wheel associated with said cylinder, and

'(3) Means for rotating said cylinder, under control of said fly-wheel at uniform speed.'

Claim 17 is substantially the same as claim 5; the principal difference being that it uses the word 'cylinder' instead of 'toothed cylinder.'

Claim 7 adds to the essentials of claim 5 'a resilient connection between said driving member (the shaft) and fly wheel, and stop means for limiting the amount of yielding of said resilient connection.' This so-called flexible or elastic flywheel connection, designed to overcome more gradually the inertia of the flywheel, and thus to secure an improved flywheel operation, was anticipated, among others, by the Constable patent, United States No. 1,425,177, of August 8, 1922, applied for June 24, 1918, as the District Court found. Its inclusion in claim 7 may therefore be disregarded as adding nothing more to the present patent than the flywheel without it.

There is no serious contention, nor could there well be, that the combination apparatus, for moving the linear record past the translation point at which the sound is recorded or reproduced involves invention without the flywheel. Mechanisms for moving linear strips or rib- [294 U.S. 477, 483] bons, by passing the strip over a revolving drum or cylinder, are a familiar type in the arts. They have long been used in the motion picture industry when it was desired to employ the linear strips at an intermediate point for sound and picture reproduction, and the like. Such mechanism, for moving a picture film past the translation point in a motion picture projector, is shown by the Holst patent, United States No. 587,527, of 1897. A like mechanism for recording or reproducing sound, or both, by the use of linear photographic records, is shown in the British Duddel patent, No. 24,546, of 1902, and the Reis patent, United States No. 1,607,480, of 1923, filed May 21, 1913. Still other mechanisms, like two of the figures attached to the specifications of the patent in suit, show the translation point at the film-carrying cylinder. Examples are the patents of Bock, United States No. 364,472, of 1887, Byron, United States No. 1,185,056, of 1916, and Pedersen, British patent No. 115,942, of 1918. The gist of respondent's contention, as is shown by the claims and the parts of the specifications already quoted, is that, by the addition of the flywheel to this familiar mechanism, the patentees have succeeded in producing a new type of machine for recording and reproducing sound by the photographic film method. It is insisted that the new device, because of its greater accuracy and precision of film movement, is so useful and constitutes such an advance in the sound motion picture art, as to entitle it to the rank of a patentable invention.

The flywheel set upon a revolving shaft is an ancient mechanical device for securing continuity and uniformity of motion when brought into association with any form of machinery moved by intermittent force or meeting with irregular or intermittent resistance. 1 So universal is its [294 U.S. 477, 484] use for that purpose in every type of machinery that standard treatises on mechanics, long before the application for the present patent, gave the mathematical formulae for ascertaining the appropriate weight and dimensions of a flywheel, moving at a given speed, required to overcome known variations in force resistance, and prescribed the standard procedure for locating the



flywheel in as direct association as possible with that part of the mechanism at which the intermittent resistance occurs. See article, 'Mechanics,' 121, Encyclopaedia Britannica (11th Ed. 1911); Angus, Theory of Machines, pp. 261-272 (1917).

The specifications of the patent recognize that disc and cylinder records themselves operate as flywheels and proceed to show how a want of a similar control may be supplied, in mechanisms used for motion picture film records, by the addition of the flywheel. But this was specifically taught by the prior art for the reproduction of sound both from phonographic and film records. There are in evidence two Edison commercial recording machines with cylindrical records, which were used at the Edison Recording Laboratory in New York before 1921. Each has a heavy flywheel mounted directly on the shaft of the record-carrying cylinder. These flywheels produce a high degree of 'speed constancy.' An application for a patent by Edison in 1879 on a claim for a combination 'with the phonograph cylinder and its shaft, of a flywheel,' was rejected by the Examiner April 7, 1879, as covering the 'use of a fly wheel as ordinarily used with machinery for the purpose of securing uniformity of motion.' Upon reconsideration, the claim was again rejected on the ground that the adaptation of the flywheel required only the exercise of 'ordinary good judgment' and not the inventive faculty.

The Underhill patent, United States No. 995,390, of 1911, exhibits a phonograph machine with a flywheel to secure uniformity of motion of the record. The specifications [294 U.S. 477, 485] state that the flywheel is used for that purpose. The patent of Alexander Graham Bell and others (Bell & Tainter), United States No. 341,213, of 1886, discloses a mechanism for recording sound on a photographic plate rotated at uniform speed under the control of a flywheel. Another patent of the same inventors, United States No. 341,214, of 1886, discloses a flywheel used in association with a mechanism for moving a linear waxcoated phonograph record at uniform speed for recording and reproducing speech and other sounds. That the record used was not photographic is unimportant. The problem of securing uniformity of motion of the record is the same for either type of linear sound record, as the present patent itself establishes, by classing together all types of linear records as exhibiting the 'problem' to which the patent is directed. The French Dragoumis patent, No. 472,467, of 1914, shows a film record moved by a cylinder turning on a shaft carrying a large wheel, obviously acting as a flywheel, though not described as such. See *American Road-Machine Co. v. Pennock & Sharp Co.*, 164 U.S. 26, 38, 17 S.Ct. 1. The flywheel was mounted on the shaft of the record-carrying cylinder at the translation point. Finally, the British Pedersen patent, already referred to, shows a photographic sound record carried by a cylinder as it passes the translation point. His specifications, after pointing out that sound is 'exceedingly sensitive to variation in rotating speed,' and that it is necessary to obviate this during the recording and reproducing operations, state that this may be done 'by providing particularly large flywheels.'

There are numerous patents showing the like use of the flywheel in apparatus for reproducing motion pictures from film. That of Holst, already noted, shows in detail an

apparatus exhibiting every element of claim 5 except that its use is for reproducing motion pictures instead of sound from film. The toothed cylinder is located adjacent [294 U.S. 477, 486] to the intermediate point which is the point of translation. The flywheel is associated with the cylinder by being attached to the rotary shaft carrying the cylinder.

An improvement to an apparatus or method, to be patentable, must be the result of invention, and not the mere exercise of the skill of the calling or an advance plainly indicated by the prior art. *Electric Cable Joint Co. v. Brooklyn Edison Co.*, 292 U.S. 69, 79, 80 S., 54 S.Ct. 586. The inclusion of a flywheel in any form of mechanism to secure uniformity of its motion has so long been standard procedure in the field of mechanics and machine design that the use of it in the manner claimed by the present patent involved no more than the skill of the calling. See *American Road-Machine Co. v. Pennock & Sharp Co.*, *supra*, page 41 of 164 U. S., 17 S.Ct. 1. Patents for devices for use both in the motion picture art and in the art of sound reproduction, notably the Holst, the Bell & Tainter, the Dragoumis patents, and the Edison application, already noted, plainly foreshadowed the use made of the flywheel in the present patent, if they did not anticipate it. The patentees brought together old elements, in a mechanism involving no new principle, to produce an old result, greater uniformity of motion. However skillfully this was done, and even though there was produced a machine of greater precision and a higher degree of motion constancy, and hence one more useful in the art, it was still the product of skill, not of invention. *Hailes v. Van Wormer*, 20 Wall. 353, 368; *Grinnell Washing Machine Co. v. E. E. Johnson Co.*, 247 U.S. 426, 432-434, 38 S.Ct. 547; *Powers- Kennedy Contracting Corp. v. Concrete Mixing & Conveying Co.*, 282 U.S. 175, 186, 51 S.Ct. 95. Its application in recording sound or reproducing it, by use of a particular type of linear record, the photographic, analogous so far as the problem of uniformity of motion was concerned to other types used by Bell & Tainter and Dragoumis, was not invention. See *Paramount Publix Corporation v. American Tri-Ergon Corporation*, *supra*. [294 U.S. 477, 487] There is some suggestion in respondent's brief and argument that the location of the flywheel adjacent to the toothed cylinder is an element in the invention which contributed to the success of the mechanism. But, as has already been indicated, such location is but the teaching of the art. In any case, the claims call only for the flywheel located upon the shaft or in association with the cylinder. No particular location is mentioned.

The Court of Appeals, in upholding the patent, made no examination of its separate claims, but treated the patent throughout as though it were a combination of five distinct elements, the photo-electric cell, the arcuate flexing of the film, the flywheel, the flexible connection of the flywheel, and the optical slit, although nowhere in the patent is any such combination claimed. The patent thus upheld is one which was neither claimed nor granted. Under the statute, it is the claims of the patent which define the invention. See *White v. Dunbar*, 119 U.S. 47, 51, 52 S., 7 S. Ct. 72; *McClain v. Ortmyer*, 141 U.S. 419, 423-425, 12 S.Ct. 76; *Paper Bag Patent Case (Continental Paper Bag Co. v. Eastern Paper Bag Co.)*, 210 U.S. 405, 419, 28 S.Ct. 748; *Smith v. Snow*, 294 U.S. 1, 55 S.Ct. 279, decided January 7, 1935. And each claim must stand or fall, as itself

sufficiently defining invention, independently of the others. See *Carlton v. Bokee*, 17 Wall. 463, 472; *Russell v. Place*, 94 U.S. 606, 609; *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U.S. 301, 319, 29 S.Ct. 495; *Symington Co. v. National Malleable Castings Co.*, 250 U.S. 383, 385, 39 S.Ct. 542; *Smith v. Snow*, *supra*; *Walker on Patents* (6th Ed.) 220. As none of the flywheel claims as drawn define an invention, none can be aided by reading into it parts of the specifications, or of other claims, which the patentees failed to include in it.

The court below, attributing the rapid development of the sound motion picture industry to the invention in the patent in suit, thought, as respondent earnestly argues here, that its utility and commercial success must be accepted as convincing evidence of invention. But we think that [294 U.S. 477, 488] want of invention would have to be far more doubtful than it is to be aided by evidence of commercial success, indicating that it brought realization of a long-felt want. *Smith v. Goodyear Dental Vulcanite Co.*, 93 U.S. 486, 495, 496 S.; *Grant v. Walker*, 148 U.S. 547, 556, 13 S.Ct. 699; *De Forest Radio Co. v. General Electric Co.*, 283 U.S. 664, 685, 51 S.Ct. 563. Compare *McClain v. Ortmyer*, *supra*, page 428 of 141 U.S., 12 S.Ct. 76. Moreover, the record fails to show that there was any long felt or generally recognized want in the motion picture industry for the device defined by the flywheel claims, or that the use of sound motion pictures was delayed by the inability of those skilled in the art to add a flywheel to the apparatus in order to give the desired uniformity of motion to linear phonograms. See *Paramount Publix Corporation v. American Tri-Ergon Corporation*, *supra*. There was no public demand for sound motion pictures before 1926, when the disc system of the Western Electric Company was first publicly used in conjunction with moving pictures. Before change to the photographic film system could be accomplished, it was necessary to await the development of numerous electrical devices not embraced in the present claims. Among them were adequate amplifiers, loud speakers, and microphones. Progress in the perfection of these appliances was achieved rapidly, after the public acceptance of the sound picture in 1926, through the efforts of many independent workers in the field. When the need arose for a mechanism suitable to move film records with such speed constancy as to reproduce the sound successfully, it was forthcoming. Only the skill of the art was required to adapt the flywheel device to familiar types of mechanism to secure the desired result.

Claims 9 and 13.

The court below made no reference to the contention of petitioner, urged here and below, that the patent was rendered invalid by the disclaimer filed shortly before the [294 U.S. 477, 489] trial of the present suit. The patent as issued contained the following claims:

'9. The method of translating sound or similar vibrations to or from a film record by the use of light varied in accordance with the sound, which comprises flexing the film arcuately longitudinally at the point of translation and rapidly and uniformly moving the film in a circumferential direction past said point.'

'13. An apparatus for reproducing speech, music or the like sounds from vibrations recorded on a film, by the use of a line of light varied in accordance with the sound, comprising a photo-electric cell, means for imparting to the film a rapid and uniform motion longitudinally of the film past said cell, a source of light projection for providing said light, and an objective lens in the path of said light and spaced from the film for directing said light as a converging narrow line impinging on the film at a point in the region of the focal point of said lens, said light passing through the film and on to said cell, the space between said lens and the film being free of obstructions to said light.'

In 1933 respondents, by appropriate procedure, disclaimed:

'(b) The method as set forth in claim 9, except wherein the uniformity of movement of the film past the translation point is effected by subjecting the portion of the film passing said point to the control of the inertia of a rotating weighty mass.

'(c) The combination as set forth in claim 13, except wherein a flywheel is operatively connected with the film through means which imparts uniformity of motion of the flywheel to the film.'

While the effect of the disclaimer, if valid, was in one sense to narrow the claims, so as to cover the combinations originally appearing in claims 9 and 13 only when used in conjunction with a flywheel, it also operated to [294 U.S. 477, 490] add the flywheel as a new element to each of the combinations described in the claims. The disclaimer is authorized by Rev. St. 4917 (35 USCA 65), which provides that, when 'through inadvertence, accident, or mistake ... a patentee has claimed more than that of which he was the ... inventor ... his patent shall be valid for all that part which is truly and justly his own,' provided that he or his assigns 'make disclaimer of such parts of the thing patented as he shall not choose to claim ... stating therein the extent of his interest in such patent.' While this statute affords a wide scope for relinquishment by the patentee of part of the patent mistakenly claimed, where the effect is to restrict or curtail the monopoly of the patent,<sup>2</sup> it does not permit the addition of a new element to the combination previously claimed, whereby the patent originally for one combination is transformed into a new and different one for the new combination. [294 U.S. 477, 491] If a change such as the present could validly be made, it could only be under the provisions of the reissue statute, Rev. St. 4916, amended by Act May 24, 1928 (35 USCA 64), which authorizes the alteration of the original invention in a reissued patent, upon surrender of the old patent, for its unexpired term. Upon the reissue, 'the specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are.' A patent amended by disclaimer thus speaks from the date of the original patent, while the reissued patent, with respect to the amended claim, speaks from the date of reissue. If respondent could thus, by disclaimer, add the

flywheel to the arcuate flexing claim and to the optical claim, he would in effect secure a new patent operating retroactively in a manner not permitted by the reissue statute and without subjecting the new claims to revision or restriction by the customary Patent Office procedure required in the case of an original or reissued patent. Such transformation of a patent is plainly not within the scope of the disclaimer statute, and the attempted disclaimer as applied to claims 9 and 13 is void. *Hailes v. Albany Stove Co.*, 123 U.S. 582, 587, 8 S.Ct. 262.3 See *Union Metallic Cartridge Co. v. United States Cartridge Co.*, 112 U.S. 624, 642, 5 S.Ct. 475; *Collins Co. v. Coes*, 130 U.S. 56, 68, 9 S.Ct. 514. Compare *Grant v. Walker*, [294 U.S. 477, 492] 148 U.S. 547, 553, 13 S.Ct. 699. It is unnecessary to consider whether the flywheel claim, if added to the original claims 9 and 13, is such a part of the patentee's original conception as to entitle it to the benefit of the reissue statute. See *Miller v. Brass Co.*, 104 U.S. 350, 355; *Hoffheins v. Russell*, 107 U.S. 132, 141, 1 S.Ct. 570; *Gage v. Herring*, 107 U.S. 640, 645, 2 S.Ct. 819; *Ives v. Sargent*, 119 U.S. 652, 663, 7 S.Ct. 436; *Corbin Cabinet Lock Co. v. Eagle Lock Co.*, 150 U.S. 38, 41-43, 14 S.Ct. 28.

With the invalid disclaimer must fall the original claims as they stood before the disclaimer. The disclaimer is a representation, as open as the patent itself, on which the public is entitled to rely, that the original claim is one which the patentee does not, in the language of the statute, 'choose to claim or to hold by virtue of the patent.' Upon the filing of the disclaimers, the original claims were withdrawn from the protection of the patent laws, and the public was entitled to manufacture and use the device originally claimed as freely as though it had been abandoned. To permit the abandoned claim to be revived, with the presumption of validity, because the patentee had made an improper use of the disclaimer, would be an inadmissible abuse of the patent law to the detriment of the public.

While the precise effect of an invalid disclaimer upon the original claim seems not to have been judicially determined, analogous principles of the patent law are so well recognized as to leave no doubt what our decision should be. It has long been settled that a claim abandoned or rejected in the Patent Office with the acquiescence of the applicant cannot be revived in a reissued patent. *Yale Lock Mfg. Co. v. Berkshire Nat. Bank*, 135 U.S. 342, 379, 10 S.Ct. 884; *Dobson v. Lees*, 137 U.S. 258, 263-265, 11 S.Ct. 71. Nor can an interpretation be given the allowed claims which would revive the claims which were abandoned in order to obtain the patent. *Shepard v. Carrigan*, 116 U.S. 593, 597, 6 S.Ct. 493; *Roemer v. Peddie*, 132 U.S. 313, 317, 10 S.Ct. 98; *Royer v. Coupe*, 146 U.S. 524, 532, 13 S.Ct. 166; *Corbin Cabinet Lock Co. v. Eagle Lock Co.*, 150 U.S. 38, 40, 14 S.Ct. 28; *Morgan Envelope Co. v. Albany Paper Co.*, 152 U.S. [294 U.S. 477, 493] 425, 429, 14 S.Ct. 627; *I.T.S. Co. v. Essex Co.*, 272 U.S. 429, 443, 47 S.Ct. 136; *Smith v. Magic City Club*, 282 U.S. 784, 789, 790 S., 51 S.Ct. 291; *Smith v. Snow*, *supra*. Similarly where, in order to secure a reissued patent, a disclaimer is made of a part of the original claims, the part so disclaimed cannot be revived by a second reissued patent, *Leggett v. Avery*, 101 U.S. 256, nor where the disclaimer is for the purpose of securing an extension of the original patent, *Union Metallic Cartridge Co. v. U.S. Cartridge Co.*,

supra, page 644 of 112 U.S., 5 S.Ct. 475. See *Collins v. Coes*, supra, page 68 of 130 U.S., 9 S.Ct. 514. Compare *Gage v. Herring*, supra, page 646 of 107 U.S., 2 S.Ct. 819. The settled rule that unreasonable delay in making a disclaimer invalidates the whole patent, *Ensten v. Simon, Ascher & Co.*, 282 U.S. 445, 452-458, 51 S.Ct. 207; compare *O'Reilly v. Morse*, 15 How. 62, 121; *Seymour v. McCormick*, 19 How. 96, 106; *Silby v. Foote*, 20 How. 378, 387; *Gage v. Herring*, supra, page 646 of 107 U.S., 2 S.Ct. 819; *Yale Lock Mfg. Co. v. Sargent*, 117 U.S. 536, 554, 6 S.Ct. 934; *Minerals Separation, Ltd. v. Butte & Superior Mining Co.*, 250 U.S. 336, 354, 39 S.Ct. 496, rests upon the similar principle that misuse of the patent, or a part of it, by the patentee, in such a manner as to mislead the public or operate to its detriment, deprives the claim of the benefit of the patent laws. The part of the patent disclaimed can stand in no better position because the disclaimer was an unsuccessful misuse of the disclaimer statute.

As claims 9 and 13 must be held invalid because of the improper disclaimers, and as the remaining claims in issue, the flywheel claims, are held invalid for want of invention, it is unnecessary to determine whether the improper disclaimers as to some of the claims render the entire patent void, as petitioners contend, and as has been intimated but not decided. See *Hailes v. Albany Stove Co.*, supra, page 589 of 123 U.S., 8 S.Ct. 262; *Marconi Wireless Telegraph Co. v. De Forest Radio Tel. & Tel. Co.*, 243 F. 560, 565 (C.C.A.2d); *Seiberling v. John E. Thropp's Sons Co.*, 284 F. 746, 756, 759 (C.C.A.3d).

REVERSED.

Mr. Justice BRANDEIS took no part in the consideration or decision of this case.

## Footnotes

[ Footnote \* ] Rehearing denied 294 U.S. 734, 55 S.Ct. 634, 79 L.Ed. --. [ *Altoona Publix Theatres v. American Tri-Ergon Corp.* 294 U.S. 477 (1935) ]

[ Footnote 1 ] The addition of the flywheel to the steam engine, in 1758, was said to be 'a very important addition to the engine, and though sufficiently obvious, it is ingenious and requires considerable skill and address to make it effective.' Robison, *Mechanical Philosophy*, vol. 2, p. 105 (1822).

[ Footnote 2 ] The disclaimer and reissue statutes were adopted to avoid the rule that, if one claim is invalid, the whole patent is void. *Moody v. Fiske*, Fed. Cas. No. 9,745, 2 Mason 112, 118; see *Ensten v. Simon, Ascher & Co.*, 282 U.S. 445, 452, 51 S.Ct. 207; *Hailes v. Albany Stove Co.*, 123 U.S. 582, 589, 8 S.Ct. 262. The use of the disclaimer has been upheld where the elimination from the patent of the matter not relied upon did not operate to enlarge the monopoly of the patent, but narrowed it, as by eliminating in their entirety some of the claims of the patent, *Sessions v. Romadka*, 145 U.S. 29, 40, 12 S.Ct. 799; see *Union Metallic Cartridge Co. v. United States Cartridge Co.*, 112 U.S. 624, 642, 5 S.Ct. 475, or by striking out an alternative method or device; *Dunbar v.*

Meyers, 94 U.S. 187, 192, 194 S.; Hurlburt v. Schillinger, 130 U.S. 456, 9 S.Ct. 584; Carson v. American Smelting & Refining Co., 4 F.(2d) 463, 469, 470 (C.C.A.9th), or by limitation of a claim or specification by deletion of unnecessary parts, Carnegie Steel Co. v. Cambria Iron Co., 185 U.S. 403, 435, 436 S., 22 S.Ct. 698; Marconi Wireless Telegraph Co. v. De Forest Radio Telephone & Telegraph Co., 243 F. 560, 565 (C.C.A.2d), or by limiting the claim to a specific type of the general class to which it was applied, Minerals Separation, Ltd. v. Butte & Superior Mining Co., 250 U.S. 336, 354, 39 S.Ct. 496; United Chromium, Inc., v. International Silver Co., 60 F. (2d) 913, 914 (C.C.A.2d); Seiberling v. John E. Thropp's Sons Co., 284 F. 746, 756, 757 (C.C.A.3d).

[ Footnote 3 ] Albany Steam Trap Co. v. Worthington, 79 F. 966, 969 (C.C.A.2d); Strause Gas Iron Co. v. Wm. M. Crane Co., 235 F. 126, 129, 130 (C.C.A.2d); Graselli Chemical Co. v. National Aniline & Chemical Co., 26 F.(2d) 305, 310 (C.C.A.2d); Hudson Motor Car Co. v. American Plug Co., 41 F.(2d) 672, 673 (C.C.A.6th); Corn Products Refining Co. v. Penick & Ford, Ltd., 63 F.( 2d) 26, 30, 31 (C.C.A.7th); General Motors Corp. v. Rubsam Corp., 65 F.(2d) 217, 222 (C.C.A.6th); Consumers' Tobacco Co. v. American Tobacco Co., 66 F.( 2d) 926, 927 (C.C.A.3d); Fruehauf Trailer Co. v. Highway Trailer Co., 67 F.( 2d) 558, 559, 560 (C.C.A.6th); White v. E. P. Gleason Mfg. Co., 17 F. 159, 160 (C.C.); Cerealine Mfg. Co. v. Bates, 77 F. 883, 884 (C.C.); Westinghouse Air Brake Co. v. New York Air Brake Co., 139 F. 265, 267-270, ( C.C.).

15. In re Jentoft, 392 F.2d 633, 157 USPQ 363 (CCPA 1968)



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*55 C.C.P.A. 1026, \*; 392 F.2d 633, \*\*;  
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IN RE ARTHUR PHILIP JENTOFT

No. 7905

United States Court of Customs and Patent Appeals

55 C.C.P.A. 1026; 392 F.2d 633; 1968 CCPA LEXIS 359; 157 U.S.P.Q. (BNA) 363

Oral argument February 5, 1968 April 18, 1968

**PRIOR HISTORY:** [\*\*\*1]

APPEAL from Patent Office, Serial No. 144,610

**DISPOSITION:** Reversed.

**CASE SUMMARY**

**PROCEDURAL POSTURE:** Appellant sought review of a decision of the Patent Office Board of Appeals that affirmed the rejection of his patent claims for an extensible plug air valve on obviousness double-patenting grounds.

**OVERVIEW:** After having his patent claims for an air valve rejected as obviousness-type double-patenting, appellant filed a terminal disclaimer in order to overcome the rejection. The court assumed arguendo the obviousness of the claim in the double patenting sense and the presence in appellant's application of a generic claim. The court held that these facts would prevent issuance of a patent absent a valid terminal disclaimer. However, the court held that the terminal disclaimer obviated the double-patenting rejection because it alleviated the policy threats that double-patenting posed. The problem of extension of monopoly was not present; the possibility of harassment by multiple assignees of possible infringers was not a problem since the patent was commonly owned; and the problem of avoidance of file-wrapper estoppel by filing a second application was not a concern if properly tried before a competent court. Therefore, the court reversed the Board's rejection of appellant's patent claims.

**OUTCOME:** The court reversed the rejection of appellant's claims because the policy problems of double-patenting on obviousness grounds were obviated by appellant's terminal disclaimer.

**CORE TERMS:** patent, valve, terminal, patenting, disclaimer, double, plug, bellows, examiner, horn, invention, membrane, conical, conduit, harassment, expansible, assignee, obviousness, resilient, rigid, cone, generic, axially, chamber, subject matter, overlap, embodiment, disclosure, alignment, estoppel

LexisNexis(R) Headnotes ☐ Hide Headnotes

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Patent Law > U.S. Patent & Trademark Office Proceedings > Appeals

**HN1** To make a rejection of patent claims fully intelligible by the Patent Office Board of Appeals, it must be related to the claims on appeal.

**COUNSEL:** Harry B. Keck for appellant.

Joseph Schimmel (Joseph F. Nakamura, of counsel) for the Commissioner of Patents.

**OPINION BY:** RICH

**OPINION:** **[\*\*633]**

**[\*1027]** Before WORLEY, Chief Judge, and Judges RICH, SMITH, ALMOND, KIRKPATRICK. \*

----- Footnotes -----

\* Senior District Judge, Eastern District of Pennsylvania, sitting by designation.

----- End Footnotes -----

RICH, Judge, delivered the opinion of the court:

This appeal is from a decision of the Patent Office Board of Appeals affirming the rejection of claims 3, 9, 13, and 14 **[\*\*634]** of application serial No. 144,610, filed October 12, 1961, for "Extensible Plug Valve." In his brief, appellant "waives the appeal" as to claims 13 and 14 so as to them the appeal will be dismissed, leaving for consideration only claims 3 and 9. n1

----- Footnotes -----

n1 Claims 5, 10, 11, and 15 have been allowed. Other claims in the application but withdrawn from further consideration under Rule 142(b) are claims 7, 8, and 12. As to them, the board dismissed the appeal and they are not before us.

----- End Footnotes ----- **[\*\*2]**

**[\*1028]** **[1]** This is an obviousness-type double patenting case in which a terminal disclaimer has been filed and considered below. The sole ground of rejection is double patenting founded on certain claims of appellant Jentoff's patent No. 3,010,692, issued Nov. 28, 1961, on an application filed Nov. 20, 1959, copending with the application at bar from Oct. 12 to Nov. 28, 1961. The patent is not, of course, prior art. To support the double patenting obviousness contention, the following prior art is relied on:

Work 2,584,523 Feb. 5, 1952

### The Patented Invention

Broadly, the invention is a gas-flow control valve capable of remote control by fluid pressure which actuates the valve. More particularly, it is an air valve for ventilation systems. The patent discloses two embodiments both operating on the same broad principal but with differing structure. Reproduced below are Fig. 1, showing one embodiment, and Figs. 8 and 9, showing the other embodiment as well as the mode of operation.

[Graphic omitted. See illustration in original.]

[\*1029] [Graphic omitted. See illustration in original.] [\*\*\*3]

Referring to Fig. 1, the air duct is 10 and has an outwardly flared horn 11 at its end where it would open into a room. Suspended in front of the horn by brackets 16 is a cone-shaped structure consisting of a base 14 and a perforate, rigid, stationary cone 15 of metal over which is mounted a conical membrane 19 of [\*\*635] resilient, expansible material such as rubber. The membrane 19 is attached to the base in air-tight fashion by strap 29 secured in groove 28. Pipe 22 admits control air into the conical chamber for the purpose of inflating the membrane 19 to partially or fully close the annular passage between it and the horn 11 to control the flow of air through the duct 10.

A modified form, having the advantage of lighter weight, is shown in Fig. 8 wherein the baseplate 14 of Fig. 1 is omitted and the supporting cone 32 is made imperforate, having the air inlet 35 attached to and passing through it at boss 33. Fig. 9 shows, in connection with the Fig. 8 embodiment of the invention, how the expansible membrane operates to effect a valving action when it is inflated. (The Fig. 1 form inflates in the same way.) Dotted line 36a shows the valve partially closed, full line [\*\*\*4] 36b shows it fully closed, and dotted line 36c shows how, on further inflation, the membrane is in contact with the horn over a substantial area. The disclosure of the patent is limited to those two forms of the invention and all of its claims are limited to a "conical membrane of resilient, expansible material" as the means for controlling the flow of air. This is called the "balloon" type valve.

[\*1030] The Invention of the Application

In contrast with the balloon type valve of the patent, the valve of the application is called the "bellows" type. Fig. 1 is reproduced:

[Graphic omitted. See illustration in original.]

Instead of having an expansible membrane resting on a stationary cone and acting as a valve by being inflated, the invention of the application secures to the fixed backplate 20 a normally collapsed bellows 24, poined air-tight therewith and with a cone-shaped "plug" 22 attached to the other end of the bellows. This plug, as the specification says, "preferably is a hollow conical plug of relatively rigid material such as stiff rubber, sheet metal or plastic materials." Alternatively, it is of "thin resilient material such as rubber." Operation of [\*\*\*5] that alternative is stated to be "similar in all respects to the operation of the preferred embodiment." Or the plug may be solid, "of lightweight plastic material such as rubber, foamed rubber, foamed polyurethane, and the like." Valve action is produced, upon changing the air pressure in the closed chamber formed by backplate, bellows, and plug, by axial movement of the plug as permitted by the bellows and shown in dotted lines illustrating the closed position. To prevent drooping of the plug when the bellows is extended, it is necessary to provide supporting means 46 which is shown above as consisting of a [\*\*636] tube 48 fixed to the backplate at 49 and a rod 50 sliding in the tube and attached to the apex of the conical plug. Other supporting means such as lazy-tongs are disclosed.

It also appears that with this plug valve moving axially it is unnecessary to have the horn 11 and it has therefore been omitted [\*1031] from some claims. Without it, the plug would move in and out of the open or terminal end of conduit 10.

The Rejection

Claims 3 and 9 on appeal stand rejected on the sole ground of "double patenting over claim 5 of applicant's patent (3010692) modified [\*\*\*6] either in view of (1) Eisele taken with Work or (2) Work taken with Eisele." (Examiner's Answer.)

Work discloses a pressure relief valve for use in fluid pressure systems in which a fluid-pressure-actuated metal bellows raises and lowers a flat valve disk relative to its seat. Inside the bellows is a telescoping rod-and-tube guiding and aligning means.

Eisele discloses a condensate discharge valve built inside a common tee fitting, the side outlet of which is plugged. In the upper leg of the tee and operating downwardly a metal bellows filled with low boiling point liquid is mounted. On the lower end of the bellows is a closure cap carrying a conical plug. The lower leg of the tee is provided with a valve seat having an aperture cooperating with the plug to form a valve. When condensate surrounds the bellows it contracts and opens the valve to discharge the condensate and when steam surrounds the bellows it expands and closes the valve. It is cited for its disclosure of the conical shape of the plug and for its bellows actuation.

Claim 5 of Jentoft's patent reads:

5. A gas flow regulating valve for controlling the flow of gas from a conduit terminal, comprising an [\*\*\*7] outwardly flared horn engageable in communicating [relation] at its narrow end with said conduit terminal, a base plate secured in spaced outer relation to the expanded end of said horn by means of spaced support arms extending from said base to the rim of said horn, a rigid, perforate cone extending from said base plate coaxially into said horn, a conical membrane of resilient, expansible material secured at its base to said base plate and extending coaxially into said horn and being in its relaxed condition spaced apart from the inner wall of said horn substantially overlying said rigid cone to provide an annular gas passageway leading outwardly from said conduit, said conical membrane and said base plate forming an enclosed valve operating chamber, and an inlet tube extending into said valve operating chamber to admit fluids therein whereby said conical membrane may be extended outwardly to constrict the annular space between said membrane and said horn. [Emphasis added for reasons referred to later under "The Board Opinion."]

As is evident, claim 5 recites the elements and functional relationships thereof present in the Fig. 1 embodiment of the balloon-type valve described [\*\*\*8] above. It delimits, therefore, a rather narrow patent right to that specific valve - that is, the right to exclude others from making the valve of Fig. 1 of the patent.

[\*1032] The examiner's position on "double patenting" must mean that in his opinion the appealed claims delimit another potential patent right on a valve which, in view of the prior art disclosures of Work and Eisele, is merely an obvious modification of the patented Fig. 1 valve defined in claim 5, taking into account the nature of the distinctions the examiner saw between claim 5 and the appealed claims. The examiner expressed himself on obviousness as follows:

\*\*\* it is the examiner's position that it would be an obvious expedient to a person having ordinary skill in the art to substitute the bellows 6 and conical plug 9 of Eisele for the rigid, perforate cone and overlying conical membrane of resilient, expansible [\*\*637] material recited in lines 7-14 of claim 5 \*\*\* since both the device of said claim 5 and of Eisele are pressure responsive valves.

That statement pertains to the obviousness not only of replacing the cone and membrane of the balloon valve with a bellows and conical plug but [\*\*\*9] also mechanically arranging the same to operate by axial movement instead of expansion. As to adding the guiding means to keep the plug of the bellows valve in axial alignment during movement, the examiner continued:

Furthermore, it would be obvious to provide the device of claim 5 \*\*\* as modified by Eisele with "an extensible alignment means" comprising telescopically engaged "shafts" in view of the teaching of the use of such guide means \*\*\* in the pressure actuated bellows valve of Work.

As to his alternative rejection on reversed application of the references, the examiner said:

Similarly, considering the second alternative, it would be obvious to substitute the bellows operated valve and alignment means shown in Work \*\*\* for the expansible membrane of the device claimed in claim 5 of Jentoft \*\*\* and to provide the valve of said device of claim 5 as modified by Work with any type valve head desired; such as, for example, the conical head of Eisele.

## The Appealed Claims

HN1 To make the rejection fully intelligible, it must be related to the claims on appeal.

Claim 3 depends from claim 9 and recites only details of the alignment means, defining it to be the telescoping [\*\*\*10] shaft arrangement shown above in the application drawing. It need not be further considered:

Claim 9 is the only claim we need discuss. It reads (original format):

9. A gas flow regulating valve for controlling the flow of gas from a conduit terminal, comprising:

a back plate secured in spaced outer relation to the end of said conduit terminal;

a normally collapsed, resilient bellows having one end secured to the said back plate;

[\*1033] a plug having a base end and an apex end and having a diminishing cross-sectional area from the said base end to the said apex end, said plug being positioned between the said bellows and the said horn n2 and having its said base end secured to the other end of the said bellows whereby the said back plate, the said bellows and the said plug define a chamber, said plug being moveable axially toward and away from the said conduit terminal solely by the extension and contraction of the said bellows;

----- Footnotes -----

n2 The word "horn" should be read "conduit terminal." As will be seen, there is no antecedent in the claim for "said horn" by reason of the fact, as shown in the record, that reference to the "outwardly flared horn" was deleted from the claim by amendment because it was not an essential element with this form of valve. The above reference to the horn, which should also have been amended, was evidently overlooked.

----- End Footnotes----- [\*\*\*11]

extensible alignment means within the said chamber for maintaining the said plug substantially axially aligned with the central axis of said conduit terminal; and

conduit means for introducing and withdrawing fluids from the said chamber whereby the said plug moves axially toward and away from the said conduit terminal to control the flow of gas therefrom.

### Patent Claim 5 and Application Claim 9 Compared

Claim 9 is clearly directed to the bellows type of valve shown above in the application drawing in which there is an axially movable "plug" rather than an expansible, resilient membrane as in the balloon type of valve. Claim 9 and patent claim 5 are both combination claims. [\*\*638] The elements recited in patent claim 5 are horn, baseplate, support arms, perforate rigid (and immovable) cone, expansible membrane, and inlet tube (for control fluid). The elements recited in appealed claim 9 are backplate, bellows, axially movable plug, alignment means, and conduit means for control fluid. Obviously, two different mechanisms are defined, operating in different ways, albeit they accomplish the same result, control of air flow. Clearly they are different inventions. The examiner [\*\*\*12] recognized as much and referred to them as "the invention disclosed in the patent and the invention disclosed in the instant application." The disclosures are different, if not mutually exclusive, and the two claims under consideration closely correspond to the disclosures. n3

----- Footnotes -----

n3 There is no formal relationship between the application at bar and the patent or its application. While there was copendency, neither contains any reference to the other, so far as the record shows, apart from the showing in the file of the present double patenting rejection.

----- End Footnotes-----

Wholly separate and distinct inventions being claimed in the claims on appeal and in the only patent claim relied on to support the double patenting rejection, we do not have here a "same-invention" type of case but only an obviousness-type double patenting rejection, the examiner's reasoning on obviousness being set forth above.

[\*1034] The Terminal Disclaimer

Faced with an obviousness-type double patenting rejection which was made final, appellant [\*\*\*13] filed a terminal disclaimer n4 and argument as to why it should be accepted as overcoming the rejection, citing our decision in In re Robeson, 51 CCPA 1271, 331 F.2d 610, 141 USPQ 485.

----- Footnotes -----

n4 Actually he filed two. The first was objected to as to form in being limited to the rejected claims. He filed a new one referring to any patent granted, which was accepted and considered by the examiner. Disclaimer was by H. H. Robertson Company, a Pennsylvania corporation, of Pittsburgh, as owner of the application.

----- End Footnotes-----

At this point, the examiner brought another claim of the patent into the picture, not as basis for the rejection but as reason for refusing to follow Robeson. n5 The examiner said:

----- Footnotes -----

n5 The distinction of purpose was made very clear by the examiner. Appellant was perplexed as to whether the rejection was based on claim 5 or on claim 2 and requested clarification, which was given as follows:

\*\*\* rejection of claims 3, 9, 13 and 14 is based on claim 5.

Reference to claim 2 was made for the purpose of pointing out that the patent contains a claim to subject matter which is generic to the subject matter being claimed in the instant application to establish a basis for the holding that the doctrines of In re Robeson, 141 USPQ 485, and In re Kaye, 141 USPQ 829, do not apply.

----- End Footnotes----- [\*\*\*14]

The terminal disclaimer \*\*\* is not considered effective to obviate the double patenting rejection \*\*\* since the patent to Jentoft contains claim 2, the subject matter of which is generic to both the invention disclosed in the patent and the invention disclosed in the instant application. The rejection \*\*\* is therefore repeated.

The examiner amplified his position in his Answer. He said claim 2 "overlaps or dominates the subject matter covered by the claims of the present application." This he attempted to demonstrate by parallel analysis of claim 2 and appealed claim 9. He said this was a "vital" difference from the facts in Robeson and Kaye. "Thus," he said, "the matter of harassment by multiple assignees was not a possibility in the situations presented by the said Kaye and Robeson situations." Because of the overlap, he said,

\*\*\* In re Siu, 42 CCPA 864, 222 F.2d 267, 105 USPQ 428, rather than \*\*\* In re Kaye and In re Robeson applies and the rejection based on double patenting has not been obviated by the filing of a terminal disclaimer. [\*\*639]

## The Board Opinion

The board's very short opinion gave a blanket approval to the examiner's position. It also [\*\*\*15] specifically agreed with the examiner that it would be obvious that "the conical structure recited in claim 2 of appellant's patent 3,010,692 could be moved into and out of valve closing position by a bellows type actuator such as shown by the secondary references." (We will assume the board meant claim 5, not claim 2, as the Patent Office Solicitor also seems to assume, otherwise [\*1035] the board would have been making a new rejection, not apparently intended. What is in claim 2 of the patent is shown by omitting the italicized portion of claim 5, quoted above.) The board then said:

The terminal disclaimer filed by appellant is ineffective for its intended purpose.

The court pointed out in the Robeson case \* \* \* that the objections to double patenting were (1) extension of monopoly, (2) harassment by multiple assignees, and (3) avoidance of file wrapper estoppel by filing of a second application.

In the present case the terminal disclaimer might resolve the question of extension of monopoly but the disclaimer does nothing towards resolving the second and third objections recited in the next preceding paragraph. The generic claim 2 in the patent would permit appellant, [\*\*\*16] his assignee, or different assignees holding title to one of the applications [sic] to harass members of the public with multiple suits.

## Opinion

The several possible issues before us are: the obviousness question; whether patent claim 2 is actually generic and would be infringed by the apparatus described and claimed in the application or, specifically, claim 9 thereof; whether, if claim 2 is generic, that would prevent the disclaimer from overcoming the rejection for double patenting; whether the disclaimer overcomes the rejection even if the other questions are decided in favor of the Patent Office and against appellant.

The Patent Office brief treats the questions of double patenting and the effect of the terminal disclaimer as separate issues, considering, first, whether there would be "double patenting" without the disclaimer and, next, whether the disclaimer "obviates" it. n6 Although from the standpoint of patentability, under all the circumstances, the two questions are inextricably intertwined, we will approach the problem in the same progressive order. That is the way it developed in the prosecution and the way it was approached below - one question at a time. [\*\*\*17]

----- Footnotes -----

n6 One might almost take the filing of a terminal disclaimer in response to a "double patenting" rejection to be a tacit admission that, without it, there would be double patenting except for the observation we have made in these cases that applicants frequently like to argue both issues. It is an unhappy circumstance to file a terminal disclaimer in a case where, on appeal, it turns out to have been unnecessary. For a solution to that problem see *Ex parte Fertig et al.*, 155 USPQ 475, decided May 12, 1967, wherein the Board of Appeals, in an obviousness-type double patenting case, affirmed the holding of obviousness and double patenting but recommended under Rule 196(c) "that the claims on appeal be considered allowable upon the presentation of a proper terminal disclaimer," applicant having offered, before the examiner, to file such disclaimer. The recommendation was predicated on our Robeson and Kaye decisions and on a finding that there was no "overlap" in the claims, a matter dealt with by us subsequently in the Braithwaite cases, *infra*.

----- End Footnotes ----- [\*\*\*18]

[\*1036] [2] While we have serious doubts about both obviousness n7 and the generic [\*\*640] nature of claim 2, n8 we find it unnecessary to pass on these issues in view of the effect which we think should be given to the terminal disclaimer. We will assume, *arguendo*, both obviousness in the double patenting sense n9 and the presence in the patent of a generic claim (which, we presume, produces what the Patent Office has been referring to of late as "overlap"). Based on these assumptions, a "double patenting" situation exists which suffices to prevent issuance of a patent on the application at bar, absent a terminal disclaimer.

----- Footnotes -----

n7 Our doubt on this score rests in part on the allowed claims. It would appear from the record that the examiner allowed claims, as to unobvious inventions, which are like claim 9 except that the "plug" is recited to be rigid and hollow, or of thin resilient material. The distinction is a tenuous one.

n8 We have difficulty reading claim 2 of the patent on the axially moving plug valve of the application since it requires a "conical membrane of expansible material" which is spaced from the horn in its "relaxed condition," thus implying expansion and a balloon-type of operation. It is unclear, to say the least, how it would be infringed by a rigid, axially-moving plug valve. [\*\*\*19]

n9 We thus qualify the term "obviousness" to distinguish it from an issue under 35 USC 103 and as a reminder that it is predicated only partially on prior art, the subject matter claimed in the applicant's own pending patent being a necessary basis for the finding, without which it would not be possible. If possible, then the rejection should be on prior art, not for "double patenting."

----- End Footnotes -----

[3] Turning to the effectiveness of the terminal disclaimer to obviate the double patenting objection, we note, first, that there are clearly distinct inventions in the patent and application and that we are not here presented with a possible single invention issue. Therefore, cases such as *In re Siu*, relied on by the examiner, are inapposite. Likewise, 35 USC 101 cited as a statutory basis in such cases is not involved and the rejection rests solely on case law.

Since this is an obviousness-type double patenting situation, we hold that the terminal disclaimer, timely filed and considered by both the examiner and the board, obviates the double patenting rejection even if, as assumed, there is "overlap." [\*\*\*20]

Our decisions in the two cases entitled *In re Braithwaite*, 54 CCPA 1589 and 1604, 379 F.2d 594 and 606, 154 USPQ 29 and 38, decided June 15, 1967, a year and a half after the board decision and after the filing of the Patent Office brief herein should answer many of the questions herein raised. In those cases we did not consider domination or "overlap" to be a significant or controlling factor. Nor do we here on somewhat different facts.

#### No Extension of Monopoly

[4] The board was apparently of the view, though cautious in expressing it, that the terminal disclaimer obviates the extension of monopoly objection to granting the second patent, even assuming it [\*1037] claims subject matter differing only in an obvious manner from that claimed in the issued patent. We will strengthen the board's tentative opinion by expressing our conviction that that is so.

Referring to our opinion in *Robeson*, the board raises two other often-voiced presumed problems, harassment and avoidance of file-wrapper estoppel (so-called). It will be observed that in *Robeson* we did not approve of those arguments as grounds for supporting a rejection, we merely observed that they are points [\*\*\*21] to be considered. We found them insufficient in *Robeson* to support the rejection.

#### File-Wrapper Estoppel Not Avoided

[5] On the matter of avoiding file-wrapper estoppel, we will now be more specific. We do not believe that it is a possibility, at least in a properly tried case before a competent court. This is amply demonstrated in a recent case, *C-Thru Products, Inc. v. Uniflex, Inc.*, 152 USPQ 303 (ED NY, 1966). There a second patent on a subcombination of a combination claimed in an issued patent was obtained with the aid of a terminal disclaimer. The court said (p. 307):

Under the circumstances, the effect of file wrapper estoppel may not be avoided by the filing of a second



[\*\*641] application together with a terminal disclaimer.

The claim in the second patent was held subject to file-wrapper estoppel limitations based on the prosecution of the application for the first patent. This argument for refusing effect to terminal disclaimers is totally wanting in substance.

#### Harassment Argument Lacks Substance

[6] As to the mere possibility of harassment, while we do not regard it as an impossibility, we think that giving weight to it to deny effect to terminal [\*\*\*22] disclaimers is to overlook the countervailing advantages to the public, pointed out in Braithwaite, in encouraging (1) additional disclosures of developments made subsequent to the initial filing, (2) earlier initial filing and patenting on the first application instead of sequential continuing and "c-i-p" applications which may not issue, and (3) consequent earlier expiration of patents and availability of inventions to the public generally.

In Robeson, the opinion refers to possible harassment through divided ownership, mentioning "multiple assignees." The implication is that if ownership remains in the same person, by original issue or assignment, the problem does not exist. Yet the board expands it to include "appellant, his assignee, or different assignees." The argument has always been predicated on divided ownership of overlapping [\*1038] patents. When there is common ownership, we think harassment by multiple suits is most unlikely. We are further of the belief that a person or corporation obtaining patents on inventions so closely related that they can give rise to double patenting rejections is most unlikely to divide the ownership of them. Though the Robeson [\*\*\*23] opinion says that we do not "minimize" the possibility, inter alia, of harassment by "multiple assignees," upon further reflection there does not appear to us to be much to minimize on this score. In any event, it should be remembered that we refused, in Robeson, to accept the harassment argument.

The unreality of the harassment theory as a ground of refusing effect to terminal disclaimers is illustrated by the allowed claims in this case. By a very narrow margin they are just over the unobviousness hurdle in being slightly more limited in defining the "plug" than claim 9 which was held obvious in the double patenting sense. A patent issuing with these allowed claims will also be dominated by patent claim 2, assuming the examiner is right, just as would claim 9. There will thus be two patents covering the same invention which could fall into the hands of different assignees who could sue the same infringer and thus "harass" him. This is a very common situation existing with respect to genus and species, dominant and subservient, and "overlapping" patents, whenever there are unobvious differences, all granted in strict accordance with law and presumed valid. Yet we do not see [\*\*\*24] the courts bogged down with harassment suits. In those rare instances where there is a situation which a court can be persuaded amounts to harassment, it has means for dealing with it by inflicting the plaintiff with attorney's fees. This can be a powerful deterrent. See the case relied on by the solicitor in his brief, supposedly as illustrating harassment, Tidewater v. Kitchen, 371 F.2d 1004, 152 USPQ 36, modified on rehearing, 152 USPQ 656. In that case, we note, there was neither divided ownership nor involvement of a terminal disclaimer and the issue of double patenting which finally invalidated the second, species patent, along with invalidity under 35 USC 103, was one on which reasonable minds could differ. The Patent Office granted the patent and a Special Master and the District Court sustained it. The Court of Appeals felt otherwise.

#### Conclusion

The terminal disclaimer here is effective to obviate the double patenting rejection of claims 3 and 9 which must [\*\*642] therefore be reversed. As to claims 13 and 14, the appeal is dismissed.

WORLEY, C.J., concurs in the result.

16. In re Morgan, 990 F.2d 1230, 26  
USPQ2d 1392 (Fed. Cir. 1993)

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*990 F.2d 1230, \*; 1993 U.S. App. LEXIS 4963, \*\*;  
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IN RE BURTON D. MORGAN

92-1278

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

990 F.2d 1230; 1993 U.S. App. LEXIS 4963; 26 U.S.P.Q.2D (BNA) 1392

March 17, 1993, PRECEDENTIAL OPINION ISSUED

**PRIOR HISTORY:** [\*\*1] Appealed from: U.S. Patent and Trademark Office Board of Patent Appeals and Interferences. Serial No. 07/331,001)

**NONPRECEDENTIAL OPINION ISSUED:** October 29, 1992, Reported at 1992 U.S. App. LEXIS 28950.

**DISPOSITION:** DISMISSED

**CASE SUMMARY**

**PROCEDURAL POSTURE:** Appellant sought review from a decision of the Patent and Trademark Office Board of Patent Appeals and Interferences, affirming the rejection of an application for reissue of a patent.

**OVERVIEW:** Appellant filed for reissue of a patent which was denied several times. During the appeal of the final reissue application, the original patent expired. The Patent Commissioner moved to dismiss the appeal, arguing that there was no "unexpired" term for which it has authority to reissue the patent under 35 U.S.C. § 251 rendering the case moot. The court granted the Commissioner's motion. The court held that under the plain language of the reissue statute, the Commissioner had authority to reissue a patent only for the unexpired part of the term of the original patent. Thus the Commissioner was divested of reissue authority once there no longer was an unexpired term of the patent. The case was dismissed as moot.

**OUTCOME:** Patent Commissioner's motion to dismiss was granted, because there was no unexpired term for which it has authority to reissue the patent and thus the case was moot.

**CORE TERMS:** reissue, patent, original patent, reexamination, unexpired, layer, expired, expires, uncut, backing,

fiber, moot, tear, reissued patent, unambiguous language, enforceable, expiration, remedial, reissued, patent infringement, amended claim, adhesive, unambiguous, unexpired term, appreciably, thickness, removably, compact

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Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > Requirements

HN1 See 35 U.S.C.S. § 251.

Governments > Legislation > Interpretation

HN2 Unless exceptional circumstances dictate otherwise, when we find the terms of a statute unambiguous, judicial inquiry is complete.

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

HN3 The language of 35 U.S.C.S. § 251 is unambiguous: the Commissioner has authority to reissue a patent only for the unexpired part of the term of the original patent. Thus, when an original patent expires, the Commissioner is divested of his reissue authority because there no longer is an unexpired term of the patent for which a patent could be reissued.

Governments > Legislation > Interpretation

Patent Law > U.S. Patent & Trademark Office Proceedings > Reissues > General Overview

HN4 Congress has provided clear language in 35 U.S.C.S. § 251 and a court cannot rewrite the statute. The fact that the intent of the reissue provision is remedial does not permit avoidance of plain statutory language. While the statute does not expressly require termination of a reissue proceeding when a patent expires, that is an inevitable concomitant of the provision that the patent can no longer be reissued.

**COUNSEL:** Edwin W. Oldham, Oldham, Oldham & Wilson Co., LPA, of Akron, Ohio, argued for appellant. Of counsel was Louis F. Wagner.

Murriel E. Crawford, Associate Solicitor, Office of the Solicitor, of Arlington, Virginia, argued for appellee. With her on the brief were Fred E. McKelvey, Solicitor and Richard E. Schafer, Associate Solicitor. Of counsel were John W. Dewhurst, Lee E. Barrett and Albin F. Drost.

**JUDGES:** Before MICHEL, PLAGER, and LOURIE, Circuit Judges.

**OPINIONBY:** LOURIE

**OPINION:**

[\*1230] LOURIE, Circuit Judge.

Burton D. Morgan appeals the November 19, 1991 decision of the Patent and Trademark Office Board of Patent Appeals and Interferences, Appeal No. 91-1882, affirming the rejection of an application for reissue of U.S. Patent 3,900,645, which expired on August 19, 1992. Because we conclude that the Commissioner has no authority to reissue this patent, we dismiss the appeal as moot.

**BACKGROUND**

The '645 patent, which relates to a "Scored Adhesive Laminate," issued to Morgan on August 19, 1975. Morgan has attempted to reissue [\*2] the '645 patent four different times. n1 He filed his first reissue application in 1977 under the then-existing "no defect" reissue rule. The Board of [\*1231] Appeals affirmed rejection of Morgan's unamended patent claims 1-4 under 35 U.S.C. § 103, and the Court of Customs and Patent Appeals affirmed that rejection in an unpublished decision. In re Morgan, Appeal No. 81-552 (July 9, 1981). Morgan then filed a continuation reissue application, and later abandoned it. Three years later, Morgan filed a third reissue application with an amended claim 1. n2 The Board then affirmed a rejection under 35 U.S.C. § 103 over the same references relied upon in the first reissue. Morgan did not appeal, and in 1989 filed a fourth reissue application, the present one, with claim 1 amended in a different manner from that in the previous application, n3 and adding a new

independent claim 5. In 1991, the Board affirmed rejection of Morgan's application under 35 U.S.C. § 112 for lack of support in the specification for the "uncut" limitation; under section 103, based upon the same references **[\*\*3]** relied upon in the previous applications; and under 35 U.S.C. § 251, for new matter. The Board affirmed its decision on reconsideration and this appeal followed.

----- Footnotes -----

n1 The '645 patent has also been the subject of litigation. Morgan Adhesives Co. v. Chemtrol Adhesives, Inc., 574 F. Supp. 832, 223 U.S.P.Q. (BNA) 639 (N.D. Ohio 1983), aff'd, 765 F.2d 158 (Fed. Cir. 1985), cert. denied, 474 U.S. 843, 88 L. Ed. 2d 107, 106 S. Ct. 130 (1985).

n2 Claim 1 read in pertinent part:

A flexible laminate . . . comprising: . . .

a fiber backing layer removably secured to said adhesive layer and having a reduced thickness potential tear line formed in such material, the fiber of the paper backing layer being appreciably compact and uncut at the potential tear line . . . .

(Amendment emphasized).

n3 Morgan transferred the term "uncut" in the earlier amended claim 1 to read as follows:

a fiber backing layer removably secured to said adhesive layer and having an uncut reduced thickness potential tear line formed in such material, the fiber of the paper backing layer being appreciably compact at the potential tear line . . . .

(Amendment emphasized).

----- End Footnotes----- **[\*\*4]**

The '645 patent expired on August 19, 1992, while this appeal was pending. On October 7, 1992, after briefing on the merits, and a few days prior to the scheduled oral hearing, the Commissioner moved to dismiss this appeal, arguing that there is no "unexpired" term for which it has authority to reissue the patent and that this case is moot. We agree with the Commissioner and therefore grant his motion.

## DISCUSSION

Reissue of patents is governed by 35 U.S.C. § 251, which provides in pertinent part:

**HN1** ↑ Whenever any patent is . . . deemed wholly or partly inoperative or invalid . . . the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

(Emphasis added). <sup>HN2</sup> "Unless exceptional circumstances dictate otherwise, 'when we find the terms of a statute unambiguous, judicial inquiry is complete.'" Burlington N. R.R. Co. v. Oklahoma Tax Comm'n, 481 U.S. 454, 461 (1987) (quoting Rubin v. United States, 449 U.S. 424, 430, 66 L. Ed. 2d 633, 101 S. Ct. 698 (1981)). [<sup>\*\*5</sup>] That is the case here.

<sup>HN3</sup> The language of section 251 is unambiguous: the Commissioner has authority to reissue a patent only "for the unexpired part of the term of the original patent." Thus, when Morgan's original patent expired on August 19, 1992, the Commissioner was divested of his reissue authority because there no longer was an unexpired term of the patent for which Morgan's patent could be reissued. Morgan's appeal thus became moot.

Morgan urges us to look beyond the unambiguous language of section 251. According to Morgan, this section should not be strictly construed, but should be applied in accordance with the remedial nature of the reissue provision. Morgan suggests that the underlying intent of this section was to prohibit the initiation of a reissue proceeding after expiration of the original patent. Morgan maintains that the phrase "for the unexpired term of the original patent" was not intended to terminate a reissue proceeding which had been properly initiated during the term of the original [<sup>\*1232</sup>] patent. Morgan points to 37 C.F.R. § 1.510(a), a reexamination rule, which provides in pertinent part:

Any person may, at any time during the period of enforceability [<sup>\*\*6</sup>] of a patent, file a request for reexamination by the Patent and Trademark Office of any claim of the patent on the basis of prior art patents or printed publications . . . .

(Emphasis added). According to Morgan, since the reissue and reexamination are both remedial in nature, and since the Patent and Trademark Office (PTO) proceeds with reexamination proceedings even after expiration of an original patent, we should interpret the reissue provision to permit similar treatment. Morgan asks us to insert the term "enforceable" into section 251 to provide that the Commissioner has authority to reissue the patent "for the enforceable unexpired part of the term of the original patent." Even if this insertion were made, however, it would not enlarge "the unexpired part of the term of the original patent." Here there is no "unexpired part," enforceable or not.

Morgan's interpretation of section 251 is expressly contrary to the plain and unambiguous language of that section.

<sup>HN4</sup> Congress has provided clear language in section 251 and we cannot rewrite the statute. The fact that the intent of the reissue provision is remedial does not permit avoidance of plain statutory language. [<sup>\*\*7</sup>] While the statute does not expressly require termination of a reissue proceeding when a patent expires, that is an inevitable concomitant of the provision that the patent can no longer be reissued. Morgan cites In re Papst-Motoren, 1 USPQ2d 1655 (Bd. Pat. App. Int. 1986), to illustrate that the Board conducts reexamination proceedings after expiration of a patent. This may be so, but it is not relevant to a reissue case, since the plain language of section 251 controls; it is reissue, not reexamination, that is before us. The Board's holding in a reexamination case is not inconsistent with the Commissioner's motion to dismiss in this reissue case.

Morgan also argues that a strict reading of section 251 is inconsistent with 35 U.S.C. § 286, since under that provision a patentee may bring a patent infringement action up to six years after the reissued patent expires. This argument is not without some force, because a patent does have value beyond its expiration date. However, the issue here is not whether Morgan can file a complaint for patent infringement after a reissued patent expires, but whether the Commissioner [<sup>\*\*8</sup>] has authority to reissue a patent after the original patent has expired. The plain and unambiguous language of section 251 compels us to conclude that he does not. A patent may be sued on after it expires, but it can no longer be reissued.

Finally, Morgan asks us to compel the Commissioner to exercise his equitable power to process his reissue application. We decline this invitation since the language of section 251 does not permit reissue of a patent which has expired. The Commissioner cannot possibly abuse his discretion concerning the conduct of reissue examinations when, as a matter of law, the process could not result in a reissued patent. Furthermore, there is no indication that the PTO unduly prolonged the processing of Morgan's application; in contrast, it is Morgan who spent fifteen years prosecuting four reissue applications, a fact which inexorably and inevitably led to the expiration of his patent.

## CONCLUSION

When Morgan's original patent expired on August 19, 1992, the Commissioner no longer had authority under 35

U.S.C. § 251 to reissue the patent. Accordingly, this appeal is moot and the Commissioner's motion is granted.  
[\*\*9]

DISMISSED

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